

Patents Bill

Government Bill

As reported from the Commerce Committee

Commentary

Recommendation

The Commerce Committee has examined the Patents Bill and recommends that it be passed with the amendments shown.

Introduction

This bill seeks to repeal and replace the Patents Act 1953. The Patents Act is modelled on the now repealed United Kingdom Patents Act 1949, and has a low threshold for patentability compared with most other countries. This low threshold can lead to broader patent rights being granted in New Zealand than in other countries, which can disadvantage New Zealand businesses and consumers, as technology that may be freely available in other countries can be covered by patents in New Zealand. This can discourage innovation and inhibit growth in productivity and exports.

The proposed patents regime would align the criteria for granting a patent with international practice. The new regime would strengthen the criteria for granting a patent by introducing an “absolute novelty” standard, and examine patent applications for usefulness and

the presence of an “inventive step” (that is, something not obvious to a person skilled in the art).¹

Strengthening the standards would require the Intellectual Property Office of New Zealand to increase the number of patent examiners and increase the resources available for patent examination. The office operates on a cost-recovery basis. Therefore, extra costs would be recovered by increasing the fees to applicants at no additional cost to the Government.

The bill seeks to simplify the procedures for granting a patent, streamline the procedures for challenging a patent, and expand revocation procedures to allow any person, at any time, to apply to the Commissioner of Patents for a grant of patent to be revoked. This would replace the existing 12-month-after-grant limit, and is expected to be simpler and cheaper than applying to the High Court for the grant of a patent to be revoked. The ability to apply to the High Court for a revocation would, however, be retained.

The bill contains provision for patents to be re-examined by the Intellectual Property Office of New Zealand. This process could be invoked at any time after a patent application is accepted. Grounds for re-examination would be an assertion that the invention was not new or did not involve an inventive step.

Exclusions to patentability

It is not uncommon to exclude for policy reasons some inventions that would otherwise meet patent requirements. This bill would exclude the following:

- methods of medical treatment of human beings
- human beings, and biological processes for their generation
- plant varieties
- inventions whose commercial exploitation would be contrary to public order or morality.

These exclusions would reaffirm that methods of medical treatment are not patentable in New Zealand, support the Royal Commission on Genetic Modification’s recommendation to exclude human beings, and incorporate the provisions of Article 27.2 of the World Trade Or-

¹ See clause 7.

ganisation Agreement on Trade Related Aspects of Intellectual Property Rights.

Article 27.2 requires that it is the commercial exploitation of the invention, rather than the nature of the invention itself, that must be objectionable for this exclusion to be invoked. It is intended that this exclusion would be used infrequently, in relation to inventions where commercial exploitation was likely to be offensive to any significant section of the community, including Māori.

Plant varieties would be excluded as they are protected under the Plant Variety Rights Act 1987.

Interests of Māori

This bill seeks to provide adequate incentives for innovation and technology transfer while ensuring that the interests of Māori in their traditional knowledge and indigenous plants and animals are protected. The bill would establish a Māori Advisory Committee to advise the Commissioner (on request) whether an invention described in a patent application was derived from Māori traditional knowledge or from indigenous plants and animals. The advisory committee would advise on whether commercial exploitation of such inventions could be contrary to Māori values. The Commissioner would be required to consider the advice of the committee, but would not be bound by it.

A number of submitters referred to the Waitangi Tribunal inquiry into indigenous flora and fauna and cultural intellectual property (WAI 262), and suggested that reform of intellectual property and patent development activity should be deferred until the Tribunal released its report. We were advised that enactment of this bill would not preclude amendments as part of the Government response to the Tribunal's report on WAI 262.

Dividing the Patent Bill

Part 5 of the bill as introduced seeks to update and modernise registration requirements, and align New Zealand's regime with that of Australia. It does not provide for a single trans-Tasman framework for regulating patent attorneys, although such a development was signalled by the Governments of New Zealand and Australia in August 2009.

We received advice that substantial amendments to the provisions in Part 5 of the bill would be needed in order to implement a trans-Tasman framework. The timeframe for developing and implementing a single regulatory framework has yet to be agreed upon and we consider it unnecessary to delay the enactment of the rest of the Patents Bill meanwhile.

After due consideration, and in accordance with Standing Order 285, we resolved to transfer the provisions concerning the regulation of patent attorneys to a separate bill. This bill, which is designed to promote quality, expertise, and integrity in the profession of patent attorneys, has been renamed the Patent Attorneys Bill.

This commentary covers the key amendments that we recommend to the bill. It does not cover minor or technical amendments.

Part 1—Preliminary

Commencement

Clause 2(2) provides for substantial parts of the bill to be brought into force by the Governor-General by one or more Orders in Council. This provision was intended to allow time for regulations to be made to give effect to some parts of the bill. In 1996 the Regulations Review Committee recommended that commencement of legislation by Order in Council be used in “rare and exceptional circumstances” only, as it transfers a critical power from Parliament to the Executive Council.² In the light of this, we recommend inserting new clause 2(3) so that the parts of the Act not covered by clauses 2(1) and 2(2) would come into force on 31 December 2012.

Purposes

We recommend including in clause 3 the Statement of Public Policy Objective from the explanatory note of the bill. This is an important policy objective, which should be included to clarify the intention of the legislation.

² Regulations Review Committee, *Investigation into the Commencement of Legislation by Order in Council*, 1996, I.16K.

Prior art base

Clause 8, subsection 3 is an anti-self collision provision intended to deal with situations where two patent applications are filed naming the same inventor, the persons entitled to be granted the patent are the same, the second of the two applications is filed before the first is published, and the second application claims patent rights over matter described (but not claimed) in the first. Few countries have anti-self collision provisions and internationally there is little support for them. We therefore recommend deleting subsection 3.

Part 2—Patentable inventions and patent rights**Exclusions from patentability**

To provide some guidance as to when commercial exploitation of an invention could be considered contrary to public order or morality, we recommend amending clause 14 by inserting a non-exhaustive list of inventions, based on Article 6 of the European Biotechnology Directive, by way of example. We would support the development of guidelines by the Intellectual Property Office of New Zealand for applying clause 14.

Patentable inventions

We recommend amending clause 15 to include computer programs among inventions that may not be patented. We received many submissions concerning the patentability of computer programs. Under the Patents Act 1953 computer programs can be patented in New Zealand provided they produce a commercially useful effect.³ Open source, or free, software has grown in popularity since the 1980s. Protecting software by patenting is inconsistent with the open source model, and its proponents oppose it. A number of submitters argued that there is no “inventive step” in software development, as “new” software invariably builds on existing software. They felt that computer software should be excluded from patent protection as software patents can stifle innovation and competition, and can be granted for trivial or existing techniques. In general we accept this position.

³ Under the Patents Act 1953 mathematical algorithms as such are not patentable. They may be patented under the Patents Act when used in a computer, so long as they produce a commercially useful effect.

While the bill would provide adequate incentives for innovation, however, we are aware of New Zealand companies who have invested in a significant number of software-related inventions, involving embedded software.⁴ We sought advice on the approach taken in other jurisdictions such as the United Kingdom and the United States, and whether legislation that would enable “embedded software” to be patentable might be practicable. After careful consideration we concluded that developing a clear and definitive distinction between embedded and other types of software is not a simple matter; and that, for the sake of clarity, a simple approach would be best. We received advice that our recommendation to include computer programs among the inventions that may not be patented would be unlikely to prevent the granting of patents for inventions involving embedded software.

We recommend that the Intellectual Property Office of New Zealand develop guidelines for inventions containing embedded software.

Part 3—Process for obtaining grant of patent and other matters

Subpart 1—Patent applications

Clause 33 concerns divisional applications, which are patent applications containing matter from previously filed applications. We are aware of concern that the lack of time limits might allow applicants to maintain pending applications for long periods, and a view that the practice of ante-dating set out in subsections 2 and 3 would be inappropriate if new matters were added. We consider that current practice addresses these concerns adequately, and therefore recommend amending clause 33 (Divisional applications) in order to codify what is already happening. We also recommend adding a requirement to comply with any further timing requirements prescribed in the regulations.

⁴ Embedded software is computer software which plays an integral role in the electronics it is supplied with (e.g. cars, pacemakers, telephones, and washing machines).

Maintenance fees

We recommend inserting new clause 33A to require an applicant to pay a maintenance fee. Failure to do so would result in the patent application lapsing. Combined with clause 292(2), this would act as a disincentive to maintain applications for inventions people are no longer actively interested in.

We considered whether any incentives should be provided to encourage the challenging of the grant of patents, through either a higher scale of costs or a period of exclusivity (regarding use of the invention) for any person who succeeded in overturning a patent. This is a significant matter, and after due consideration, we have concluded that it should be dealt with separately as a policy issue.

Subpart 2—Specifications

Clause 37 would require every complete specification to “particularly describe the invention and the method by which it is to be performed”. This provision is carried over from the Patents Act 1953, and was copied from the (now repealed) United Kingdom Patents Act 1949. No other major jurisdictions use this standard. Therefore, we recommend amending clause 37 (Contents of complete specification) by replacing “particularly describe the invention and the method by which it is to be performed” with the stricter requirement to “disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art”.

We also recommend amending clause 37 to require that claims for an invention be “supported” by the description, replacing the current “fair basis” requirement. These proposed amendments are based on the wording of sections 14(3) and 14(5) of the United Kingdom Patents Act 1977.

Subpart 4—Convention applications

We also recommend amending clause 50(3) so that convention applicants would be required to file certain documents only at the request of the Commissioner.

Subpart 5—Priority dates

For the sake of consistency, we recommend amending clauses 57 and 58 by replacing reference to an “application for protection” with reference to a “basic application” as defined in clause 5; and replacing the term “fairly based” with “supported”, which we also recommend be done in clause 37. We further recommend amending clause 58 to make it clear that the filing date may be the filing date in New Zealand or a convention country.

We recommend inserting new clause 59A to allow the Commissioner to direct that a patent application or specification be treated as having been filed on the same date as a corresponding document for another application. This would replace clause 107, and would also cover opposition and re-examination proceedings where it was found that the nominated person or patentee in respect of the other application was not entitled to the patent.

Subpart 6—Examination

The bill as introduced would require all patent applications to be examined, including those that applicants no longer wished to pursue. Allowing the Commissioner to examine an application only when requested to do so by the applicant would serve the bill’s purpose of updating and simplifying the administrative aspects of the patent regime. We therefore recommend inserting new clause 59B (Request for examination). To facilitate the efficient management of patent examiners’ workloads, we also recommend empowering the Commissioner to direct applicants to request an examination.⁵

We recommend amending clause 60 by replacing “to the best of the Commissioner’s knowledge” with “on the balance of probabilities”. This would be consistent with clause 70 (Acceptance of complete specification). For the sake of consistency, we also recommend that the matters upon which the Commissioner must report under clause 60 be consistent with clause 70.

We recommend amending clause 62 (Applicants must act by deadline if deadline set by Commissioner) to ensure that applicants “must” make a substantive response, rather than take “reasonable steps to

⁵ See new clause 59B(2).

ensure that the response is a substantive response”, which is vague and unclear.

We recommend amending clause 65 (Duty to inform Commissioner of search results) so that the submission of search reports would not be compulsory, but at the request of the Commissioner. This would further simplify the administration of the patent regime.

Subpart 7—Acceptance and publication

The purpose of clause 67 is to allow applications to lapse if certain requirements are not complied with or satisfied within a prescribed period. For example, an applicant might fail to respond to a request from the Commissioner to submit a search result. We recommend amending clause 67 to clarify this purpose by inserting new subsection 1(ab) and deleting clause 66 which would no longer be necessary. Clause 68 is intended to allow the Courts to extend the prescribed period for putting a patent application in order for acceptance if an appeal is pending. We recommend clarifying the intent of clause 68, and its relationship with clause 261 (Appeals of decisions of Commissioner).

We recommend deleting reference to a form in clause 76(2). Patents can be filed electronically and a “form”, in the conventional sense of paper copy, may not exist.

We recommend inserting new paragraph 76(1)(ab) to allow the confidentiality obligations incumbent on the Commissioner to be imposed on every person who is provided with documents by the Commissioner.

We recommend amending clause 77 (Effect of publication of complete specification) to clarify that proceedings may only be brought when all elements have been met, including the requirement that an alleged infringing act would infringe both the patent as granted and a claim of the complete specification in the form that it was immediately before it became open to public inspection.

Subpart 9—Assertions by third parties and re-examinations

The Patents Act 1953 allows third parties to oppose the grant of a patent, in what is known as pre-grant opposition, in the three-month period between acceptance of a patent application and the grant of the patent. The bill as introduced does not make provision for pre-

grant opposition. Instead, it proposes strengthening the standards of the patents regime, and would provide for a re-examination process that could be invoked at any time after a patent application had been accepted.

Many submitters favoured pre-grant opposition, and argued that it allows New Zealand businesses to limit the scope of troublesome international applications; and that an opposition mechanism allows overly broad patent claims to be narrowed, preventing patent owners from wrongfully asserting invalid rights, and thus reducing costs and disruption to businesses.

We consider that there is merit in maintaining a modified form of pre-grant opposition, and recommend amending subpart 9 by inserting new clauses that would enable third parties to oppose a patent before it was granted. Amending subpart 9 thus would require a number of consequential amendments, including inserting new clause 89A (Relationship between re-examination and other proceedings), amending clause 93 (When patent must be granted), and inserting new clause 181A (Request or claim may not be considered in certain circumstances). We recommend that these, and other, amendments be made where necessary.

We think that the grounds on which third parties can oppose a patent being granted, request that a grant of patent be re-examined, or request that a patent be revoked should be consistent, and recommend amending the appropriate clauses of this bill to achieve this. It would also be necessary for the Intellectual Property Office of New Zealand to develop re-examination guidelines.

Subpart 10—Grant of patent

If an invention is improved or modified, it is possible to apply for a patent of addition. This provides protection for improvements or modifications which, relative to publication or use of the previous invention, may be deemed to lack an inventive step. We recommend amending clause 98 (Patents of addition) to allow such an application to be made by a person authorised by the applicant or patentee of the main invention. This would be consistent with the move from a “right to apply” approach to a “right to grant” approach.

We recommend amending clause 101 to make it clear that a patent of addition would also lapse if the patent for the main invention lapsed through non-payment of a renewal fee.

Subpart 11—Revocation and surrender of patents

The bill would allow three processes for challenging a patent application or patent: opposition (pre-grant opposition), re-examination, and revocation. This might lead to people re-litigating issues previously dealt with in other proceedings. To prevent this, we recommend inserting new clause 89A subsections (4) and (5), and amending clause 105 to allow the Commissioner to refuse to consider an application for revocation or re-examination, if the issues raised are the same (or substantially the same) as those argued before the Commissioner or the Court in previous opposition, re-examination, or revocation proceedings. We received advice that this would not prevent an application for revocation being brought before the Court.

Part 4—Infringement, other patent proceedings, and matters affecting patent ownership

Subpart 1—Infringement proceedings

Prior use rights provide protection for people or companies who wish to protect their inventions as trade secrets. We recommend inserting new clause 138A (No infringement for prior use of invention) which would allow them to continue using an invention, even if another person or company obtained a patent for the invention, without being subject to infringement action. Prior use rights would only apply to patents if the relevant patent applications were made after the commencement of the bill or subject to the bill under the transitional provisions.

Subpart 2—Declarations of non-infringement

We recommend amending clauses 151 and 152 to clarify who may apply for a declaration, and what conditions must be satisfied before a declaration can be made. This would enable people considering, or already exploiting, an invention to take pre-emptive action to avoid future patent infringement action.

Subpart 3

We recommend deleting clauses 155 to 157 and replacing them with new clause 141A (Right to bring infringement proceeding if registrable assignment or licence has occurred). This would protect infringement actions from being too easily defeated by a technicality, while ensuring that there were appropriate incentives for people to register assignments and licences.

Subpart 5—Compulsory licenses

We recommend amending subpart 5 to allow New Zealand to accept the Protocol Amending the TRIPS Agreement, to Implement the Doha Declaration on the TRIPS Agreement and Public Health. Acceptance of the protocol would allow a person to export patented pharmaceuticals under a compulsory license in line with the protocol. The protocol seeks to assist countries, particularly developing countries, which are facing serious public health problems and have little or no capacity to manufacture pharmaceuticals.

Subpart 6—Crown use of inventions

We recommend amending, where appropriate, subpart 6 to make inventions whose patent applications are pending available for Crown use. This would bring New Zealand's patent legislation into line with that of Australia.

Part 6—Administrative and miscellaneous provisions**Subpart 2—General provisions on proceedings of Commissioner**

We recommend inserting new clause 255A, which would give people adversely affected the right to be heard before the Commissioner makes a final decision. There would be two exceptions to its application: the power to direct applicants to request an examination under new clause 59B (Request for examination), and a person to whom new clause 92A applies (A person who requests re-examination has no right to participate further in re-examination proceedings).

To achieve consistency with High Court rules, we recommend amending clause 259 to allow the Commissioner to award indemnity costs. For this reason, we also recommend amending clause 260, which relates to the Commissioner's ability to require security for

costs if he or she considers that a party would be unable to meet the costs of another party if required to; and, where appropriate, amending clauses 261 to 264, which relate to appeals against the Commissioner's decisions.

Subpart 3—Establishment and operation of administrative bodies for patents

Clause 270 would require the Commissioner to submit an annual report to the Minister no later than 30 September of each year, and the Minister to present the annual report to the House within six sitting days of receiving it. Section 44(1) of the Public Finance Act 1989 supersedes these reporting requirements.⁶ We therefore recommend deleting this clause and equivalent provisions in the Designs Act 1953 and the Trade Marks Act 2002.

Subpart 4—Other miscellaneous provisions

Clause 281(2) would allow the Commissioner to require an individual to confirm whether an agent is authorised to apply, on their behalf, for an extension of a time limit for certain filing requirements or for delivery failures. We received advice that the purpose of this clause, which has been carried over from the Patents Act 1953, is unknown, and therefore recommend deleting it.

Subpart 5—Regulations

We recommend amending clause 292 to allow provision for maintenance and renewal fees. This would allow the Crown to recover a share of the overall costs incurred by the Commissioner in performing his or her duties. Such fees would also encourage applicants who had lost interest to let their applications lapse, and encourage patent owners to not renew patents they were no longer exploiting or deriving any benefit from.

⁶ The Commissioner's report is included in the annual report of the Ministry of Economic Development.

Subpart 6—Repeals, amendments, validation, and saving and transitional provisions

We recommend amending clause 297 to clarify that the Patents (United States of America) Regulations 1956 would continue to apply despite any inconsistency with the provisions of the bill.

Appendix

Committee process

The Patents Bill was introduced during the 48th Parliament on 9 July 2008, and was reinstated in the 49th Parliament on 9 December 2008. It was referred to the committee on 5 May 2009. The closing date for submissions was 2 July 2009. We received and considered 67 submissions from interested groups and individuals. We heard 36 submissions. On 18 February 2010 the committee decided to divide the bill.

We received advice from the Ministry of Economic Development. The Regulations Review Committee reported to the committee on the powers contained in clause 2(2).

Committee membership

Hon Lianne Dalziel (Chairperson)

John Boscawen

Charles Chauvel (until 14 October 2009); (from 18 November 2009)

David Clendon (from 25 November 2009)

Clare Curran

Te Ururoa Flavell

Jo Goodhew (until 24 June 2009)

Raymond Huo (from 14 October 2009 until 18 November 2009)

Melissa Lee

Peseta Sam Lotu-Iiga

Katrina Shanks

Jonathan Young (from 24 June 2009)

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Key to symbols used in reprinted bill

As reported from a select committee

text inserted unanimously

~~text deleted unanimously~~

Hon Simon Power

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Infringement, other patent proceedings, and matters affecting patent ownership

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The Parliament of New Zealand enacts as follows:**1 Title**

This Act is the Patents Act **2008**.

2 Commencement

- (1) The following provisions of this Act come into force on the day after the date on which this Act receives the Royal assent: 5
- (a) **section 1** and this section:
 - (ab) **Part 1** (which contains the preliminary provisions):
 - (b) **section 194** (which relates to the setting of qualification requirements for patent attorney applications):
 - (c) **sections 201 to 207** (which relate to the code of conduct for patent attorneys and patent attorney companies): 10
 - (d) **subpart 6 of Part 5 and Schedule 1** (which relate to the Board and its membership):
 - (e) **subpart 3 of Part 6** (which relates to the establishment and operation of the administrative bodies under this Act): 15
 - (f) **subpart 5 of Part 6** (which contains the regulation-making powers):
 - (g) **section 314(1)** (which appoints the Commissioner and Assistant Commissioners of Patents under the Patents Act 1953 as the new Commissioner and Assistant Commissioners). 20
- (2) The rest of this Act comes into force on a date to be appointed by the Governor-General by Order in Council; and 1 or more orders may be made bringing different provisions into force on different dates. 25
- (3) To the extent that it is not previously brought into force under subsection (1) or (2), the rest of this Act comes into force on 31 December 2012. 30

Part 1 Preliminary

Purposes and overview

- 3 Purposes**
- The purposes of this Act are to— 5
- (aa) provide an efficient and effective patent system that—
- (i) promotes innovation and economic growth while providing an appropriate balance between the interests of inventors and patent owners and the interests of society as a whole; and 10
- (ii) complies with New Zealand’s international obligations; and
- (a) ensure that a patent is granted for an invention only in appropriate circumstances by—
- (i) establishing appropriate criteria for the granting of a patent; and 15
- (ii) providing for procedures that allow the validity of a patent to be tested; and
- (b) provide greater certainty for patent owners and the users of patented inventions that patents will be valid after they are granted; and 20
- (c) address Māori concerns relating to the granting of patents for inventions derived from indigenous plants and animals or from Māori traditional knowledge; and
- (d) ~~promote quality, expertise, and integrity in the profession of patent attorneys; and~~ 25
- (e) ~~ensure that New Zealand’s patent regime takes account of international developments.~~
- (e) ensure that New Zealand’s patent legislation takes account of developments in the patent systems of other countries. 30
- 4 Overview**
- (1) In this Act,—
- (a) this Part specifies the purposes of this Act and defines terms and expressions used in this Act; and 35
- (b) **Part 2** contains provisions concerning patentable inventions and patent rights, including provisions relating

- to what is a patentable invention, exclusions from what is patentable, the exclusive rights given by a patent, and who may be granted a patent; and
- (c) **Part 3** describes the process for obtaining a patent and various other matters, including provisions relating to patent applications, specifications, examinations, acceptance, publication, opposition, and the granting of patents; and 5
- (d) **Part 4** contains matters affecting patent ownership, including provisions relating to infringement proceedings; and declarations of non-infringement, ~~and other proceedings relating to patents~~; and provisions on patent dealings and compulsory licences; and 10
- (e) ~~**Part 5** contains provisions relating to patent attorneys; patent attorney companies; and patent attorney partnerships; including a registration system for patent attorneys; a code of conduct for patent attorneys and patent attorney companies; a complaints and disciplinary regime; and provisions dealing with the Patent Attorneys² Standards Board of New Zealand; and~~ 15 20
- (f) **Part 6** contains provisions relating to the patents register, the Commissioner, the Māori advisory committee, and other administrative and miscellaneous matters.
- (2) This section is intended only as a guide to the general scheme and effect of this Act. 25

Interpretation

5 Interpretation

- (1) In this Act, unless the context otherwise requires,—
- ~~**acquirer** has, in **sections 160 and 161**, the meaning set out in **section 160(1)**~~ 30
- applicant**—
- (a) means a person who has applied for a patent for an invention; and
- (b) includes a person in whose favour a direction has been given under **section 27(2)(ab)(i), 122, or 124(1)(a)** and the personal representative of a deceased applicant 35

assignee includes the personal representative of a deceased assignee; and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person

basic application means an application for protection in respect of an invention, being an application that is made in a convention country (whether before or after it became a convention country) 5

Board means the Patent Attorneys' Standards Board of New Zealand established under **section 237** 10

Budapest Treaty—

- (a) means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure signed at Budapest on 28 April 1977, together with the regulations annexed to that treaty; and 15
- (b) includes any amendments, modifications, and revisions from time to time made to that treaty or those regulations, being amendments, modifications, and revisions to which New Zealand is a party and by which New Zealand is bound 20

claim means a claim of the complete specification

code of conduct means the applicable code of conduct for patent attorneys and patent attorney companies under **section 201** 25

Commissioner—

- (a) means the Commissioner of Patents appointed under **section 266**; and
- (b) includes an Assistant Commissioner of Patents appointed under **section 266** 30

convention applicant, in relation to a basic application, means a person who—

- (a) has made the basic application; or
- (b) is the assignee of the person who made the basic application; or 35
- (c) is the personal representative of a person mentioned in **paragraph (a) or (b)**; or

- (d) has the consent of a person mentioned in **paragraph (a), (b), or (c)** to make a convention application based on that basic application

convention application means a patent application made under **subpart 4 of Part 3 section 50(1)** 5

convention country, in a provision of this Act, means an entity for the time being declared by an order made under **section 294** to be a convention country for the purposes of that provision

court means the High Court 10

date of the publication of the accepted complete specification has the meaning set out in **section 70**

depository institution means a body or institution that receives, accepts, and stores micro-organisms and furnishes samples of micro-organisms 15

disciplinary matter means a complaint about, or inquiry into, the conduct of a patent attorney or patent attorney company or a decision on that inquiry or complaint

exclusive licence means a licence from a patentee that gives the licensee (or the licensee and persons authorised by the licensee) any of the patentee's exclusive rights under **section 17** to the exclusion of the patentee and all other persons 20

exploit has the meaning set out in **section 17**

file means file with IPONZ

filing date, in relation to a document filed under this Act, means— 25

- (a) the date on which the document is filed; or
 (b) the date on which the document is treated as having been filed (if it is treated under this Act or the regulations as having been filed on a different date) 30

government department means any department or instrument of the Executive Government of New Zealand, or any branch or division of any of those departments or instruments

incorporated law firm has the meaning set out in section 6 of the Lawyers and Conveyancers Act 2006 35

Institute means the New Zealand Institute of Patent Attorneys (Incorporated)

integrated circuit means a circuit, in its final or an intermediate form, if—

- (a) the elements of the circuit and some or all of the interconnections are integrally formed in or on a piece of material; and
- (b) at least one of the elements of the circuit is an active element; and
- (c) the circuit is intended to perform an electronic function

5

interested party, in relation to a patent application, means the applicant or a joint applicant, or a person who claims to be entitled to the grant of a patent on the application, either alone or jointly with another person

10

international application means an application made under the Patent Cooperation Treaty for the protection of an invention

15

International Bureau means the International Bureau of the World Intellectual Property Organization

international depositary authority has the same meaning as in the Budapest Treaty

international filing date means the international filing date given to an international application under Article 11 or 14(2) of the Patent Cooperation Treaty

20

invention includes an alleged invention

inventive step has the meaning set out in **section 7**

inventor,—

25

- (a) in relation to an invention, means the actual deviser of the invention; but
- (b) in **section 9**, has the meaning set out in **section 9(2)**

IPONZ means the Intellectual Property Office of New Zealand

30

journal means the journal published under **section 254**

lawyer has the meaning set out in section 6 of the Lawyers and Conveyancers Act 2006

licence means a licence to do anything that the patentee otherwise has the exclusive right to do under **section 17**

35

main invention has the meaning set out in **section 98**

Māori advisory committee means the committee appointed under **section 275**

Minister means the Minister of the Crown who, under the authority of any warrant or with the authority of the Prime Minister, is for the time being responsible for the administration of this Act 5

Ministry means the department of State that, with the authority of the Prime Minister, is for the time being responsible for the administration of this Act

nominated person, in relation to a patent application, means the person identified as the person to whom the patent is to be granted 10

novel has the meaning set out in **section 6**

patent means letters patent for an invention

patent application means an application for a patent under this Act 15

patent area means—

- (a) New Zealand; and
- (b) all waters within the outer limits of the territorial sea of New Zealand (as defined by section 3 of the Territorial Sea, Contiguous Zone, and Exclusive Economic Zone Act 1977); and 20
- (c) the airspace above New Zealand and those waters

patent attorney means a registered patent attorney registered under section 100 of the Patents Act 1953 25

patent attorney company has the meaning set out in **section 185**

patent attorney partnership has the meaning set out in **section 186**

Patent Cooperation Treaty— 30

- (a) means the Patent Cooperation Treaty signed at Washington on 19 June 1970; and
- (b) includes any amendments, modifications, and revisions from time to time made to that Treaty, being amendments, modifications, and revisions to which New Zealand is a party and by which New Zealand is bound 35

patent date, in relation to a patent, means the date given to the patent under **section 95**

- patent of addition** means a patent granted under **sections 98 to 103**
- patentable invention** has the meaning set out in **section 13**
- patented process** means a process for which a patent has been granted and is in force 5
- patented product** means a product for which a patent has been granted and is in force
- patentee** means the person entered in the patents register as the grantee or owner of a patent at the relevant time
- patents register** means the patents register kept under **section 241** 10
- personal representative**, in relation to a deceased person,—
- (a) means a person to whom probate of the will of the deceased person, letters of administration of the estate of the deceased person, or any other similar grant, has been granted, whether in New Zealand or anywhere else; but 15
- (b) does not include a person referred to in **paragraph (a)** if, under the terms of the grant, the person is not entitled to do an act in relation to which the expression is used
- prescribed** means prescribed by regulations 20
- prescribed depository institution** means—
- (a) an international depository authority, whether in or outside New Zealand; or
- (b) any other depository institution in New Zealand that is prescribed for the purposes of this paragraph 25
- prior art base** has the meaning set out in **section 8**, and **prior art** has a corresponding meaning
- priority date**, in relation to a claim, means the priority date given to the claim under **subpart 5 of Part 3**
- publicly notify**, in relation to the Commissioner, has the meaning set out in **subsection (3)** 30
- publish**, in relation to the Commissioner publishing anything in the journal, has the meaning set out in **subsection (4)**
- receiving Office** has the same meaning as in Article 2(xv) of the Patent Cooperation Treaty 35

- register of patent attorneys** or **patent attorneys register** means the register kept under **section 230** the Patents Act 1953
- registered**, in relation to a patent attorney, means registered as a patent attorney under **Part 5** 5
- registration certificate** means a registration certificate that is issued under **Part 5**
- regulations** means regulations in force under this Act
- relevant proceeding**, in relation to a patent, means a court proceeding— 10
- (a) for infringement of the patent; or
 - (b) for the revocation of the patent; or
 - (c) in which the validity of the patent, or of a claim, is in dispute
- rules relating to micro-organisms** means— 15
- (a) the provisions of the Budapest Treaty that are applicable; and
 - (b) the provisions of the regulations that relate to micro-organisms
- Statute of Monopolies** means the Act of the 21st year of the reign of King James the First, chapter 3, being an Act concerning monopolies and dispensations with penal laws and the forfeiture thereof 20
- Treaty application** means an international application— 25
- (a) that contains a request specifying New Zealand as a designated State under Article 4(1)(ii) of the Patent Cooperation Treaty; and
 - (b) that has been given an international filing date
- Treaty regulations**— 30
- (a) means the regulations made under the Patent Cooperation Treaty; and
 - (b) includes any amendments from time to time made to those regulations
- TRIPS agreement** means the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights done at Marrakesh on 15 April 1994 35
- useful** has the meaning set out in **section 10**.

- (2) In the case of an entity that is a convention country but is not a State, part of a State, or a territory for whose international relations a State is responsible,—
- (a) a reference in this Act to an application for protection in a country or an application for protection in respect of a country must be read as a reference to an application for protection under the rules of the entity; and 5
 - (b) a reference in this Act to filing a specification in a convention country must be read as a reference to filing a specification under the rules of the entity; and 10
 - (c) a reference in this Act to the law of a convention country must be read as a reference to the rules of the entity; and
 - (d) a reference in this Act to the Government of a convention country must be read as a reference to the governing body of the entity. 15
- (3) The Commissioner may comply with any requirement in this Act for the Commissioner to **publicly notify** anything by—
- (a) publishing it on ~~a website~~ an Internet site maintained for IPONZ's purposes; and
 - (b) if the Commissioner thinks fit, also publishing it by any other means that the Commissioner considers appropriate to make it known to persons that are likely to have an interest in the matter. 20
- (4) Any requirement in this Act for the Commissioner to **publish** anything in the journal requires the Commissioner to publish that matter in the journal in the manner required by the regulations (if any). 25
- (5) An example used in this Act has the following status:
- (a) the example is only illustrative of the provision to which it relates and does not limit the provision; and 30
 - (b) if the example and the provision to which it relates are inconsistent, the provision prevails.

Compare: 1953 No 64 s 2

6 **Meaning of novel**

An invention, so far as claimed in a claim, is **novel** if it does not form part of the prior art base. 35

Compare: Patents Act 1977 s 2(1) (UK)

7 Meaning of inventive step

An invention, so far as claimed in a claim, involves an **inventive step** if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the prior art base.

Compare: Patents Act 1977 s 3 (UK)

5

8 Meaning of prior art base

(1) For the purpose of deciding whether or not an invention is novel and for the purpose of deciding whether or not an invention involves an inventive step, the **prior art base**, in relation to an invention so far as claimed in a claim, means all matter (whether a product, a process, information about a product or process, or anything else) that has at any time before the priority date of that claim been made available to the public (whether in New Zealand or elsewhere) by written or oral description, by use, or in any other way.

10

15

(2) For the purpose of deciding whether or not an invention is novel, the **prior art base**, in relation to an invention so far as claimed in a claim, also includes the information contained in a complete specification filed in respect of another patent application if all of the following circumstances apply:

20

(a) if the information is, or were to be, the subject of a claim of that complete specification, the claim has, or would have, a priority date earlier than that of the claim under consideration; and

(b) that complete specification became open to public inspection after the priority date of the claim under consideration; and

25

(c) the information was contained in that complete specification on its filing date and when it became open to public inspection.

30

(3) However, **subsection (2)** does not apply if—

(a) either or both of the following apply:

(i) all of the nominated persons under the patent application are the same as the nominated persons under the other patent application at the filing date of the patent application under consideration.

35

- (ii) ~~all of the inventors identified in the patent application are the same as the inventors identified in the other patent application at the filing date of the patent application under consideration; and~~
- (b) ~~neither of the complete specifications filed for the patent applications contains a claim for matter claimed in the other.~~ 5

Compare: Patents Act 1977 s 2(2) (UK)

9 Disclosure to be disregarded in certain circumstances

- (1) For the purposes of **section 8**, the disclosure of matter constituting an invention must be disregarded if 1 or more of the following applies: 10
- (a) that disclosure occurred during the 1-year period immediately preceding the filing date of the patent application and the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by a person from— 15
- (i) the inventor; or
- (ii) any other person to whom the matter was made available in confidence by the inventor; or 20
- (iii) any other person who obtained it from the inventor because the person or the inventor believed that the person was entitled to obtain it; or
- (iv) any other person to whom the matter was made available in confidence by any person referred to in **subparagraphs (i) to (iii)** or in this subparagraph; or 25
- (v) any other person who obtained it from any person mentioned in **subparagraphs (i) to (iv)** because the person or the person from whom the person obtained it believed that the person was entitled to obtain it: 30
- (b) that disclosure occurred during the 1-year period immediately preceding the filing date of the patent application and the disclosure was made in breach of confidence by a person who obtained the matter in confidence from the inventor or from any other person to whom it was made available by, or who obtained it from, the inventor: 35

- (c) that disclosure was due to the communication of the matter to a government department or to any person authorised by a government department to investigate the invention or its merits, or to anything done, in consequence of that communication, for the purpose of the investigation: 5
- (d) that disclosure occurred during the 6-month period immediately preceding the filing date of the patent application and that disclosure was due to, or made in consequence of,— 10
- (i) the display of the invention with the consent of the inventor at a specified exhibition; or
 - (ii) the use of the invention with the consent of the inventor for the purposes of a specified exhibition in the place where it is held; or 15
 - (iii) the publication of any description of the invention in consequence of its display or use at a specified exhibition as referred to in **subparagraph (i) or (ii)**; or
 - (iv) the use of the invention, after it has been displayed or used at a specified exhibition as referred to in **subparagraphs (i) and (ii)** and during the period of the exhibition, by any person without the consent of the inventor: 20
 - (v) ~~a description of the invention in a paper being read by the inventor before a learned society or published with the inventor's consent in the transactions of a learned society:~~ 25
- (e) that disclosure was due to, or made in consequence of, the invention being publicly worked, at any time during the 1-year period immediately preceding the filing date of the patent application, by any of the following persons if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public: 30
- (i) the patentee or applicant nominated person;
 - (ii) any person from whom the patentee or applicant nominated person derives title: 35

- (iii) any person with the consent of the patentee or applicant nominated person:
- (iv) any person with the consent of any person from whom the patentee or applicant nominated person derives title. 5
- (2) For the purposes of this section,—
inventor, in relation to an invention,—
 (a) means the actual deviser of the invention; and
 (b) includes any owner of the invention at the relevant time
specified exhibition means an exhibition (whether held in 10
 New Zealand or elsewhere) that is declared to be an inter-
 national or industrial exhibition by the Commissioner in a
 notice that is publicly notified.
 Compare: 1953 No 64 s 60; Patents Act 1977 s 2(4), (5) (UK)
- 10 Meaning of useful** 15
 An invention, so far as claimed in a claim, is **useful** if the
 invention has a specific, credible, and substantial utility.

Act binds the Crown

- 11 Act binds the Crown** 20
 This Act binds the Crown.

Part 2

Patentable inventions and patent rights

Subpart 1—Patentable inventions

General rules concerning what is patentable

- 12 Patent may be granted for patentable inventions only** 25
 (1) A patent may be granted for an invention only if it is a
 patentable invention.
 (2) This section is subject to **section 103** (which relates to patents
 of addition).
- 13 Patentable inventions** 30
 An invention is a **patentable invention** if the invention, so far
 as claimed in a claim,—

- (a) is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies; and
- (b) when compared with the prior art base—
- (i) is novel; and
- (ii) involves an inventive step; and
- (c) is useful; and
- (d) is not excluded from being a patentable invention under **section 14 or 15**.

5

Compare: Patents Act 1990 s 18(1) (Aust)

Exclusions from patentability

10

14 Inventions contrary to public order or morality not patentable inventions

- (1) An invention is not a patentable invention if the commercial exploitation of the invention, so far as claimed in a claim, is contrary to—
- (a) public order (which in this section has the same meaning as the term *ordre public* as used in Article 27.2 of the TRIPS agreement); or
- (b) morality.

15

Examples

20

The commercial exploitation of the following inventions is contrary to public order or morality and, accordingly, those inventions are not patentable:

- an invention that is a process for cloning human beings;
- an invention that is a process for modifying the germ line genetic identity of human beings;
- an invention that involves the use of human embryos for industrial or commercial purposes;
- an invention that is a process for modifying the genetic identity of animals that is likely to cause them suffering without any substantial medical benefit to human beings or animals, or an invention that is an animal resulting from such a process.

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- (2) For the purposes of **subsection (1)**, commercial exploitation must not be regarded as contrary to public order or morality only because it is prohibited by any law in force in New Zealand.

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- (3) The Commissioner may, for the purpose of making a decision under this section, seek advice from the Māori advisory committee or any person that the Commissioner considers appropriate.
- (4) For the purposes of this section, **TRIPS agreement** means the ~~World Trade Organization Agreement on the Trade Related Aspects of Intellectual Property Rights done at Marrakesh on 15 April 1994.~~ 5
 Compare: Patents Act 1977 s 1(3), (4) (UK)

15 Other exclusions 10

- (1) Human beings, and biological processes for their generation, are not patentable inventions.
- (2) An invention of a method of treatment of human beings by surgery or therapy is not a patentable invention.
- (3) An invention of a method of diagnosis practised on human beings is not a patentable invention. 15
- (3A) A computer program is not a patentable invention.
- (4) A plant variety is not a patentable invention.
- (5) For the purposes of **subsection (4)**, **plant variety** has the same meaning as that given to the term **variety** in section 2 of the Plant Variety Rights Act 1987. 20

Subpart 2—Patent rights

16 Nature of patent

- (1) A patent is personal property.
- ~~(2) The rules of law that apply to the ownership and devolution of personal property generally apply to patents as they apply in relation to other choses in action.~~ 25
- (3) Equities in respect of a patent may be enforced in the same way as equities in respect of any other personal property.
 Compare: 1953 No 64 ss ~~63(5)~~, s 84(4); 2002 No 49 s 9 30

17 Exclusive rights given by patent

- (1) A patent gives the patentee the exclusive rights, during the term of the patent, to exploit the invention and to authorise another person to exploit the invention.

- (2) In this Act, **exploit**, in relation to an invention, includes,—
- (a) if the invention is a product, to—
 - (i) make, hire, sell, or otherwise dispose of the product; or
 - (ii) offer to make, hire, sell, or otherwise dispose of the product; or
 - (iii) use or import the product; or
 - (iv) keep the product for the purpose of doing any of the things referred to in **subparagraphs (i) to (iii)**; or
 - (b) if the invention is a process, to use the process or to do any act mentioned in **paragraph (a)** in respect of a product resulting from that use.
- (3) This section is subject to **subparts 5 and 6 of Part 4** (which relate to compulsory licences and the use of patented inventions for services of the Crown).
Compare: Patents Act 1990 s 13 (Aust)

18 Extent, effect, and form of patent

- (1) A patent has effect throughout the patent area.
- (2) However, a patent may be assigned for any place in, or part of, the patent area as effectively as if it were granted so as to extend to that place or part only.
- (3) A patent has the same effect against the Crown as it has against any other person a subject.
- (4) **Subsection (3)** is subject to the provisions of this Act and to section 7(3) of the Crown Proceedings Act 1950.
- (5) A patent must be in the prescribed form.
Compare: 1953 No 64 s 29(1)–(3)

19 Term of patent

- (1) The term of every patent is 20 years from the patent date.
- (2) However, a patent ceases to have effect on the expiry of the period prescribed for the payment of any renewal fee if that fee is not paid within that period or within that period as extended under **section 20**.

- (3) **Subsection (2)** applies despite anything in the patent or any other provision in this Act.

Compare: 1953 No 64 s 30(3), (4)

20 Extension of period for paying renewal fees

- (1) ~~If the prescribed period for the payment of a renewal fee expires before the date that is 4 months after the date of the grant of the patent, the period for payment of the renewal fee is extended to the date that is 4 months after the date of the grant of the patent.~~ 5
- (2) A patentee may request, in the prescribed manner (if any), that the prescribed period for the payment of a renewal fee ~~(including any extension of the period under **subsection (1)**)~~ be extended to any date that is not more than 6 months after the expiry of the prescribed period. 10
- (3) The Commissioner must extend the prescribed period for the payment of the renewal fee to the date requested under **subsection (2)** if, before that date,— 15
- (a) the request under **subsection (2)** is made; and
 - (b) the renewal fee is paid; and
 - (c) the prescribed penalty (if any) is paid. 20

Compare: 1953 No 64 s 30(4), (5)

Subpart 3—Patent ownership

Who may be granted patent

21 Who may be granted patent

- (1) A patent for an invention may only be granted to a person who— 25
- (a) is the inventor; or
 - (b) derives title to the invention from the inventor; or
 - (c) is the personal representative of a deceased person mentioned in **paragraph (a) or (b)**. 30
- (2) A patent may be granted to a person whether or not the person is a New Zealand citizen.

Compare: Patents Act 1990 s 15 (Aust)

Power of patentee to deal with patent

- 22 Power of patentee to deal with patent**
- (1) A patentee may (subject to any rights vested in other persons that are entered in the patents register) deal with the patent as the absolute owner of it and give good discharges for any consideration for that dealing. 5
- (2) This section does not protect a person who deals with a patentee otherwise than as a purchaser in good faith for value and without notice of any fraud on the part of the patentee.
- (3) This section is subject to **section 16(3)**. 10
Compare: Patents Act 1990 s 189(1), (2) (Aust)

Co-owners of patent

- 23 Co-ownership of patent**
- (1) If a patent is granted to 2 or more persons, each of those persons is entitled to an equal undivided share in the patent. 15
- (2) If 2 or more persons are patentees of the patent, each of those persons is entitled to exercise the exclusive rights given by the patent for the person's own benefit without accounting to the others.
- (3) However, a licence under a patent must not be granted, and a share in a patent must not be assigned, except with the consent of all patentees of the patent (other than the licensor or assignor). 20
- (4) **Subsections (1) to (3)** are subject to any agreement to the contrary between the patentees of the patent. 25
- (5) This section is subject to any direction of the Commissioner under **section 25**.
- (6) Nothing in **subsection (1) or (2)** affects the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as trustees or personal representatives. 30
Compare: 1953 No 64 s 63(1)–(3), (5)

- 24 Rights of buyers from co-owners of patent**
- If a patented product, or a product of a patented process, is sold by any of 2 or more persons who are patentees of a patent, 35

the buyer, and a person claiming through the buyer, may deal with the product as if the product had been sold by all of the patentees.

Compare: 1953 No 64 s 63(4); Patents Act 1990 s 16(2) (Aust)

- 25 Power of Commissioner to give directions to co-owners** 5
- (1) If 2 or more persons are patentees of a patent, the Commissioner may, on the request of any of them in the prescribed manner, give any directions in accordance with the request that the Commissioner thinks fit.
 - (2) The directions under **subsection (1)** must relate to— 10
 - (a) the sale or lease of the patent or any interest in it; or
 - (b) the grant of licences; or
 - (c) the exercise of any right under **section 23** in relation to the patent.
 - (3) If any patentee fails to do anything required to carry out a direction given under **subsection (1)** within 14 days after being asked in writing to do so by any of the other patentees, the Commissioner may, on the request of any of them in the prescribed manner, direct a person to do that thing in the name and on behalf of the person in default. 20
- Compare: 1953 No 64 s 64(1), (2)
- 26 Miscellaneous provisions concerning directions**
- (1) Before giving a direction under **section 25**, the Commissioner must—
 - (a) give a reasonable opportunity to be heard,— 25
 - (i) in the case of a request under **section 25(1)**, to the patentees of the patent; and
 - (ii) in the case of a request under **section 25(3)**, to the person in default; and
 - (b) have regard to the terms of any agreement between the patentees of the patent that are brought to the Commissioner’s notice. 30
 - (2) The Commissioner must not give a direction that—
 - (a) ~~affects the rights or obligations of a trustee or of the personal representative of a deceased person; or rights or obligations arising out of either of those relationships; or~~ 35

- (a) affects the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as trustees or personal representatives; or
- (b) is inconsistent with the terms of an agreement between the patentees of the patent. 5

Compare: 1953 No 64 s 64(3), (5); Patents Act 1990 s 17(3), (4) (Aust)

Disputes as to inventions made by employees

27 Disputes as to inventions made by employees

- (1) This section and **sections 28 and 29** apply if a dispute arises between an employer and a person who is, or was at the material time, his, her, or its employee as to the rights of the parties in respect of— 10
 - (a) an invention made by the employee, either alone or jointly with any other person; or 15
 - (b) any patent granted, or to be granted, in respect of an invention referred to in **paragraph (a)**.
- (2) The Commissioner may, on a request made to him or her in the prescribed manner by either of the parties and after giving to each of them a reasonable opportunity to be heard,— 20
 - (a) determine the matter in dispute; and
 - (ab) give any directions that the Commissioner thinks fit—
 - (i) for enabling a patent application to proceed in the name of 1 or more of the parties alone; or
 - (ii) for regulating the manner in which it is to proceed; or 25
 - (iii) for both of the purposes referred to in **subparagraphs (i) and (ii)**; and
 - (b) make any orders for giving effect to his or her decision as he or she considers expedient. 30
- (3) However, if it appears to the Commissioner that, in relation to any request under this section, the matter in dispute involves questions that would more properly be determined by the Authority, he or she may decline to deal with the matter.
- (4) A decision of the Commissioner under this section or **section 28** has the same effect as between the parties and persons claiming under them as a decision of the Authority. 35

- (5) Section 161 of the Employment Relations Act 2000 does not limit this section or **section 28 or 29**.
- (6) The parties to a dispute or review under this section or **section 28 or 29** are the employer and employee.
- (7) In this section and **sections 28 and 29**, **Authority** means the Employment Relations Authority established by section 156 of the Employment Relations Act 2000. 5
Compare: 1953 No 64 s 65(1), (3)

28 Employment Relations Authority or Commissioner may apportion benefit of invention and of patent 10

- (1) In proceedings before the Authority, or on a request made to the Commissioner under **section 27**, the Authority or Commissioner may make an order specified in **subsection (2)** (unless satisfied that one or other of the parties is entitled, to the exclusion of the other, to the benefit of an invention made by an employee). 15
- (2) The order referred to in **subsection (1)** is an order providing for the apportionment between the employer and employee of the benefit of the invention, and of any patent granted or to be granted in respect of the invention, in the manner that the Authority or Commissioner considers just. 20
Compare: 1953 No 64 s 65(2)

29 Review of Commissioner's decision

- (1) A person who is aggrieved by a decision of the Commissioner under **section 27 or 28** may apply to the Authority for a review of the decision. 25
- (2) An application for review must be made within—
(a) 20 working days after the date of the decision; or
(b) any further time the Authority allows on an application made before or after that period expires. 30
- (3) The Authority—
(a) may confirm, reverse, or modify the decision of the Commissioner; and
(b) may make any other decision that the Commissioner could have made. 35

- (4) The Authority must not review any decision made under **section 27 or 28**, or part of a decision made under those sections, that is not the subject of an application under **subsection (1)**.
- (5) A decision against which an application is made under **subsection (1)** continues in force pending the determination of the review unless the Authority orders otherwise. 5
- Compare: 1953 No 64 s 65(4)

Part 3

Process for obtaining grant of patent and other matters 10

Subpart 1—Patent applications

- 30 Right to apply for patent**
Any person may apply for a patent either alone or jointly with another person.
Compare: Patents Act 1977 s 7(1) (UK) 15
- 31 Application requirements**
Every patent application must be made in accordance with this Act and the manner prescribed by the regulations.
- 32 Commissioner may post-date application or specification**
- (1) The Commissioner may, on the request of the applicant in the prescribed manner (if any), direct that a patent application be post-dated to the date that is specified in the request. 20
- (2) The Commissioner must not exercise the power under **subsection (1)** after the acceptance of the complete specification.
- (3) A patent application must not be post-dated under **subsection (1)** to a date later than 6 months after the date that it was actually made or would, but for **subsection (1)**, be treated as having been made. 25
- (4) A convention application must not be post-dated under **subsection (1)** to a date later than the last date that, under the provisions of this Act, the application could have been made. 30
- (5) If an application or specification filed under this Act is amended before acceptance of the complete specification, the

Commissioner may direct that the application or specification be post-dated to the date that the amendment is first filed.

Compare: 1953 No 64 s 12(3), (4)

33 Divisional applications

- (1) If a patent application has been made (but has not become void or been abandoned), the applicant may, before the acceptance of the complete specification and in the prescribed manner, make a fresh patent application for any part of the subject matter of the original application. 5
- (2) The Commissioner may direct that the fresh patent application be given an earlier date if a request to that effect is made in the prescribed manner. 10
- (3) The earlier date must not be earlier than the filing date of the original patent application. 15
- Compare: 1953 No 64 s 12(5)

33 Divisional applications

- (1) If a patent application has been made (but has not become void or been abandoned) (the **parent application**), the applicant may, in the prescribed manner, make a fresh patent application for any part of the subject matter of the parent application (the **divisional application**). 20
- (2) A divisional application may only be made—
- (a) before the acceptance of the complete specification for the parent application; and
- (b) in accordance with any further prescribed requirements relating to the period within which a divisional application may be made. 25
- (3) The Commissioner may direct that a divisional application or a complete specification for that application (or both) be given an earlier date if— 30
- (a) a request to that effect is made in the prescribed manner; and
- (b) the divisional application is only in respect of subject matter that was in substance disclosed by the parent application as filed. 35
- (4) The earlier date must not be earlier than,—

- (a) in the case of the divisional application, the filing date of the parent application; and
- (b) in the case of a complete specification for the divisional application, the filing date of the complete specification for the parent application.

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Compare: 1953 No 64 s 12(5)

33A Applicant must pay maintenance fee

- (1) An applicant must pay a prescribed maintenance fee within the period or periods that are prescribed for the purposes of this section.
- (2) A patent application must be treated as having been abandoned if the applicant does not comply with **subsection (1)**.

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Subpart 2—Specifications

34 Complete and provisional specifications

- (1) Every patent application must—
 - (a) be accompanied by a complete specification or a provisional specification unless the application is a convention application; and
 - (b) be accompanied by a complete specification if the application is a convention application.
- (2) The Commissioner may direct that a specification that purports to be a complete specification be treated as a provisional specification if—
 - (a) the applicant requests, at any time before the acceptance of the specification, that the Commissioner make that direction; and
 - (b) the patent application is not a convention application.
- (3) A person is not entitled to make a request under **subsection (2)** if the patent application and specification filed in respect of the application have become open to public inspection.
- (4) If the Commissioner makes a direction under **subsection (2)**, the complete specification must be treated, for the purposes of this Act, to be, and to have always been, a provisional specification.

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- (5) The Commissioner may cancel a provisional specification and post-date the patent application to the filing date of a complete specification if—
- (a) a complete specification has been filed for a patent application that was accompanied by a provisional specification or by a specification treated as a provisional specification under **subsection (2)**; and 5
 - (b) the applicant requests, at any time before the acceptance of the complete specification, that the Commissioner cancel the provisional specification and post-date the application. 10

Compare: 1953 No 64 s 9(1), (4), (5); Patents Act 1990 s 37 (Aust)

35 Filing of complete specification after provisional specification has been filed

- (1) If a patent application is accompanied by a provisional specification, 1 or more complete specifications must be filed within the period allowable under **subsection (2)**. 15
- (2) The period allowable is—
- (a) the period within 12 months from the filing date of the patent application; or 20
 - (b) an extended period not exceeding the prescribed period if, on or before the date on which the complete specification is filed,—
 - (i) a request to that effect for an extension of time in which to file the complete specification is made to the Commissioner in the prescribed manner (if any); and 25
 - (ii) the prescribed penalty (if any) is paid.
- (3) A patent application referred to in **subsection (1)** must be treated as having been abandoned if a complete specification is not filed within the period allowable under **subsection (2)**. 30
- (4) If 2 or more patent applications accompanied by provisional specifications have been filed for inventions that are cognate, or of which one is a modification of another,—
- (a) a single complete specification may be filed for those applications; or 35
 - (b) more than 1 complete specification may be filed for those applications with the leave of the Commissioner.

- (5) **Subsection (4)** is subject to **subsections (1) to (3)** and **sections 36 to 42**.

Compare: 1953 No 64 s 9(2), (3); ~~Patents Act 1990 s 37 (Aust)~~

36 Contents of provisional specification

Every provisional specification must— 5

- (a) describe the invention; and
- (b) include any other prescribed information.

Compare: 1953 No 64 s 10(1)

37 Contents of complete specification

(1) Every complete specification must— 10

- (a) ~~particularly describe the invention and the method by which it is to be performed; and~~

(a) disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art; and 15

- (b) disclose the best method of performing the invention that is known to the applicant and for which there is an entitlement to claim protection; and

(c) end with a claim or claims defining the scope of the invention claimed; and 20

- (d) include any other prescribed information.

(2) The claim or claims must—

- (a) relate to one invention only; and

~~(b) be clear, succinct, and fairly based on the matter disclosed in the specification.~~ 25

- (b) be clear and concise; and

(c) be supported by the matter disclosed in the complete specification.

(3) A complete specification filed after a provisional specification, or filed with a convention application, may include claims concerning developments of, or additions to, the invention that 30

was described in the provisional specification or the ~~invention for which the application for protection was made in a convention country~~ basic application (as the case may be) if those

developments or additions are developments or additions for which the applicant would be entitled to make a separate patent 35

application under **subpart 4** nominated person would be entitled to the grant of a separate patent under this Act.

- (4) If a complete specification claims a new substance, the claim must not be construed as extending to that substance when found in nature. 5

Compare: 1953 No 64 s 10(1), (3), (4), (6), (7); Patents Act 1977 s 14(3), (5) (UK)

37A Amendment of complete specification before acceptance

- (1) Before the acceptance of a complete specification, the applicant may, in the prescribed manner, amend that specification. 10

- (2) Subsection (1) is subject to **section 32(5)**.

- (3) Subpart 8 applies in respect of amendments to a complete specification after the acceptance of the complete specification.

38 Supply of drawings 15

- (1) Drawings may be supplied for the purposes of any specification.
- (2) Drawings must be supplied for the purposes of a specification if the Commissioner requires drawings to be supplied.
- (3) Drawings supplied under this section form part of the specification unless the Commissioner directs otherwise. 20

Compare: 1953 No 64 s 10(2)

39 Specifications for micro-organisms

- (1) To the extent that an invention is a micro-organism, the complete specification complies with **section 37(1)(a) and (b)**, so far as those paragraphs require a description of the micro-organism, if, and only if, the deposit requirements specified in **section 40** are satisfied in relation to the micro-organism. 25

- (2) **Subsection (3)** applies if— 30

- (a) an invention involves the use, modification, or cultivation of a micro-organism, other than the micro-organism mentioned in **subsection (1)**; and
- (b) a person skilled in the relevant art in New Zealand could not reasonably be expected to perform the invention 35

- without having a sample of the micro-organism before starting to perform the invention; and
- (c) the micro-organism is not reasonably available to a person skilled in the relevant art in New Zealand.
- (3) The complete specification complies with **section 37(1)(a) and (b)**, to the extent that those paragraphs require a description of the micro-organism, if, and only if, the deposit requirements specified in **section 40** are satisfied in relation to the micro-organism. 5
- (4) For the purposes of this section and **section 42**, a micro-organism may be reasonably available to a person even if it is not so available in New Zealand. 10
- Compare: Patents Act 1990 s 41 (Aust)

40 Deposit requirements for micro-organisms

- (1) The deposit requirements are satisfied in relation to a micro-organism to which a specification relates if, and only if,— 15
- (a) the micro-organism was, on or before the filing date of the specification, deposited with a prescribed depositary institution in accordance with the rules relating to micro-organisms; and 20
- (b) the applicant for the patent provides to the Commissioner, within the prescribed period, a receipt for the deposit from the prescribed depositary institution; and
- (c) the specification includes, at the filing date of the specification, all relevant information on the characteristics of the micro-organism that is known to the applicant; and 25
- (d) at all times since the end of the prescribed period, the specification has included—
- (i) the name of a prescribed depositary institution from which samples of the micro-organism are obtainable as provided by the rules relating to micro-organisms; and 30
- (ii) the file, accession, or registration number of the deposit given by the institution; and 35
- (e) at all times since the filing date of the specification, samples of the micro-organism have been obtainable from

a prescribed depository institution as provided by those rules.

- (2) For the purposes of **subsection (1)(b)**, the receipt for the deposit must be in the prescribed form (if any).

Compare: Patents Act 1990 s 6 (Aust)

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41 Deposit requirements treated as satisfied in certain circumstances

- (1) This section applies if—

- (a) the requirements specified in **section 40(1)(d) or (e)** cease to be satisfied in relation to a micro-organism; and 10
- (b) steps are taken at a later time within the prescribed period in accordance with all applicable provisions of the regulations (if any); and
- (c) as a result of those steps, if the period during which those requirements are not satisfied is disregarded, those requirements would be satisfied at that later time. 15

- (2) If this section applies,—

- (a) the requirements specified in **section 40(1)(d) and (e)** must be treated as having been satisfied during the period mentioned in **subsection (1)(c)**; and 20
- (b) the provisions that are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention during that period. 25

Compare: Patents Act 1990 s 41(4) (Aust)

42 Micro-organism ceasing to be reasonably available

- (1) A patent may be revoked under **section 92 or subpart 11** on the ground referred to in **section 106(1)(c)** (which relates to complete specifications that do not comply with **section ~~37(1)~~ this subpart**) if— 30

- (a) the patent was granted for an invention that involves the use, modification, or cultivation of a micro-organism, other than a micro-organism mentioned in **section 39(1)**; and 35

- (b) the micro-organism was, at the filing date of the complete specification, reasonably available to a person skilled in the relevant art in New Zealand; and
 - (c) the micro-organism has ceased to be reasonably available to a person skilled in the relevant art in New Zealand. 5
- (2) This section does not limit **section 37(1)**.

Subpart 3—Treaty applications

43 Treaty application treated as application accompanied by complete specification 10

For the purposes of this Act, a Treaty application must be treated as a patent application accompanied by a complete specification.

Compare: 1953 No 64 s 26A

44 Description, claims, and drawings 15

- (1) The description, claims, and drawings (if any) contained in a Treaty application must be treated as a complete specification.
- (2) An indication, in relation to a deposited micro-organism given under rule ~~13bis.4~~ 13bis.4 of the Treaty regulations, in relation to a Treaty application, must be taken to be included in the description contained in the Treaty application even if the indication is contained in another document. 20

Compare: 1953 No 64 s 26B; Patents Act 1990 s 88(5) (Aust)

45 International filing date 25

A Treaty application must be treated as having been filed in New Zealand on its international filing date.

Compare: 1953 No 64 s 26C

46 Commissioner must provide international filing date in certain circumstances 30

- (1) The Commissioner must give an international application an international filing date if—
 - (a) a request contained in the international application specifies New Zealand as a designated State under Article 4(1)(ii) of the Patent Cooperation Treaty; and

- (b) 1 or more of the following applies:
 - (i) the receiving Office has refused to accord the international application an international filing date under Article 11(1) of the Patent Cooperation Treaty: 5
 - (ii) the receiving Office has declared that the international application is considered withdrawn:
 - (iii) the International Bureau has made a finding under Article 12(3) of the Patent Cooperation Treaty that the international application is considered withdrawn; and 10
 - (c) the Commissioner has decided under Article 25(2)(a) of the Patent Cooperation Treaty that the refusal or the declaration or the finding was the result of a mistake on the part of the receiving Office or the International Bureau. 15
- (2) The date given under **subsection (1)** must be the date of receipt of the application by the receiving Office under Article 11(1) of the Patent Cooperation Treaty.
- (3) If the date of receipt of the application by the receiving Office cannot be ascertained, the Commissioner may give the application an international filing date. 20
- (4) This Act applies to the application in accordance with this section.
- (5) This section does not apply to an international application that has been filed in a receiving Office in a language other than English, unless a translation of that application into English that has been verified to the satisfaction of the Commissioner has been provided to the Commissioner. 25
- Compare: 1953 No 64 s 26D 30
- 47 Amendments to documents forming part of complete specification**
- (1) **Subsection (2)** applies if an English translation of a Treaty application—
- (a) has been filed with the Commissioner; or 35
 - (b) has been published under Article 21 of the Patent Cooperation Treaty by the International Bureau.

- (2) The description, claims, and any matter associated with the drawings contained in the Treaty application must be treated for the purposes of this Act as having been amended, on the day the translation was filed, by substituting the translated documents for those originally filed. 5
- (3) The description, claims, and drawings contained in a Treaty application must be treated for the purposes of this Act as having been amended on the day that an amendment was made if—
- (a) the Treaty application has been amended under Article 19(1) of the Patent Cooperation Treaty; or 10
 - (b) the Treaty application has been amended under Article 34 of the Patent Cooperation Treaty, and New Zealand has been chosen by the applicant to be an elected State under Article 31(4)(a) of the Patent Cooperation Treaty 15 within the prescribed time limit.
- (4) If a Treaty application has been rectified under rule 91 of the Treaty regulations, the description, claims, and drawings contained in that Treaty application must be treated, for the purposes of this Act, as having been amended on the application's 20 international filing date.

Compare: 1953 No 64 s 26E

48 Treaty application void

- (1) A Treaty application must be treated as void for the purposes of this Act if— 25
- (a) an applicant withdraws the applicant's international application, or withdraws the application in relation to New Zealand as a designated State; or
 - (b) an international application is considered to be withdrawn in accordance with Article 12(3), 14(1)(b), 14(3)(a), or 14(4) of the Patent Cooperation Treaty; or 30
 - (c) the designation of New Zealand as a designated State is considered to be withdrawn in accordance with Article 14(3)(b) of the Patent Cooperation Treaty; or
 - (d) the applicant fails to fulfil the applicant's obligations 35 under Article 22(1) of the Patent Cooperation Treaty within the prescribed time limit; or

- (e) the applicant fails to fulfil the applicant's obligations under Article 39(1)(a) of the Patent Cooperation Treaty within the prescribed time limit.
- (2) **Subsection (1)(b) and (c)** are subject to Article 25 of the Patent Cooperation Treaty. 5
Compare: 1953 No 64 s 26F
- 49 Requirements for examination of Treaty application**
- (1) The Commissioner must not, in relation to a Treaty application, exercise the Commissioner's powers under **subpart 6** (which relates to examination of patent applications) until— 10
- (a) the applicant has fulfilled the applicant's obligations under Article 22(1) or 39(1) of the Patent Cooperation Treaty; and
- (b) the prescribed time limit has expired; and
- (c) if applicable, a translation of the international application into English has been filed with the Commissioner and verified to the satisfaction of the Commissioner; and
- ~~(d) all documents required to be filed under this Act and the regulations have been filed; and~~ 20
- (d) all prescribed documents have been filed; and
- (e) all fees required to be paid under this Act and the regulations have been paid.
- ~~(2) However, the Commissioner may, on the express request of the applicant, exercise the Commissioner's powers under **subpart 6** at any time.~~ 25
- (2) However, the Commissioner may exercise the Commissioner's powers under **subpart 6** at any time before all of the requirements in **subsection (1)** are satisfied if—
- (a) the applicant makes a request under **section 59B**; and 30
- (b) the Commissioner considers that it is desirable to exercise those powers despite the fact that 1 or more of those requirements have not been satisfied.
- (3) **Section 60** is subject to this section. 35
Compare: 1953 No 64 s 26G

Subpart 4—Convention applications

50 Convention applicants may make convention applications

- (1) ~~A convention applicant in relation to a basic application may make a convention application, or 2 or more of those convention applicants may make a joint convention application, within the period of 12 months from the day on which a basic application is first made in a convention country in respect of the invention.~~ 5
- (1) A convention applicant in relation to a basic application may make a patent application, or 2 or more of those convention applicants may make a joint patent application, in respect of the relevant invention within the period of 12 months from the day on which a basic application is first made in a convention country in respect of the invention. 10
- (1A) A patent application made under **subsection (1)** is a **convention application**. 15
- (2) For the purposes of this Act,—
- (a) the filing of a complete specification in a convention country after the filing of a provisional specification in relation to an application for protection must be treated as a basic application made in that country; and 20
- (b) a person must be treated as having made a basic application in a convention country in respect of an invention if the person has made an application for protection in respect of the invention by an application that,— 25
- (i) in accordance with the terms of a treaty subsisting between that convention country and any 1 or more other convention countries, is equivalent to a basic application duly made in any one of those convention countries; or 30
- (ii) in accordance with the law of that convention country, is equivalent to a basic application duly made in that convention country; and
- (c) a matter must be treated as having been disclosed in a basic application made in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or in documents submitted by the ~~convention appli-~~ 35

ent person who made the basic application in support of, and at the same time as, that application.

- (3) ~~Despite **subsection (2)(c)**, no account may be taken of any disclosure effected by any of the documents referred to in that paragraph unless a copy of the document is filed with the convention application or within the period as may be prescribed after the filing of that application.~~ 5
- (3) Despite **subsection (2)(c)**, if the Commissioner has given a written notice to the convention applicant requiring the convention applicant to file a copy of any or all of the documents referred to in that paragraph, account must not be taken of any disclosure in the document or those documents unless a copy of the document or documents is filed within the prescribed period after the Commissioner has given the notice. 10

51 How convention applications are made and dealt with 15

- (1) A convention application must be made and dealt with in the same manner as any other patent application.
- (2) However, a patent application that is a convention application must—
 - (a) include the prescribed information relating to the relevant basic application; and
 - (b) be accompanied by a complete specification in accordance with **section 34(1)**; and
 - (c) be made and dealt with in accordance with any other additional or different requirements prescribed for convention applications by this Act or regulations. 25

52 Withdrawn, abandoned, or refused basic applications

For the purposes of this Act, if more than 1 basic application has been made for an invention, a previously filed basic application (**basic application A**) must be disregarded and a subsequently filed basic application (**basic application B**) must be substituted for basic application A if— 30

- (a) basic application A was made in, or in respect of, the same convention country and by the same applicant as basic application B; and 35

- (b) not later than the ~~filing~~ date of filing of basic application B, basic application A was unconditionally withdrawn, abandoned, or refused; and
- (c) basic application A had not been made available to the public in New Zealand or elsewhere before its unconditional withdrawal, abandonment, or refusal; and 5
- (d) no rights remain outstanding in respect of basic application A; and
- (e) basic application A has not served to establish a right of priority in relation to another application in any convention country. 10

Compare: 1953 No 64 s 7(2A)

53 Basic applications for 2 or more cognate inventions

- (1) If basic applications have been made in 1 or more convention countries for 2 or more inventions that are cognate or of which one is a modification of another, a single convention application may be made for those inventions at any time within 12 months from the date of the earliest of the basic applications. 15
- (2) Despite **subsection (1)**, the requirements of **section 51(2)(a)** apply separately to the basic applications for each of the inventions referred to in **subsection (1)**. 20

Subpart 5—Priority dates

54 Priority date of claims of complete specification

- (1) Every claim of a complete specification has effect from the date prescribed by this subpart as the priority date of that claim. 25
- (2) A patent is not invalidated—
 - (a) by reason only that the invention, so far as claimed in a claim, has been made available to the public (whether in New Zealand or elsewhere) on or after the priority date of the claim by written or oral description, by use, or in any other way; 30
 - (b) by the grant of another patent on a specification claiming the same invention in a claim of the same or a later priority date.

Compare: 1953 No 64 s 11(1)

35

55 Priority date if complete specification filed for single application

The priority date of a claim is the filing date of the patent application if—

- (a) the complete specification is filed for a single application that was accompanied by a provisional specification or by a specification that is treated as a provisional specification; and 5
- (b) the claim is ~~fairly based on~~ supported by the matter disclosed in that provisional specification. 10

Compare: 1953 No 64 s 11(2)

56 Priority date if complete specification filed for 2 or more applications

(1) This section applies if—

- (a) the complete specification is filed or proceeded with in relation to 2 or more patent applications that were accompanied by provisional specifications or by specifications that are treated as provisional specifications; and 15
- (b) the claim is ~~fairly based on~~ supported by the matter disclosed in at least 1 of those provisional specifications. 20

(2) The priority date of the claim is the filing date of the patent application that is accompanied by the specification that ~~first disclosed the matter on which the claim is fairly based~~ disclosed the matter that supports the claim (or, if there is more than 1 application accompanied by such a specification, the filing date of the earliest of them). 25

Compare: 1953 No 64 s 11(3)

57 Priority date for convention applications

(1) This section applies if the complete specification is filed for a convention application and the claim is fairly based on the matter disclosed— 30

- (a) in the application for protection in a convention country; or
- (b) if the convention application is founded on more than 1 application for protection in a convention country, in at least 1 of those applications for protection. 35

- (2) ~~The priority date of the claim is the date of the relevant application for protection that first disclosed the matter on which the claim is fairly based.~~

~~Compare: 1953 No 64 s 11(4)~~

57 Priority date for convention applications 5

- (1) This section applies if the complete specification is filed for a convention application and the claim is supported by the matter disclosed—

(a) in the basic application; or

(b) if the convention application is founded on more than 1 basic application, in at least 1 of those basic applications. 10

- (2) The priority date of the claim is the date of the basic application that disclosed the matter that supports the claim (or, if there is more than 1 such basic application, the date of the earliest of them). 15

~~Compare: 1953 No 64 s 11(4)~~

58 Priority date for Treaty applications

- (1) This section applies if—

(a) the patent application that relates to the complete specification that contains the claim is a Treaty application; and 20

(b) that Treaty application claims the priority of an earlier application under Article 8 of the Patent Cooperation Treaty; and 25

(c) that earlier application is—

(i) an application made in New Zealand not more than 12 months before the international filing date of the Treaty application; or

(ii) ~~an application for protection~~ a basic application for an invention, made in a convention country not more than 12 months before the international filing date of the Treaty application, that is the first application made in a convention country for the invention; or 30 35

(iii) ~~an application for protection~~ a basic application for an invention made in a convention country

- after an application referred to in **subparagraph (ii)**; and
- (d) the claim is ~~fairly based on~~ supported by the matter disclosed in that earlier application or in a specification filed for that earlier application. 5
- (2) ~~The priority date of the claim is,—~~
- (a) ~~if the claim is fairly based on the matter disclosed in that earlier application, the filing date of that application; or~~
 - (b) ~~in any other case, the filing date of the specification for the earlier application that first disclosed the matter on which the claim is fairly based.~~ 10
- (2) The priority date of the claim is,—
- (a) if the claim is supported by the matter disclosed in the earlier application, the date of filing of that application; 15
 - or
 - (b) in any other case, the date of filing of the specification for the earlier application that disclosed the matter that supports the claim (or, if there is more than 1 such specification, the date of filing of the earliest of them).
- (3) For the purposes of **subsection (2)**, **date of filing** means,— 20
- (a) in the case of the earlier application being an application made in New Zealand, the date that the earlier application or specification for the earlier application (as the case may be) is filed in New Zealand;
 - (b) in any other case, the date that the earlier application or specification for the earlier application (as the case may be) is filed in the convention country. 25

59 Rules that apply if 2 or more priority dates apply or other rules do not apply

- (1) If, under **sections 56 to 58**, a claim would, but for this provision, have 2 or more priority dates, the priority date of that claim is the earlier or earliest of those dates. 30
 - (2) If **sections 55 to 58** do not apply to any case, the priority date of a claim is the filing date of the complete specification. 35
- Compare: 1953 No 64 s 11(5), (6)

59A **Priority date in case of lack of entitlement in respect of another patent application**

- (1) This section applies if—
- (a) a patent application (**application A**) is made for an invention that has been claimed in a complete specification filed in relation to another patent application (**application B**); and 5
- (b) 1 or more of the following applies:
- (i) the Commissioner has refused to grant a patent in relation to application B on the ground specified in **section 87A(1)(b)** (whether in a re-examination or an opposition proceeding under **subpart 9**): 10
- (ii) the patent granted in relation to application B has been revoked by the court or the Commissioner on the ground specified in **section 106(1)(b)**: 15
- (iii) the complete specification filed in relation to application B has, in a re-examination or an opposition proceeding under **subpart 9** or a proceeding under **subpart 11**, been amended by the exclusion of the claim relating to the invention as a result of a finding by the Commissioner that the nominated person or the patentee is not entitled to the patent. 20
- (2) The Commissioner may direct that application A and any specification filed in relation to it must, for the purposes of this subpart, be treated as having been filed on the date on which the corresponding document was filed, or is treated as having been filed, in relation to application B. 25
- Compare: 1953 No 64 s 62 30

Subpart 6—Examination

59B **Request for examination**

- (1) The applicant may, in the prescribed manner, ask for an examination of the patent application and the complete specification relating to the application. 35
- (2) The Commissioner may, on 1 or more of the prescribed grounds and in the prescribed manner, direct the applicant to

ask, within the prescribed period, for an examination of the patent application and the complete specification relating to the application.

- (3) If the patent application and the complete specification relating to the application are open to public inspection, any person may, in the prescribed manner, require the Commissioner to give a direction under **subsection (2)**. 5
- (4) However, a person may not act under **subsection (3)** if the application is a Treaty application and the requirements in **section 49(1)** have not been satisfied. 10
- (5) If required under **subsection (3)**, the Commissioner must give a direction accordingly, unless the applicant has already asked, or been directed to ask, for an examination of the patent application and the complete specification relating to the application. 15
- (6) If the Commissioner gives a direction under this section, the patent application must be treated as having been abandoned if the applicant does not ask, within the prescribed period, for an examination of the patent application and the complete specification relating to the application. 20

Compare: Patents Act 1990 s 44 (Aust)

60 Examination

- (1) The Commissioner must examine a patent application and the complete specification relating to the application and report on— 25
 - (a) whether the specification complies with **subpart 2** (which relates to specification requirements); and
 - (b) whether, to the best of the Commissioner’s knowledge, the invention, so far as claimed, is a patentable invention under **section 13**; and 30
 - (c) all other matters (if any) that are prescribed.
- (1) The Commissioner must, after being asked to do so under **section 59B**, examine a patent application and the complete specification relating to the application, and report on—
 - (a) whether the Commissioner is satisfied, on the balance of probabilities, that— 35

- (i) the application and the specification comply with the requirements of this Act and of the regulations; and
- (ii) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this subparagraph; and 5
- (iii) the invention, so far as claimed, is a patentable invention under **section 13**; and
- (iv) there is no other lawful ground of objection to the grant of a patent in respect of the application; and 10
- (b) all other matters (if any) that are prescribed.
- (2) The examination must be carried out in the prescribed manner.
- (3) The Commissioner must give a copy of the report to the applicant after it is issued. 15
- Compare: Patents Act 1990 s 45 (Aust)

61 Commissioner may refuse to proceed with application or require application or specification to be amended

- (1) ~~This section applies if, after examining under **section 60** a patent application and any specification filed in relation to the application, the Commissioner reports that—~~ 20
- (a) ~~the application or any of those specifications do not comply with the requirements of this Act or of the regulations; or~~
- (b) ~~the invention, so far as claimed, is not a patentable invention under **section 13**; or~~ 25
- (c) ~~there is any other lawful ground of objection to the grant of a patent in respect of the application.~~
- (1) This section applies if, after examining under **section 60** a patent application and the complete specification relating to the application, the Commissioner reports that he or she is not satisfied as to any of the matters specified in **section 60(1)(a).** 30
- (2) The Commissioner—
- (a) must state the grounds of objection when reporting on an examination; and 35
- (b) may—
- (i) refuse to proceed with the patent application; or

- (ii) require the applicant to amend the patent application or any specification before the Commissioner proceeds with the application.

62 Applicants must act by deadline if deadline set by Commissioner

5

(1) If the Commissioner has acted under **section 61(2)(b)(ii)**, the applicant must, by the deadline set by the Commissioner (if any),—

- (a) respond to the report; and
- (b) take reasonable steps to ensure that the response is a substantive response.

10

(2) After each response, the Commissioner may issue a further report under **section 60**, and, if the Commissioner still believes that 1 or more of the following applies, the Commissioner may act under **section 61**—

15

- (a) the patent application or any specification filed in relation to the application does not comply with the requirements of this Act or of the regulations;
- (b) the invention, so far as claimed, is not a patentable invention under **section 13**;
- (c) there is any other lawful ground of objection to the grant of a patent in respect of the application.

20

(3) If the Commissioner has issued a further report under **section 60** and acted under **section 61**, the applicant must, by the deadline set by the Commissioner (if any),—

25

- (a) respond to the report; and
- (b) take reasonable steps to ensure that the response is a substantive response.

(1) If the Commissioner has acted under **section 61(2)(b)**, the applicant must, by the deadline (if any) set by the Commissioner, make a substantive response to the report.

30

(2) After each response, the Commissioner may issue a further report under **section 60**, and, if the Commissioner is still not satisfied as to any of the matters specified in **section 60(1)(a)**, the Commissioner may act under **section 61**.

35

(3) If the Commissioner has issued a further report under **section 60** and acted under **section 61(2)(b)**, the applicant must, by

the deadline (if any) set by the Commissioner, make a substantive response to the report.

(4) The Commissioner must set deadlines (if any) in the prescribed manner.

(4A) The Commissioner may extend any deadlines in the prescribed manner. 5

(5) For the purposes of this section, a **substantive response** is a response that, in the opinion of the Commissioner,—

(a) gives a fair and substantial answer to the report issued by the Commissioner; or 10

(b) gives a fair and substantial answer to the report issued by the Commissioner and amends the application or specification to remove 1 or more of the grounds of objection raised by the Commissioner in the report; or

(c) amends the application or specification to remove all of the grounds of objection raised by the Commissioner in the report. 15

63 Application treated as abandoned if applicant fails to act within set deadline

A patent application must be treated as having been abandoned if ~~the Commissioner is satisfied that~~ the applicant has failed to comply with **section 62**. 20

64 Commissioner must examine amended specification

(1) The Commissioner must examine an amended complete specification in the same manner as the original specification if the specification is amended following the issue of a report under **section 60**. 25

(2) **Subsection (1)** does not apply after the complete specification is accepted.

Compare: 1953 No 64 s 18(2)

30

65 Duty to inform Commissioner of search results

(1) The applicant must, ~~in the prescribed manner, inform the Commissioner~~ if required by the Commissioner, inform the Commissioner, in the prescribed manner, of the results of any documentary searches by, or on behalf of, a foreign patent office 35

carried out for the purpose of assessing the patentability of an invention disclosed in the complete specification or a corresponding application filed outside New Zealand.

- (2) **Subsection (1)**—
 - (a) does not apply to a search if the search is prescribed as a type of search to which this section does not apply; and 5
 - (b) applies only to searches completed before the grant of the patent.
- (3) A search is completed on the earliest of—
 - (a) the date, if any, specified in the search report as the date that the report was issued; and 10
 - (b) the date, if any, specified in the search report as the date that the search was completed; and
 - (c) the date that the search results were issued to the applicant or patentee by the foreign patent office. 15
- (4) In this section, **foreign patent office** means an office, organisation, or other body that may grant protection in respect of an invention in a country outside New Zealand.
 Compare: Patents Act 1990 s 45(3) (Aust)

- 66 Consequences of breach of duty** 20
 An amendment of a complete specification relating to a patent is not allowable and must not be made if—
 - (a) the patentee or the patentee’s predecessor in title breaches or breached **section 65** in relation to the patent; and 25
 - (b) the effect of the proposed amendment would be to remove a lawful ground of objection in relation to **section 43(b)** to the specification arising from the existence of some or all of the information not provided under **section 65**. 30

Subpart 7—Acceptance and publication

Time for putting application in order for acceptance

- 67 Time for putting application in order for acceptance**
- (1) A patent application is void unless, within the prescribed period, the applicant ensures that— 35

- (a) the application and the complete specification comply with the requirements of this Act and of the regulations; and
- (ab) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this paragraph; and 5
- (b) the invention, so far as claimed, is a patentable invention under **section 13**; and
- (c) there is no other lawful ground of objection to the grant of a patent in respect of the application. 10
- (2) Deadlines, or extensions of deadlines, set by the Commissioner under **section 62** cannot extend the prescribed period under **subsection (1)**.
- (3) Nothing in this section limits the power of the Commissioner to treat a patent application as having been abandoned under **section 63** (which relates to treating an application as abandoned). 15

Compare: 1953 No 64 s 19(1), (1A)

68 Time may be extended if appeal pending or possible

- (1) This section applies if, at the expiry of the prescribed period under **section 67**,— 20
- (a) an appeal to the court is pending under any of the provisions of this Act in respect of the patent application; or
- (b) an appeal to the court is pending under any of the provisions of this Act, in the case of an application for a patent of addition, in respect of either that application or the patent application for the main invention; or 25
- (c) the time within which an appeal referred to in **paragraph (a) or (b)** may be brought under **section 261(2)(b)(i)** has not expired. 30
- (2) The court may extend the period that applies under **section 67** if an appeal referred to in **subsection (1)(a) or (b)** is pending or is brought within the time referred to in **subsection (1)(c)** or before the expiry of any extension of that time granted (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiry of the last previous extension. 35

- (3) If no appeal referred to in **subsection (1)(a) or (b)** is pending or is so brought, the period that applies under **section 67** continues until the end of the time referred to in **subsection (1)(c)**, or, if any extension of that time is granted, until the expiry of the extension or last extension so granted. 5

Compare: 1953 No 64 s 19(3)

68 Time may be extended if appeal pending or possible

- (1) This section applies if, at the expiry of the prescribed period under **section 67**,—

- (a) an appeal to the court is pending under **section 261** in respect of the patent application (or, in the case of an application for a patent of addition, either in respect of that application or in respect of the patent application for the main invention); or 10
- (b) the 20-working-day period within which an appeal referred to in **paragraph (a)** may be brought under **section 261(2)(b)(i)** has not expired. 15

- (2) The court may extend the period that applies under **section 67** until the date that the court thinks fit if an appeal referred to in **subsection (1)(a)**— 20

- (a) is pending; or
- (b) is brought within the time referred to in **subsection (1)(b)**; or
- (c) is brought before the expiry of any extension of the time for bringing an appeal allowed by the court under **section 261(2)(b)(ii)**,— 25
- (i) in the case of a first extension, on an application for an extension made within the time referred to in **subsection (1)(b)**; or
- (ii) in the case of a subsequent extension, on an application for an extension made before the expiry of the last previous extension. 30

- (3) If no appeal referred to in **subsection (1)(a)** is pending or is so brought, the period that applies under **section 67** continues— 35

- (a) until the end of the time referred to in **subsection (1)(b)**; or

- (b) if any extension of the time for bringing an appeal is allowed by the court as referred to in **subsection (2)(c)**, until the expiry of the extension or last extension that is allowed.

Compare: 1953 No 64 s 19(3)

5

69 Notice of entitlement must be filed before acceptance

- (1) The applicant must file, in the prescribed manner, a notice stating the grounds on which the nominated person is entitled to be granted the patent under **section 21**—
- (a) before the expiry of the prescribed period under **section 67**; or 10
- (b) before the expiry of the extension or last extension under **section 68** (if the prescribed period under **section 67** is extended under that section).
- (2) For the purposes of this Act, the applicant may be taken to be the nominated person. 15
- (3) However, if the applicant is not the nominated person or is not the only nominated person, the applicant must identify all of the nominated persons in the notice referred to in **subsection (1)**. 20
- (4) **Subsection (2)** does not limit **subsection (1)**.
- (5) A patent application is void if the applicant does not comply with this section.

Acceptance

- 70 Acceptance of complete specification** 25
- (1) The Commissioner must, after the applicant has complied with the requirements referred to in **sections 67(1) and 69**, accept the complete specification relating to a patent application if the Commissioner is satisfied, on the balance of probabilities, that— 30
- (a) the application and the specification comply with the requirements of this Act and of the regulations; and
- (ab) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this paragraph; and 35

- (b) the invention, so far as claimed, is a patentable invention under **section 13**; and
 - (c) there is no other lawful ground of objection to the grant of a patent in respect of the application.
- (2) The Commissioner must, after acceptance of a complete specification,— 5
- (a) give notice of the acceptance to the applicant; and
 - (b) publish the acceptance in the journal.
- (3) For the purposes of this Act, **date of the publication of the accepted complete specification** means the date of publication 10 of the journal containing the publication under **subsection (2)(b)**.
- (4) This section is subject to **sections 67, 68, and 71**.
Compare: 1953 No 64 s 20(1), (2)

71 Applicant may request Commissioner to postpone acceptance 15

- (1) The applicant may give notice to the Commissioner requesting the Commissioner to postpone acceptance of the complete specification until a date that is specified in the notice.
- (2) The date specified in the notice must not be a date that is after 20 the prescribed period.
- (3) The Commissioner may postpone acceptance under **section 70** if a notice is given under this section.
Compare: 1953 No 64 s 20(1)

Publication 25

72 Publication

- (1) The Commissioner must publish a notice in the journal that a complete specification is open to public inspection if—
 - (a) the specification has been filed for a patent application that is not a Treaty application; and 30
 - (b) a period of 18 months after the earliest priority date claimed in respect of the patent application has ended; and
 - (c) the specification is not already open to public inspection. 35

- (2) **Subsection (1)** does not apply if the patent application is void or has been abandoned.
- (3) If a complete specification filed in respect of a patent application (other than a Treaty application) has not become open to public inspection, the Commissioner must, if asked to do so by the applicant, publish, in the prescribed manner, a notice in the journal that the complete specification is open to public inspection. 5
- (4) If **section 39(2)** applies to a specification, the applicant may not make a request under **subsection (3)** in relation to the specification unless the specification includes the particulars mentioned in **section 40(1)(d)**. 10

Compare: Patents Act 1990 s 54(1)–(3) (Aust)

73 **Publication in case of divisional applications made as provided for in section 33** 15

- (1) The Commissioner must publish a notice in the journal that a complete specification filed for a fresh divisional application is open to public inspection if—
- (a) the fresh divisional application is ~~not a Treaty application~~ and is made in respect of ~~an original~~ a parent application (whether or not the ~~original parent~~ application is a Treaty application); and 20
- (b) the complete specification filed for the ~~original parent~~ application was open to public inspection when the fresh divisional application was made. 25
- (2) **Subsection (3)** applies if a fresh divisional application (~~other than a Treaty application~~) is made in respect of ~~an original~~ a parent application that is not a Treaty application and—
- (a) a notice is published in the journal that the complete specification filed for the ~~original parent~~ application is open to public inspection; or 30
- (b) a notice is published in the journal that the complete specification filed for the fresh divisional application is open to public inspection.
- (3) The Commissioner must also publish in the journal a notice that,— 35

- (a) if **subsection (2)(a)** applies, the complete specification filed for the ~~fresh~~ divisional application is open to public inspection; or
 - (b) if **subsection (2)(b)** applies, the complete specification filed for the ~~original~~ parent application is open to public inspection. 5
- (4) The Commissioner must also publish in the journal a notice that the complete specification filed for a fresh application is open to public inspection if—
- (a) the fresh application is an application other than a Treaty application and is made in respect of an original application that is a Treaty application; and 10
 - (b) a notice is published in the journal that the complete specification filed for the original application is open to public inspection. 15
- (5) For the purposes of this section,—
- fresh divisional application** means a ~~fresh patent~~ divisional application referred to in **section 33**
- original parent application** means the ~~original patent~~ parent application referred to in **section 33**. 20
- Compare: Patents Act 1990 s 54(4)—(6), (5) (Aust)

74 Documents open to public inspection

- (1) If a notice is published under **section 72 or 73**, the specification concerned, and the other documents (if any) that are prescribed, are open to public inspection. 25
- (2) If acceptance of a complete specification is published under **section 70(2)(b)** in relation to a patent application, the following documents (being documents that have not already become open to public inspection) are open to public inspection:
 - (a) all documents (other than prescribed documents) filed in relation to the application or the patent, whether before or after the acceptance or grant: 30
 - (b) all documents (other than prescribed documents) filed, after the patent ceases, expires, or is revoked, in relation to the former patent: 35
 - (c) copies of all documents relating to the application or patent (other than prescribed documents) given by the

Commissioner to the applicant or patentee, or the former applicant or patentee.

- (3) A specification, or other document, must be taken to have been made available to the public on the day on which it becomes open to public inspection unless it has been made available to the public (whether in New Zealand or elsewhere) otherwise before that day. 5
- (4) **Subsection (3)** is subject to **section 75**.
Compare: Patents Act 1990 s 55 (Aust)

75 Publication of Treaty applications 10

- (1) A Treaty application must be taken to have become open to public inspection, and to have been made available to the public, on the date that it is published under Article 21 of the Patent Cooperation Treaty.
- (2) On and after the date on which the requirements in **section 49** are satisfied in relation to a Treaty application, the documents (if any) that are prescribed are open to public inspection. 15

76 Certain documents not to be published

- (1) Except as otherwise provided by or under this Act, documents of the kind mentioned in **section 74 or 75**— 20
- (a) must not be published by the Commissioner or be open to public inspection; and
- (ab) must not be published before the document is open to public inspection by any person to whom the Commissioner provides the document in the performance of his or her functions; and 25
- (b) are not liable to be inspected or produced before the Commissioner or in a legal proceeding unless the Commissioner, court, or any person having power to order inspection or production, directs that the inspection or production be allowed. 30
- (2) **Subsection (1)** does not prevent—
- (a) the Commissioner from publishing the date and number of a patent application and any details of the patent application and invention that are required to be given in or with the patent application ~~form~~. 35

- (b) documents of the kind mentioned in **section 74 or 75** being published by the Commissioner and becoming open to public inspection with the consent of the applicant.
- (3) Notice of an application for the production in legal proceedings of a document of the kind mentioned in **section 74 or 75** must be given to the Commissioner, who is entitled to be heard on the application. 5
- (4) ~~The reports of the Commissioner on the examination of a patent application or specification must not, before the acceptance of the complete specification,—~~ 10
 - (a) ~~be published by the Commissioner or be open to public inspection; or~~
 - (b) ~~be inspected or produced in any legal proceeding unless the court, or any person having power to order inspection or production in the proceeding, certifies that it is desirable that the production or inspection be allowed in the interests of justice.~~ 15
- (5) A request for information under the Official Information Act 1982 may be refused by the Commissioner or the Ministry, as contrary to this Act, if, ~~and to the extent that,~~ it would require documents of the kind mentioned in ~~subsection (1) or (4)~~ **section 74 or 75**, or information in connection with those documents, to be made available before those documents are open to public inspection. 20 25
 Compare: 1953 No 64 s 91(2); Patents Act 1990 s 56 (Aust)

77 Effect of publication of complete specification

- (1) After a complete specification relating to a patent application has become open to public inspection and until a patent is granted on the application, the nominated person has the same privileges and rights as the nominated person would have had if a patent for the invention had been granted on the day when the specification became open to public inspection under **sections 72 to 75**. 30
- (2) **Subsection (1)** does not give the nominated person the right to commence proceedings in respect of any act unless— 35
 - (a) a patent is granted on the patent application; and

- (b) ~~the act would, if done after the grant of the patent, have constituted an infringement of a claim of the specification.~~
- (2) The nominated person is entitled to bring a proceeding by virtue of this section in respect of an act only— 5
- (a) after the patent has been granted; and
- (b) if the act would, if the patent had been granted on the day referred to in **subsection (1)**, have infringed both—
- (i) the patent; and 10
- (ii) the claims (as interpreted by the description and any drawings that form part of the complete specification) in the form in which they were contained in the complete specification immediately before it became open to public inspection. 15
- (3) If it is alleged that an infringement has occurred in the period commencing with the date on which the complete specification became open to public inspection and ending with the date that the patent is granted, the period of limitation for taking an action for that infringement is the later of— 20
- (a) 6 years from the date of the alleged infringement; or
- (b) 3 years from the date of the grant of the patent.
- (4) **Subsection (3)** applies despite anything to the contrary in the Limitation Act 1950. 25
- Compare: 1953 No 64 s 20(4), (5); Patents Act 1990 s 57(1), (3) (Aust); Patents Act 1977 s 69(2) (UK)

78 Defence for period between complete specification becoming open to public inspection and acceptance

- (1) It is a defence to proceedings under **section 77(1)** in respect of an act done during the specified period if the defendant proves that a patent could not validly have been granted in respect of the claims (as framed when the act was done) that are alleged to have been infringed by the doing of the act. 30
- (2) An act is done during the specified period if it is done— 35
- (a) after the complete specification referred to in **section 77(1)** became open to public inspection; and
- (b) before that complete specification was accepted.
- Compare: Patents Act 1990 s 57(4) (Aust)

78 Court must consider whether it would be reasonable to expect that patent would be granted

- (1) In a proceeding under **section 77**, the court must, in considering the amount of damages or an account of profits for an infringement, consider whether or not it would have been reasonable to expect, from a consideration of the complete specification that became open to public inspection, that a patent would be granted that would confer on the patentee protection from an act of the same description as that found to infringe the rights conferred by that section. 5
- (2) If the court finds that it would not have been reasonable, the court must reduce the damages, or the amount of an account of profits, to an amount that it thinks just. 10

Compare: Patents Act 1977 s 69(3) (UK)

Subpart 8—Amendment of specifications after acceptance 15

79 General rules concerning amendments of specifications after acceptance

- (1) After the acceptance of a complete specification, an amendment to that specification is not allowable and must not be made, ~~except for the purpose of correcting an obvious mistake,~~ if the effect of the amendment is that— 20
- (a) the specification as amended would claim or describe matter that was not in substance disclosed in the specification before the amendment; or 25
- (b) a claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.
- (1A) **Subsection (1)** does not apply to an amendment for the purpose of correcting an obvious mistake made in, or in relation to, a complete specification. 30
- (2) If, after the date of the publication of the accepted complete specification, any amendment of the specification is allowed by the Commissioner or the court,—
- (a) the right of the patentee or applicant to make the amendment must not be called into question except on the ground of fraud; and 35

- (b) the amendment must, in all courts and for all purposes, be treated as forming part of the specification.
- (3) However, in construing the specification as amended, reference may be made to the specification as originally published.
Compare: 1953 No 64 s 40(1), (2) 5
- 80 Amendment must be published in journal**
If, after the date of the publication of the accepted complete specification, any amendment of the specification is allowed under **sections 81 to 85**, the fact that the specification has been amended must be published in the journal. 10
Compare: 1953 No 64 s 40(3)
- 81 Amendment of specification with leave of Commissioner**
- (1) The Commissioner may, on a request made under this section by a patentee, or by an applicant for a patent at any time after the acceptance of the complete specification, allow the complete specification to be amended subject to any conditions that the Commissioner thinks fit. 15
- (2) However, the Commissioner must not allow a specification to be amended on a request made under this section while any relevant proceeding is pending. 20
- (3) Every request for leave to amend a specification under this section must—
- (a) state the nature of the proposed amendment; and
- (b) give full particulars of the reasons for the request; and
- (c) be made in the prescribed manner (if any). 25
- (4) This section is subject to **section 79** (which contains general rules about amendments of specifications).
Compare: 1953 No 64 s 38(1), (2)
- 82 Request for leave to amend must be published in journal**
- (1) Every request for leave to amend a specification under **section 81**, and the nature of the proposed amendment, must be published in the journal. 30
- (2) However, if the request is made before the date of the publication of the accepted complete specification, the Commissioner may, if the Commissioner thinks fit, dispense with publication 35

under **subsection (1)** or direct that publication be postponed until the date of the publication of the accepted complete specification.

Compare: 1953 No 64 s 38(3)

- 83 Opposition to proposed amendment** 5
- (1) Any person may give notice to the Commissioner of opposition to a proposed amendment within the prescribed period after the publication of a request under **section 82**.
- (2) If a notice is given within the prescribed period, the Commissioner must— 10
- (a) notify the person who made the request under **section 81**; and
- (b) give that person and the opponent a reasonable opportunity to be heard before the Commissioner decides the case. 15
- Compare: 1953 No 64 s 38(4)
- 84 Provisions concerning amendments with leave of Commissioner do not apply in certain circumstances**
- Sections 81 to 83** do not apply in relation to any amendment of a specification effected— 20
- (a) on a reference to the Commissioner of a dispute as to the infringement or validity of a claim; or
- (b) ~~in accordance with any provision of this Act that authorises the Commissioner to revoke a patent, or to refuse to grant a patent, unless the specification is amended to the Commissioner's satisfaction.~~ 25
- (b) in accordance with any of **sections 91(2), 92(2), and 105(4)(b)**.
- Compare: 1953 No 64 s 38(6)
- 85 Amendment of specification with leave of court** 30
- (1) In any relevant proceeding in relation to a patent, the court may, by order, allow the patentee to amend the patentee's complete specification in the manner and subject to the terms as to costs, publication, or otherwise that the court thinks fit.
- (2) If, in any proceedings for the revocation of a patent, the court decides that the patent is invalid, the court may allow the spe- 35

cification to be amended under this section instead of revoking the patent.

- (3) If an application for an order under this section is made to the court,—
- (a) the applicant for that order must give notice of the application to the Commissioner; and 5
- (b) the Commissioner may appear and be heard on the application; and
- (c) the Commissioner must appear if he or she is directed by the court to appear. 10
- (4) This section is subject to **section 79** (which contains general rules about amendments of specifications). 10
- Compare: 1953 No 64 s 39

Subpart 9—Assertions by third parties, opposition, and re-examinations 15

Assertions by third parties within prescribed period

86 Assertions by third parties on novelty and inventive step

- (1) ~~Any~~ person may, within the prescribed period after a complete specification becomes open to public inspection but before the date of the publication of the accepted complete specification, notify the Commissioner, in the prescribed manner (if any), that the person asserts that the invention, so far as claimed in a claim, is not a patentable invention because it does not comply with **section 13(b)** (which relates to the requirement for the invention to be novel and involve an inventive step). 20 25
- (2) The notice must state the reasons for the person's assertion.
- (3) The notice and any documents accompanying it are open to public inspection. 30

Compare: Patents Act 1990 s 27(1), (4) (Aust)

87 Commissioner must consider and deal with notice in prescribed manner

- (1) The Commissioner must inform the applicant in writing of any matter of which the Commissioner is notified under **section** 35

86 and send the applicant a copy of any document accompanying the notice.

- (2) The Commissioner must otherwise consider and deal with a notice under **section 86** in the prescribed manner.

Compare: Patents Act 1990 s 27(2), (3) (Aust)

5

Opposition to grant of patent

87A Opposition to grant of patent

- (1) Any person may, in the prescribed manner, oppose the grant of a patent on 1 or more of the following grounds:

(a) that the invention, so far as claimed in a claim, is not a patentable invention under **section 13**: 10

(b) that the nominated person is not entitled to the patent:

(c) that the complete specification does not comply with **subpart 2** (which relates to specification requirements): 15

(d) that the applicant is attempting, or has attempted, to obtain the grant of a patent by fraud, false suggestion, or a misrepresentation:

(e) that the invention, so far as claimed in a claim, was secretly used in New Zealand before the priority date of that claim: 20

(f) that granting the patent would be contrary to law.

- (2) For the purposes of **subsection (1)(a)**, account must not be taken of any secret use of the invention.

- (3) For the purposes of **subsection (1)(e)**, account must not be taken of any use of the invention— 25

(a) for the purpose of reasonable trial or experiment only if the trial or experiment is conducted by, on behalf of, or with the consent of the nominated person or any person from whom the nominated person derives title; or 30

(b) by a government department or any person authorised by a government department, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention directly or indirectly to that department or person; or 35

- (c) by any other person, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention to that person in confidence if the use of the invention is without the consent of the nominated person or of any person from whom the nominated person derives title. 5

87B Hearing and decision by Commissioner

If the grant of a patent is opposed, the Commissioner must—

- (a) give the applicant and the opponent a reasonable opportunity to be heard before deciding a case; and 10
- (b) consider whether any of the following grounds are established on the balance of probabilities:
- (i) any ground set out in **section 87A** that is relied upon by the opponent;
- (ii) any other ground set out in **section 87A** that the Commissioner has decided to take into account (whether relied upon by the opponent or not); and 15
- (c) otherwise decide and deal with the case in the prescribed manner.

Re-examination after acceptance 20

88 Re-examination of complete specification before patent is granted

- (1) The Commissioner may, and must if requested to do so by any person, re-examine a ~~complete specification~~ patent application and the complete specification relating to the application on or after the date of the publication of the accepted complete specification if the patent has not been granted. 25
- (2) A request under **subsection (1)** must be made in the prescribed manner (if any).
- (2) A request under **subsection (1)** must— 30
- (a) specify 1 or more of the grounds set out in **section 87A** that the person wants the Commissioner to consider; and
- (b) be made in the prescribed manner (if any).

89 Re-examination of complete specification after patent is granted

- (1) If a patent has been granted, the Commissioner may, and must if requested to do so by any person, re-examine the ~~complete specification~~ patent application and the complete specification relating to the application. 5
- (2) A request under **subsection (1)** must—
- (a) specify 1 or more of the grounds set out in **section 106** that the person wants the Commissioner to consider; and 10
- (b) be made in the prescribed manner (if any).
- (2) **Subsection (1)** does not apply if—
- (a) a relevant proceeding in relation to the patent is pending; or
- (b) an application for the revocation of the patent has been made to the Commissioner under **section 104** and the Commissioner has not yet made a decision on that application. 15
- (3) A request under **subsection (1)** must be made in the prescribed manner (if any). 20
- (4) If the Commissioner has started to re-examine a complete specification relating to a patent under **subsection (1)**, the Commissioner must not continue the re-examination if—
- (a) a relevant proceeding in relation to the patent is commenced and the Commissioner has received notification of the commencement of that proceeding; or 25
- (b) an application for the revocation of the patent has been made to the Commissioner under **section 104** and the Commissioner has not yet made a decision on that application. 30
- (5) The Commissioner must re-examine the ~~complete specification~~ a patent application and the complete specification relating to the application if the validity of a patent is disputed in any proceedings before the court under this Act and the court directs the Commissioner to re-examine the complete specification conduct a re-examination. 35

Compare: Patents Act 1990 s 97 (Aust)

89A Relationship between re-examination and other proceedings

- (1) The Commissioner must not conduct a re-examination under this subpart if,—
- (a) in the case of **section 88**, an opposition proceeding under this subpart in relation to the application is pending: 5
- (b) in the case of **section 89(1)**,—
- (i) a relevant proceeding in relation to the patent is pending; or 10
- (ii) a proceeding before the Commissioner under **subpart 11** in relation to the patent is pending.
- (2) If a re-examination under this subpart has commenced, the Commissioner must not continue the re-examination if,—
- (a) in the case of **section 88**, an opposition proceeding under this subpart in relation to the application is commenced: 15
- (b) in the case of **section 89(1)**,—
- (i) a relevant proceeding in relation to the patent is commenced and the Commissioner has received notification of the commencement of that proceeding; or 20
- (ii) a proceeding before the Commissioner under **subpart 11** in relation to the patent is commenced. 25
- (3) If a re-examination has been discontinued under **subsection (2)**, the Commissioner may, if he or she thinks fit, continue the re-examination after the opposition proceeding, relevant proceeding, or proceeding under **subpart 11** (as the case may be) is completed. 30
- (4) Despite **sections 88(1) and 89(1)**, the Commissioner is not required to conduct a re-examination after receiving a request under either of those subsections if the Commissioner considers that all of the issues raised in relation to the request are the same, or substantially the same, as those raised in a previous opposition or re-examination proceeding under this subpart or a previous proceeding before the Commissioner or the court under **subpart 11**. 35

(5) On a re-examination under **section 88 or 89(1)**, the Commissioner may refuse to consider any issue that the Commissioner considers is the same, or substantially the same, as an issue raised in a previous opposition or re-examination proceeding under this subpart or a previous proceeding before the Commissioner or the court under **subpart 11**. 5

(6) **Sections 88, 89, and 90** are subject to this section.

90 Report on re-examination

(1) On re-examining a complete specification under this subpart, the Commissioner must consider and report on whether, to the best of the Commissioner’s knowledge, the invention, so far as claimed in a claim, when compared with the prior art base,— 10
 (a) is novel; and
 (b) involves an inventive step.

(2) For the purposes of **subsection (1)**, in considering the prior art base, account must not be taken of information that is made publicly available only through the doing of an act (whether in or out of New Zealand). 15

(1) On a re-examination under this subpart, the Commissioner must consider and report on whether the Commissioner is satisfied, on the balance of probabilities, that any of the relevant grounds are established. 20

(2) For the purposes of **subsection (1)** and **sections 91 and 92**, **relevant grounds** means,—

(a) in the case of a request under **section 88(1)**, the grounds specified under **section 88(2)(a)** and any other grounds set out in **section 87A** that the Commissioner has decided to consider; 25

(b) in the case of a re-examination under **section 88** that is commenced by the Commissioner, the grounds set out in **section 87A** that the Commissioner has decided to consider; 30

(c) in the case of a request under **section 89(1)**, the grounds specified under **section 89(2)(a)** and any other grounds set out in **section 106** that the Commissioner has decided to consider; 35

(d) in the case of a re-examination under **section 89** that is commenced by the Commissioner, the grounds set out

- in **section 106** that the Commissioner has decided to consider:
- (e) in the case of a re-examination that was directed under **section 89(5)**, the grounds set out in **section 106** that the court has asked the Commissioner to consider. 5
- (3) A copy of a report under this section must, if the re-examination was directed under **section 89(5)**, be given by the Commissioner to the court that gave the direction.
Compare: Patents Act 1990 ss 98, 100 (Aust)
- 91 Refusal to grant patent: re-examination before grant** 10
- (+) If the Commissioner makes an adverse report on a re-examination under **section 88**, the Commissioner may refuse to grant the patent.
- (1) If the Commissioner reports on a re-examination under **section 88** that he or she is satisfied, on the balance of probabilities, that any of the relevant grounds are established, the Commissioner may refuse to grant the patent. 15
- (2) The Commissioner must not refuse to grant a patent under this section unless the Commissioner has, if appropriate, given the applicant a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection in relation to **section 13(b)** (which relates to the requirement for the invention to be novel and involve an inventive step) and the applicant has failed to do so. 20
Compare: Patents Act 1990 s 100A (Aust) 25
- 92 Revocation of patent: re-examination after grant**
- (+) If the Commissioner makes an adverse report on a re-examination under **section 89**, the Commissioner may, by notice in writing, revoke the patent, either wholly or in so far as it relates to a particular claim (as the case may be). 30
- (1) If the Commissioner reports on a re-examination under **section 89** that he or she is satisfied, on the balance of probabilities, that any of the relevant grounds are established, the Commissioner may, by notice in writing, revoke the patent, either wholly or in so far as it relates to a particular claim (as the case may be). 35

- (2) The Commissioner must not revoke a patent under this section unless the Commissioner has, if appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection ~~in relation to **section 13(b)** (which relates to the requirement for the invention to be novel and involve an inventive step)~~ and the patentee has failed to do so. 5
- (3) The Commissioner must not revoke a patent under this section—
- (a) while a relevant proceeding in relation to that patent is pending; or 10
 - (b) before the Commissioner has made a decision on an application for revocation of the patent made under **section 104** (if an application has been made to the Commissioner under that section). 15
- (4) **Subpart 11** (which relates to the revocation and surrender of patents) does not limit this section. 15
- Compare: Patents Act 1990 s 101 (Aust)

92A Person who requests re-examination has no right to participate further in re-examination proceeding 20

- (1) A person who has made a request under **section 88(1) or 89(1)**—
- (a) does not have a right to be heard in relation to the re-examination; and
 - (b) does not have any other right to participate in the re-examination proceeding after the request is made; and 25
 - (c) does not have a right to appeal to the court against any decision of the Commissioner under any of **sections 88 to 92**. 30
- (2) **Section 261** (which relates to appeals of decisions of the Commissioner) is subject to this section.

Subpart 10—Grant of patent

*General rules***93 When patent must be granted**

- (+) The Commissioner must grant a patent to the nominated person, or to 2 or more nominated persons jointly, as soon as is reasonably practicable after the date that is 3 months after the date of the publication of the accepted complete specification if either—
- (a) a request to re-examine the complete specification has not been made in accordance with **section 88** and the Commissioner decides that he or she will not re-examine the complete specification under that section; or
- (b) the Commissioner decides, following all re-examinations of the complete specification relating to the patent application under **section 88**, that the patent should be granted.
- (1) The Commissioner must grant a patent to the nominated person, or to 2 or more nominated persons jointly, as soon as is reasonably practicable after the date that is 3 months after the date of the publication of the accepted complete specification if—
- (a) there is no opposition to the grant; or
- (b) in spite of opposition, the Commissioner’s decision, or the decision on appeal, is that a patent should be granted.
- (1A) However, if, before the patent is granted, a re-examination proceeding is commenced under **section 88** (whether as a result of a request or a decision of the Commissioner) and that proceeding has not been discontinued or ended under **section 89A**, the Commissioner—
- (a) must not act under **subsection (1)** until after the Commissioner has prepared a report under **section 90**; and
- (b) may refuse to grant the patent in accordance with **section 91**.
- (1B) The Commissioner may postpone the grant of the patent in the prescribed circumstances.

-
- (2) If a nominated person dies before a patent is granted on the patent application, the patent may be granted to his or her personal representative.
 - (3) The date that the patent is granted must be entered in the patents register. 5
 - (4) The Commissioner must, as soon as is reasonably practicable after a patent has been granted, publish in the journal a notice that it has been granted.
 - (5) ~~This section does not limit the Commissioner's power to refuse to grant a patent under section 94.~~ 10
Compare: 1953 No 64 s 27(1)

 - 94 Validity of patent not guaranteed**
 Nothing done under this Act guarantees the granting of a patent, or that a patent is valid, in New Zealand or anywhere else. 15
Compare: Patents Act 1990 s 20(1) (Aust)

 - 95 Patent date**
 - (1) Every patent must be given a patent date that is—
 - (a) the filing date of the relevant complete specification; or
 - (b) if the regulations provide for the determination of a different date as the patent date, the date determined under the regulations. 20
 - (2) However, no proceeding may be taken for an infringement committed before the date on which the relevant complete specification became open to public inspection. 25
 - (3) The patent date of every patent must be entered in the patents register.
Compare: 1953 No 64 s 30(1), (2); Patents Act 1990 s 65 (Aust)

 - 96 Patent granted for one invention only**
 - (1) A patent ~~may~~ must be granted for one invention only. 30
 - (2) However, it is not competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than 1 invention.
Compare: 1953 No 64 s 29(4)

97 Amendment of patent granted to deceased person or to person body corporate that has been liquidated or wound up

- (1) This section applies if, at any time after a patent has been granted, the Commissioner is satisfied that the person to whom the patent was granted— 5
- (a) had died before the patent was granted; or
- (b) in the case of a body corporate, had ceased to exist before the patent was granted.
- (2) The Commissioner may amend the patent by substituting for the name of that person the name of the person to whom the patent should have been granted. 10
- (3) The patent has effect, and is to be treated as always having had effect, in accordance with that amendment. 15

Compare: 1953 No 64 s 28

Patents of addition

98 Patents of addition

- ~~(1) This section applies if—~~
- ~~(a) a patent application is made in respect of any improvement in, or modification of, an invention (the **main invention**); and~~ 20
- ~~(b) the applicant also applies, or has applied, for a patent for that invention or is the patentee of that invention.~~
- (1) This section applies if—
- (a) a patent for an invention (the **main invention**) has been applied for or granted; and 25
- (b) the applicant or patentee (or a person authorised by the applicant or patentee) applies for a further patent for an improvement in, or modification of, the main invention; and 30
- (c) the application for that further patent is made in the prescribed manner.
- (2) The Commissioner may, on the request of the applicant for the further patent, grant the patent for the improvement or modification as a patent of addition. 35

Compare: 1953 No 64 s 34(1); Patents Act 1990 s 81(1) (Aust)

99 Commissioner may revoke patent for improvement or modification and grant patent of addition

- (1) This section applies if—
 - (a) an invention that is an improvement in, or modification of, another invention is the subject of an independent patent; and 5
 - (b) the patentee of that patent is also the patentee of the patent for the main invention.
- (2) The Commissioner may, on the request of the patentee, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition for the improvement or modification. 10
- (3) The patent of addition must have the same patent date as the patent date of the patent that is revoked. 15

Compare: 1953 No 64 s 34(2)

100 Restrictions on granting of patents of addition

- (1) The Commissioner must not grant a patent as a patent of addition unless the filing date of the complete specification is the same as, or later than, the filing date of the complete specification for the main invention. 20
- (2) The Commissioner must not grant a patent of addition before the granting of the patent for the main invention.

Compare: 1953 No 64 s 34(3), (4)

101 Term of patent of addition

- (1) A patent of addition— 25
 - (a) must be granted for a term equal to that of the patent for the main invention, or as much of the term of the patent for the main invention that is unexpired; and
 - (b) ~~remains in force—~~
 - (i) ~~during that term; or~~ 30
 - (ii) ~~until the expiry of the term of the patent for the main invention (if the term of the patent for the main invention expires before the expiry of that term).~~
 - (b) remains in force during that term or until the earlier of expiry or revocation of the patent for the main invention. 35

- (2) However, if the patent for the main invention is revoked under this Act, the court or the Commissioner (as the case may be) may order that the patent of addition become, and continue in force as, an independent patent for the remainder of the term of the patent for the main invention. 5

Compare: 1953 No 64 s 34(5)

102 Renewal fees for patents of addition

- (1) No renewal fees are payable in respect of a patent of addition.
- (2) However, if any patent of addition becomes an independent patent under **section 101(2)**, the renewal fees are payable 10 from that time, on the same dates, as if the patent had been originally granted as an independent patent.

Compare: 1953 No 64 s 34(6)

103 Provisions concerning inventive step requirement and validity in connection with patents of addition

- (1) The grant of a patent of addition must not be refused, and a patent granted as a patent of addition must not be revoked or invalidated, on the ground only that the invention claimed in the complete specification of the patent of addition does not involve any inventive step having regard to any publication or use of— 20
- (a) the main invention described in the complete specification for the main invention; or
 - (b) any improvement in, or modification of, the main invention described in the complete specification of— 25
 - (i) a patent of addition to the patent for the main invention; or
 - (ii) an application for a patent of addition to the patent for the main invention.
- (2) The validity of a patent of addition must not be questioned on 30 the ground that the invention should have been the subject of an independent patent.

Compare: 1953 No 64 s 34(7)

Subpart 11—Revocation and surrender of patents

104 Revocation of patent

- (1) The Commissioner or the court may, on an application under this section, revoke a patent on any of the grounds set out in **section 106**. 5
- (2) An application under this section may be made by any person.
Compare: 1953 No 64 ss 41(1), (3), 42

105 Provisions concerning applications for revocation made to Commissioner 10

- ~~(1) The Commissioner may refuse any application to the Commissioner under **section 104** that is frivolous or vexatious.~~
- (1) The Commissioner may refuse any application to the Commissioner under **section 104** if the Commissioner considers that— 15
- (a) the application is frivolous or vexatious; or
- (b) all of the issues raised by the application are the same, or substantially the same, as the issues raised in a previous opposition or re-examination proceeding under **subpart 9** or in a previous proceeding before the Commissioner or the court under this subpart. 20
- (1A) The Commissioner may, in considering an application under **section 104**, refuse to consider any issue that the Commissioner considers is the same, or substantially the same, as an issue raised in a previous opposition or re-examination proceeding under **subpart 9** or in a previous proceeding before the Commissioner or the court under this subpart. 25
- (2) If a relevant proceeding in relation to a patent is pending in any court, an application to the Commissioner under **section 104** may be made only with the leave of that court. 30
- (3) If an application is made to the Commissioner under **section 104**, the Commissioner must—
- (a) notify the patentee; and
- (b) give to the person who made the application and the patentee a reasonable opportunity to be heard before deciding the case (unless the application has been refused under **subsection (1)**). 35

(3A) The Commissioner may, at any stage of a proceeding relating to an application made to the Commissioner under **section 104**, refer the application to the court.

- (4) If, on an application made to the Commissioner under **section 104**, the Commissioner is satisfied, on the balance of probabilities, that any of the grounds set out in **section 106** are established, the Commissioner may by order direct that the patent is either—
- (a) revoked unconditionally; or
 - (b) revoked unless the complete specification is amended to the Commissioner's satisfaction within the time that is specified in the order.

Compare: 1953 No 64 s 42(3)

106 Grounds for revoking patent

- (1) A patent may be revoked on 1 or more of the following grounds:
- (a) that the invention, so far as claimed in a claim, is not a patentable invention under **section 13**;
 - (b) that the patentee is not entitled to the patent;
 - ~~(c) that the complete specification does not comply with **section 37(1)** (which requires descriptions of the invention, method of performance, and claims);~~
 - ~~(d) that the scope of a claim is not sufficiently and clearly defined or that a claim is not fairly based on the matter disclosed in the complete specification;~~
 - (c) that the complete specification does not comply with **subpart 2** (which relates to specification requirements);
 - (e) that the patent was obtained by fraud, false suggestion, or a misrepresentation;
 - (f) that the invention, so far as claimed in a claim, was secretly used in New Zealand before the priority date of that claim;
 - (g) that the patent has been granted contrary to law.
- (2) For the purposes of **subsection (1)(a)**, account must not be taken of any secret use of the invention.
- (3) For the purposes of **subsection (1)(f)**, account must not be taken of any use of the invention—

- (a) for the purpose of reasonable trial or experiment only if the trial or experiment is conducted by, on behalf of, or with the consent of the nominated person or any person from whom the nominated person derives title; or
 - (b) by a government department or any person authorised by a government department if ~~the nominated person, or any person from whom the nominated person derives title, has communicated or disclosed, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing~~ the invention directly or indirectly to that department or person; or
 - (c) by any other person, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention to that person in confidence if the use of the invention is without the consent of the nominated person or of any person from whom the nominated person derives title.
- (4) Every ground set out in **subsection (1)** is available as a ground of defence in any proceeding for the infringement of the patent.

Compare: 1953 No 64 s 41(1), (2), (4)

107 Priority date in case of obtaining

- (1) This section applies if—
- (a) a patent application (**application A**) is made for an invention that has been claimed in a complete specification filed in relation to another patent application (**application B**); and
 - (b) the patent granted in relation to application B has been revoked by the court or the Commissioner on the ground specified in **section 106(1)(b)**.
- (2) The Commissioner may direct that application A and any specification filed in relation to it must, for the purposes of **subpart 5**, be treated as having been filed on the date on which the corresponding document was filed; or is treated as having been filed, in relation to application B if the Commissioner is satisfied that the patent granted in relation to application B was obtained in breach of the rights of the person who is, or may

~~be, granted a patent in relation to application A or any person under or through whom that person claims.~~

Compare: 1953 No 64 s 62(b)

108 Court may also revoke patent if patentee, without reasonable cause, refuses request of government department to exploit invention 5

(1) The court may, on the application of a government department, revoke a patent if the court is satisfied that the patentee has, without reasonable cause, failed to comply with a request of the government department to exploit the patented invention for the services of the Crown on reasonable terms ~~under section 170.~~ 10

(2) The ground for revoking a patent set out in **subsection (1)** is available as a ground of defence in any proceeding for the infringement of the patent. 15

Compare: 1953 No 64 s 41(3)(a)

109 Surrender of patent

(1) A patentee may, by notice given to the Commissioner, offer to surrender the patent.

(2) The Commissioner must publish the offer in the journal. 20

(3) A person may, within the prescribed period after the publication, give notice to the Commissioner of opposition to the surrender.

(4) The Commissioner must notify the patentee if notice of opposition is given. 25

(5) The Commissioner may accept the offer and by order revoke the patent if—

(a) the Commissioner has given the patentee and the opponent a reasonable opportunity to be heard; and

(b) the Commissioner is satisfied that the patent may properly be surrendered. 30

Compare: 1953 No 64 s 43

Subpart 12—Restoration of lapsed patents and restoration of patent applications

Restoration of lapsed patents

110 Restoration of lapsed patents

- (1) This section applies if a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under **section 20**. 5
- (2) The Commissioner may, on a request made in the prescribed manner and in accordance with this subpart, by order restore the patent, and any patent of addition specified in the request that has ceased to have effect when the patent ceased to have effect, if the Commissioner is satisfied that the failure to pay the renewal fee was unintentional. 10

Compare: 1953 No 64 s 35(1)

111 Request must describe circumstances that led to failure to pay renewal fee 15

- (1) A request for an order under **section 110** must contain a statement that fully sets out the circumstances that led to the failure to pay the renewal fee.
- (2) The Commissioner may require the person who makes the request to provide any further evidence that the Commissioner thinks fit. 20

Compare: 1953 No 64 s 35(3)

112 Persons who may make request for restoration of patent

- (1) A request for an order under **section 110** may be made by the person who was the patentee or, if that person is deceased, by that person's personal representative. 25
- (2) If the patent was held by 2 or more persons jointly, the request for an order under **section 110** may, with the leave of the Commissioner, be made by 1 or more of them without joining the others. 30

Compare: 1953 No 64 s 35(2)

113 When request for restoration of patent may be made

- (1) A request for an order under **section 110** may only be made within the prescribed period. 35

- (2) However, the Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.
- (3) The person who makes the request must, for the purposes of **subsection (2)**, provide the Commissioner with a statement that fully sets out the circumstances that caused the delay and the reasons why the delay is not undue.
- (4) The Commissioner may require that person to provide any further evidence that the Commissioner thinks fit.
- 114 Commissioner must give applicant person who made request reasonable opportunity to be heard if not satisfied that prima facie case has been made out for restoration** 10
 The Commissioner must, after considering a request made in accordance with **sections 110 to 113**, give the person who made the request a reasonable opportunity to be heard if the Commissioner is not satisfied that a prima facie case has been made out for an order under **section 110**. 15
- 115 Commissioner to publish request in journal** 15
 The Commissioner must publish a request made in accordance with **sections 110 to 113** in the journal if the Commissioner is satisfied that a prima facie case has been made out for an order under **section 110**. 20
 Compare: 1953 No 64 s 35(4)
- 116 Notice of opposition and reasonable opportunity to be heard** 25
- (1) Any person may, within the prescribed period, give notice to the Commissioner of opposition to an order being made under **section 110** on either or both of the following grounds: 25
- (a) that the failure to pay the renewal fee was not unintentional: 30
- (b) if the period within which a request for an order under **section 110** may be made is extended under **section 113**, that the delay in making the request was undue.
- (2) The Commissioner must notify the person who made the request if a person has given notice under **subsection (1) and** 35

provide the person who made the request with a copy of that notice.

- (3) The Commissioner must give the person who made the request and the opponent a reasonable opportunity to be heard before the Commissioner decides the case. 5
Compare: 1953 No 64 s 35(4), (5)

117 Order to be made on payment of unpaid fees

- (1) If the Commissioner has published a request under **section 115**, he or she must make an order under **section 110** in accordance with the request after the prescribed period for giving notice of opposition if— 10
- (a) all unpaid renewal fees are paid; and
 - (b) all other prescribed additional penalties (if any) are paid; and
 - (c) either— 15
 - (i) no notice of opposition is given within the prescribed period; or
 - (ii) the decision of the Commissioner is in favour of the person who made the request (in the case of a notice of opposition having been given within the prescribed period). 20
- (2) An order for the restoration of a patent—
- (a) may be made subject to a condition requiring the registration of any matter if the provisions of this Act concerning entries in the patents register have not been complied with; and 25
 - (b) must contain, or be subject to, the provisions that are prescribed for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention between the date when the patent ceased to have effect and the date on which the request is published under **section 115**; and 30
 - (c) may be made subject to any other conditions that the Commissioner thinks fit. 35
- (3) If any condition of an order under this section is not complied with by the patentee, the Commissioner may revoke the order

and give any directions that are consequential on the revocation that the Commissioner thinks fit.

- (4) The Commissioner must, before the Commissioner makes a decision under **subsection (3)**, give the patentee a reasonable opportunity to be heard. 5

Compare: 1953 No 64 s 35(5)–(7)

Restoration of patent applications

118 Request for restoration of void or abandoned patent applications

- (1) This section applies if— 10
- (a) the patent application is abandoned under **section 33A, 59B, or 63** or is void under **section 67 or 69**; or
 - (b) in the case of a Treaty application, the Treaty application is void under **section 48(1)(d) or (e)**.
- (2) The applicant may make a request to the Commissioner in the prescribed manner for an order to restore the patent application and to extend the period for complying with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) to a date that is specified in the order. 15 20
- (3) Every request for an order must contain a statement that fully sets out the circumstances that led to the failure of the applicant to comply with the requirements imposed on the applicant by or under this Act ~~within the time allowed by or under this Act~~ or the Patent Cooperation Treaty (as the case may be). 25
- (4) The Commissioner must publish the request in the journal if the Commissioner is satisfied that the failure of the applicant to comply with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) within the time allowed by or under this Act was unintentional. 30

Compare: 1953 No 64 s 37(1), (2)

119 When request for restoration of application may be made

- (1) A request under **section 118** may only be made within the prescribed period. 35

- (2) However, the Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.
- (3) The applicant must, for the purposes of **subsection (2)**, provide the Commissioner with a statement that fully sets out the circumstances that caused the delay and the reasons why the delay is not undue. 5
- (4) The Commissioner may require the applicant to provide any further evidence that the Commissioner thinks fit.

120 Notice of opposition 10

- (1) Any person may, within the prescribed period, give notice to the Commissioner of opposition to an order being made under **section 121** on either or both of the following grounds:
- (a) that any failure of the applicant to comply with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) within the time allowed by or under this Act was not unintentional: 15
- (b) if the period within which a request under **section 118** may be made is extended under **section 119**, that the delay in making the request was undue. 20
- (2) The Commissioner must notify the applicant if a person has given notice under **subsection (1)** and provide the applicant with a copy of that notice.
- (3) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before the Commissioner decides the case. 25

Compare: 1953 No 64 s 37(3), (4)

121 Commissioner to determine matter 30

- (1) The Commissioner must, after the expiry of the prescribed period for giving notice of opposition under **section 120**,—
- (a) by order restore the patent application and extend the period for complying with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) to a period that is specified in the order if the Commissioner is satisfied that— 35

- (i) every failure of the applicant to comply with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) within the time allowed by or under this Act was unintentional; and 5
- (ii) if the period within which the request for an order under this section may be made was extended under **section 119**, there was no undue delay in making the request; or
- (b) dismiss the request. 10
- (2) An order under this section must contain, or be subject to, the provisions that are prescribed for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention that is the subject of the patent application between ~~the specified date~~ date on which the patent application became void or was abandoned and the date on which the request is published under **section 118**. 15
- ~~(3) For the purposes of **subsection (2)**, the **specified date** means,—~~ 20
- ~~(a) in the case of a patent application that is a Treaty application that is void under **section 48**, the date on which the application became void; and~~
- ~~(b) in any other case, the date when the patent application became void or abandoned.~~ 25
- (4) The Commissioner must publish in the journal the making of an order under **subsection (1)** after that order is made.
- Compare: 1953 No 64 s 37(5), (6)

Subpart 13—Miscellaneous provisions

Substitution of applicants 30

122 Persons claiming under assignment or agreement or by operation of law

- (1) This section applies if, before a patent has been granted, a person would, if the patent were to be then granted, be entitled under an assignment or agreement, or by operation of law, to— 35
- (a) the patent; or
- (b) an interest in the patent; or

- (c) an undivided share in the patent or in an interest in the patent.
- (2) The Commissioner may, on a request made by the person in the prescribed manner, direct that the patent application proceed in the name of the person, or in the names of the person and the applicant or the other joint applicant or applicants (as the case may require). 5
- ~~(3) If the Commissioner gives a direction,—~~
 - ~~(a) the person must be taken to be the applicant, or a joint applicant, as the case may require; and 10~~
 - ~~(b) the patent application must be taken to have been amended so as to request the grant of a patent to the person, either alone or as a joint patentee, as the case may require.~~
- (3) If the Commissioner gives a direction, the person must be taken to be— 15
 - (a) the applicant, or a joint applicant, as the case may require; and
 - (b) the nominated person, or joint nominated person, as the case may require. 20

Compare: 1953 No 64 s 24(1); Patents Act 1990 s 113 (Aust)

123 Death of applicant

- (1) If an applicant dies before a patent is granted on the patent application, his or her personal representative may proceed with the application. 25
- (2) However, the Commissioner may also dispense with probate and letters of administration and allow a person to proceed with a deceased applicant’s application under **section 162**.

Compare: Patents Act 1990 s 215(1) (Aust)

124 Disputes between interested parties 30

- (1) If a dispute arises between interested parties in relation to a patent application concerning whether, or in what manner, the application should proceed, the Commissioner may, on a request made to the Commissioner, give any directions that the Commissioner thinks fit— 35

- (a) for enabling the application to proceed in the name of 1
or more of the parties alone; or
 - (b) for regulating the manner in which it is to proceed; or
 - (c) for both of the purposes referred to in **paragraphs (a)**
and (b). 5
- (2) A request under **subsection (1)** must be made in the pre-
scribed manner and may be made by any of the parties.
- (3) The Commissioner must, before giving a direction, give a rea-
sonable opportunity to be heard to any person that the Com-
missioner considers is interested (whether or not that person is 10
currently an interested party).
Compare: 1953 No 64 s 24(5)

Provisions for secrecy of certain inventions

125 Directions in relation to inventions concerning defence

- (1) The Commissioner may give any of the directions described 15
in **subsection (2)** if—
- (a) a patent application has been made for an invention
either before or after the commencement of this section;
and
 - (b) the invention is, in the opinion of the Commissioner,— 20
 - (i) one of a class notified to the Commissioner by
the Minister of Defence as relevant for defence
purposes; or
 - (ii) likely to be valuable for defence purposes.
- (2) The directions are directions— 25
- (a) for prohibiting or restricting the publication of informa-
tion concerning the invention; or
 - (b) for prohibiting or restricting the communication of in-
formation concerning the invention to a person or class
of persons specified in the directions. 30
- (3) While the directions are in force,—
- (a) the patent application may, subject to the directions,
proceed up to the acceptance of the complete specifi-
cation; and
 - (b) the patent application and the complete specification 35
must not become open to public inspection; and

- (c) a patent must not be granted in relation to the patent application.

Compare: 1953 No 64 s 25(1)

126 Commissioner must give notice to Minister of Defence

If the Commissioner gives directions under **section 125**, the Commissioner must give notice of the patent application and of the directions to the Minister of Defence.

Compare: 1953 No 64 s 25(2)

127 Minister of Defence must consider whether publication would be prejudicial to defence of New Zealand

(1) The Minister of Defence must,—

(a) on receipt of a notice under **section 126**, consider whether the publication of the invention would be prejudicial to the defence of New Zealand; and

(b) unless a notice under **subsection (3)** has been given to the Commissioner, reconsider that question before the expiry of 9 months from the filing date of the patent application and at least once in every subsequent year.

(2) For the purposes of **subsection (1)**, the Minister of Defence may, at any time after the complete specification has been accepted or, with the consent of the applicant, at any time before the complete specification has been accepted, inspect the patent application and any documents provided to the Commissioner in connection with that application.

(3) If, on consideration of the invention at any time, it appears to the Minister of Defence that the publication of the invention would not, or would no longer, be prejudicial to the defence of New Zealand, the Minister of Defence must give notice to the Commissioner to that effect.

Compare: 1953 No 64 s 25(2)(a)–(c)

128 Commissioner must revoke directions on receipt of notice from Minister of Defence

On receipt of a notice under **section 127**, the Commissioner—

(a) must revoke the directions given under **section 125**; and

- (b) may, subject to any conditions that the Commissioner thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the patent application, whether or not that time has previously expired. 5

Compare: 1953 No 64 s 25(2)(d)

129 Acceptance of complete specification while directions in force

- (1) This section applies if a complete specification filed for a patent application for an invention for which directions have been given under **section 125** is accepted while the directions are in force. 10
- (2) If any use of the invention is made while the directions are in force by, on behalf of, or to the order of a government department, **subpart 6 of Part 4** applies to that use as if the patent had been granted for the invention. 15
- (3) If it appears to the Minister of Defence that the applicant for the patent has suffered hardship by reason of the directions being in force, the Minister of Finance may pay to the applicant an amount by way of compensation that the Minister of Finance considers is reasonable. 20
- (4) For the purposes of **subsection (3)**, the Minister of Finance must have regard to—
- (a) the novelty and usefulness of the invention; and
 - (b) the purpose for which the invention is designed; and 25
 - (c) any other relevant matters.

Compare: 1953 No 64 s 25(3)

130 Maintenance fees and renewal fees not payable while directions in force

No maintenance fees and no renewal fees are payable for any period during which directions that are given under **section 125** are in force if a patent is granted for an application for which directions have been given. 30

Compare: 1953 No 64 s 25(4)

131 Offence to fail to comply with directions

- (1) Every person who fails to comply with a direction given under **section 125** commits an offence if, at the time of the failure, the person knew or ought to have known that a direction had been given. 5
- (2) Every person who commits an offence against **subsection (1)** is liable on conviction on indictment to imprisonment for a term not exceeding 2 years, to a fine not exceeding \$20,000, or to both. 10
- Compare: 1953 No 64 s 25(6)

132 Liability of directors and managers if body corporate commits offence

- If a body corporate is convicted of an offence against **section 131**, every director and every person concerned in the management of the body corporate is guilty of the offence if it is proved— 15
- (a) that the act that constituted the offence took place with his or her authority, permission, or consent; and
- (b) that he or she— 20
- (i) knew, or could reasonably be expected to have known, that the offence was to be or was being committed; and
- (ii) failed to take all reasonable steps to prevent or stop it. 25
- Compare: 1953 No 64 s 108

Part 4**Infringement, other patent proceedings,
and matters affecting patent ownership**

Subpart 1—Infringement proceedings

What constitutes infringement 30**133 Infringement by doing anything patentee has exclusive right to do**

A person infringes a patent if (other than under a licence or with the consent or agreement of the patentee) the person does

anything in the patent area that the patentee has the exclusive right to do under **section 17**.

134 Infringement by supplying means to infringe to another person

- (1) A person (A) also infringes a patent if (other than under a licence or with the consent or agreement of the patentee)— 5
- (a) A supplies, or offers to supply, in the patent area another person (B) with any of the means, relating to an essential element of the invention, for putting the invention into effect; and 10
- ~~(b) A knows, or ought reasonably to know, that the means are suitable and intended by B for putting the invention into effect; and~~
- (b) either—
- (i) A knows, or ought reasonably to know, that the means are suitable and intended by B for putting the invention into effect; or 15
- (ii) if the means is a staple commercial product, A supplies the means, or offers to supply the means, for the purpose of inducing B to put the invention into effect; and 20
- (c) B would infringe the patent by putting the invention into effect.
- (2) ~~However, it is not an infringement to supply or offer to supply a staple commercial product unless the supply or offer is made for the purpose of inducing B to do anything that would infringe the patent under **section 133**.~~ 25

135 Presumption that product produced by infringing process

- (1) If a patented process is a process for obtaining a new product, the same product produced by a person (other than under a licence or with the consent or agreement of the patentee) is presumed in an infringement proceedings to have been obtained by that process. 30
- (2) **Subsection (1)** applies unless the defendant proves the contrary. 35
- (3) In applying **subsection (1)**, the court must not require any person to disclose any manufacturing or commercial secrets if

the court thinks that it would be unreasonable to require that disclosure.

Compare: 1953 No 64 s 68A

What does not constitute infringement

- 136 No infringement for experimental use** 5
- (1) It is not an infringement of a patent for a person to do an act for experimental purposes relating to the subject matter of an invention ~~if the act does not unreasonably conflict with the normal exploitation of the invention.~~
- (2) In this section, **act for experimental purposes relating to the subject matter of an invention** includes an act for the purpose of—
- (a) determining how the invention works:
 - (b) determining the scope of the invention:
 - (c) determining the validity of the claims: 15
 - (d) seeking an improvement of the invention (for example, determining new properties, or new uses, of the invention).
- 137 No infringement by use in or from foreign vessels, aircraft, or vehicles** 20
- (1) It is not an infringement of a patent if—
- (a) an invention is used—
 - (i) on board a foreign vessel, in the body of a foreign vessel, or in a foreign vessel’s machinery, tackle, apparatus, or other accessories, and the invention is used for the vessel’s actual needs only; or 25
 - (ii) in the construction or working of a foreign aircraft or foreign land vehicle or of a foreign aircraft’s or foreign land vehicle’s accessories; and
 - (b) the vessel, aircraft, or land vehicle comes into the patent area accidentally or only temporarily. 30
- (2) In this section, **foreign** means—
- (a) registered in a convention country, in the case of a vessel or aircraft; or

- (b) owned by a person resident or incorporated in a convention country, in the case of a land vehicle.

Compare: 1953 No 64 s 79

138 No infringement for use to produce information required by law 5

It is not an infringement of a patent for a person to make, use, import, sell, hire, or otherwise dispose of the invention solely for uses reasonably related to the development and submission of information required under ~~New Zealand law, or the law of any other country,~~ any law that regulates the manufacture, construction, use, importation, sale, hire, or disposal of any product (whether in New Zealand or elsewhere). 10

Compare: 1953 No 64 s 68B

138A No infringement for prior use of invention

- (1) It is not an infringement of a patent for a person to do an act that exploits an invention, and that would infringe a patent apart from this section, if, immediately before the priority date of the relevant claim, the person— 15

- (a) was exploiting the invention in the patent area; or
 (b) had taken definite steps (contractually or otherwise) to exploit the invention in the patent area. 20

- (2) **Subsection (1)** does not apply if, before the priority date, the person—

- (a) had stopped (except temporarily) exploiting the invention; or 25
 (b) had abandoned (except temporarily) the steps to exploit the invention.

- (3) **Subsection (1)** does not apply to an invention the person derived from any of the following persons, unless the person derived the invention from information that was made publicly available by or with the consent of that person: 30

- (a) the patentee or nominated person;
 (b) any person from whom the patentee or nominated person derives title.

- (4) A person (A) may— 35

- (a) dispose of the whole of A's entitlement under **subsection (1)** to exploit an invention without infringing a

- patent to another person (**B**) (and in this case **subsections (1) to (3)** apply to B as they applied to the first person who had that entitlement and from whom B's entitlement was directly or indirectly derived); but
- (b) may not grant a licence to another person to exploit the invention. 5
- (5) This section applies in respect of a patent only if—
- (a) the relevant patent application was made under this Act on or after the commencement of **Part 3** (and **section 304** did not apply); or 10
- (b) this Act applies to the relevant patent application under **section 302, 303, or 305(3)**.
- Compare: Patents Act 1990 s 119 (Aust)

Counterclaim for revocation of patent

- 139 Defendant may counterclaim for revocation of patent** 15
- (1) A defendant may apply by way of counterclaim in ~~infringement proceedings~~ an infringement proceeding for revocation of the patent on any of the grounds stated in **section 106**.
- (2) If the defendant is a government department, it may apply by way of counterclaim in ~~infringement proceedings~~ an infringement proceeding for revocation of the patent on the ground stated in **section 108** (whether or not it also applies by way of counterclaim for revocation of the patent on any of the grounds stated in **section 106**). 20

Bringing infringement proceedings in court 25

- 140 Who may bring infringement proceedings**
- (1) ~~Infringement proceedings~~ An infringement proceeding may be brought in court by—
- (a) the patentee;
- (b) an exclusive licensee for any infringement that occurs during the term of the licence. 30
- (2) However, **section 141A** affects the right to bring a proceeding under this section.
- (3) Neither **subsection (1) nor section 141A** enables a person to bring any proceeding that is barred under the Limitation Act 1950. 35

141 When and how proceedings may be brought

- (1) ~~Infringement proceedings~~ An infringement proceeding may not be brought until the patent is granted.
- (2) However, **section 77** enables an infringement proceedings to relate to infringements before the patent is granted in the circumstances set out in that section ~~(and subject to the defence in **section 78**)~~. 5
- (3) ~~Sections 155 to 157~~ contain notice and registration requirements for civil proceedings ~~(including infringement proceedings)~~ relating to interests in patents. 10

141A Right to bring infringement proceeding if registrable assignment or licence has occurred

- (1) If a person has the right to bring an infringement proceeding under **section 140(1)** by virtue of a transaction that must be registered under **section 160**, that person must not bring the proceeding unless— 15
- (a) the person's title or interest was registered at least 1 month before the commencement of the proceeding; or
- (b) the person has—
- (i) given at least 1 month's written notice to the proposed defendant of the intention to bring the proceeding; and 20
- (ii) registered the person's title or interest before bringing the proceeding.
- (2) However, a person may bring an infringement proceeding in court, despite not having registered the person's title or interest, if— 25
- (a) the person would be entitled to do so under **section 140(1)** if the title or interest was registered; and
- (b) the person has given at least 1 month's written notice to the proposed defendant of the intention to bring the proceeding and provided an address for service in New Zealand; and 30
- (c) within that notice period, the proposed defendant has not required the proposed plaintiff to register that title or interest. 35

- (3) However, the court may, on application to it, authorise a person to bring an infringement proceeding in court without complying with **subsection (1) or (2)(b)**.

142 Proceedings brought by exclusive licensee

- (1) If an exclusive licensee brings infringement proceedings,— 5
- (a) the patentee must be added as a defendant unless joined as a plaintiff; and
 - (b) the court must, in awarding damages or any other relief, take into account, to the extent the infringement is of the exclusive licensee’s rights,— 10
 - (i) the loss suffered, or likely to be suffered, by the exclusive licensee as a result of the infringement; or
 - (ii) the profits earned as a result of the infringement.
- (1) If an exclusive licensee brings an infringement proceeding, the patentee must be joined as a defendant (unless joined as a plaintiff). 15
- (2) A patentee ~~added~~ joined as a defendant is not liable for costs unless the patentee actually defends the proceedings. 20
- Compare: 1953 No 64 s 72

Relief for infringement

143 Types of relief available for infringement

The relief that the court may grant for an infringement of a patent includes—

- (a) an injunction; and 25
- (b) at the option of the plaintiff, damages or an account of profits.

Compare: 1953 No 64 s 69

144 Court must not award damages or account of profits if innocent infringement 30

- (1) The court must not award damages or an account of profits for infringement of a patent if the defendant proves that at the date of the infringement the defendant did not know, and ought not reasonably to have known, that the patent existed or, in

the case of a proceeding under **section 77**, that the complete specification had become open to public inspection.

- (2) It is presumed that a person ought reasonably to have known that a patent existed if—
- (a) a product is marked so as to indicate it is patented in New Zealand and with the New Zealand patent number; and
- (b) the person knew, or ought reasonably to have known, of the product.
- (3) But there is no presumption if the product is marked merely so as to indicate it is patented.
- Compare: 1953 No 64 s 68(1)

145 Court must refuse damages or account of profits for infringement before amendment to accepted specification

- (1) If an amendment has been made to an accepted complete specification under this Act, the court must not award damages or an account of profits for an infringement that occurs before the date of the decision to allow the amendment.
- (2) **Subsection (1)** does not apply if—
- (a) the court is satisfied that the specification, as accepted, was framed in good faith and with reasonable skill and knowledge; or
- (b) it is only an amendment to correct an obvious mistake.
- Compare: 1953 No 64 s 68(3)

146 Court may refuse damages or account of profits if renewal fees not paid

The court may refuse to award damages or an account of profits for an infringement that occurs after a failure to pay any renewal fee for the patent within the prescribed period and before any extension of that period.

Compare: 1953 No 64 s 68(2)

147 Limits on damages and accounts of profits do not affect power to grant injunction

Nothing in **sections 144 to 146** affects the court's power to grant an injunction in an infringement proceedings.

Compare: 1953 No 64 s 68(4)

148 Court may grant relief for partially valid patent

- (1) If it is found in ~~infringement proceedings~~ an infringement proceeding that a patent is only partially valid, the court may grant relief for that part of the patent that is valid and infringed.
- (2) However, the court may grant damages, an account of profits, or costs for that part of the patent only if the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge. 5
- (3) It is at the court's discretion whether or not to grant costs and as to the date from which damages or the account of profits should be counted. 10
- (4) The court may, as a condition of the relief, direct that the specification be amended by an application under **section 85** (which relates to the amendment of a specification with the leave of the court), and the application may be made even if the other issues in the infringement proceedings have not yet been determined. 15

Compare: 1953 No 64 s 71

149 Court may grant costs for subsequent proceedings if validity of specifications contested

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- (1) If the validity of a claim of a specification is contested in ~~proceedings~~ a proceeding and the court finds the claim to be valid, the court may certify that the claim's validity was contested in ~~those proceedings~~ that proceeding.
- (2) A party who is relying on the validity of that claim in any subsequent infringement or revocation proceedings is then entitled to reasonable solicitor-client costs for the certified claim if a final order or judgment is made or given in favour of that party. 25
- (3) This section does not apply to the costs of any appeal in ~~those~~ subsequent proceedings the subsequent proceeding. 30

Compare: 1953 No 64 s 73

150 Infringement proceedings must be tried before Judge alone

Infringement proceedings must be tried before a Judge alone, unless the court otherwise directs.

Compare: 1953 No 64 s 113(3)

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Subpart 2—Declarations of non-infringement

151 Court may make declaration of non-infringement

(1) The court may declare in proceedings between a person (A) and a patentee or exclusive licensee (B) that the exploitation by A of any product or process does not or would not infringe the patent if A proves that—

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(a) A has applied in writing to B for a written acknowledgment to that effect and has given B full written particulars of the relevant product or process; and

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(b) A has undertaken to pay a reasonable sum for B's expenses in obtaining advice on whether or not the proposed exploitation would infringe the patent; and

(c) B has not given that acknowledgment.

(2) It does not matter that B has not asserted anything to the contrary.

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Compare: 1953 No 64 s 75(1)

152 When proceedings for declaration of non-infringement may be brought

(1) Proceedings for a declaration of non-infringement may be brought at any time after the date of the publication of the accepted complete specification.

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(2) If proceedings are brought before the grant of the patent under **subsection (1)**, references to the patentee and B in **section 151** must be read as references to the nominated person.

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Compare: 1953 No 64 s 75(4)

151 Application for declaration of non-infringement

(1) A person who wishes to exploit an invention may apply to a court for a declaration that the exploitation of the invention would not infringe a claim of a complete specification.

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- (2) An application may be made—
 (a) at any time after the complete specification has become open to public inspection; and
 (b) whether or not the patentee or nominated person has made any assertion to the effect that the exploitation of the invention would infringe the claim. 5
- (3) The patentee or nominated person must be joined as a respondent in the proceeding.
 Compare: Patents Act 1990 s 125 (Aust)

152 Proceeding for declaration of non-infringement 10

- (1) The court must not make a declaration of non-infringement unless a patent has been granted in respect of the relevant invention and—
 (a) the applicant for the declaration—
 (i) has asked the nominated person or patentee in writing for a written admission that the proposed exploitation would not infringe a claim of the complete specification; and 15
 (ii) has given the nominated person or patentee full written particulars of the proposed exploitation; and 20
 (iii) has undertaken to pay a reasonable sum for the nominated person’s or patentee’s expenses in obtaining advice about whether the proposed exploitation would infringe the claim; and 25
 (b) the nominated person or patentee has refused or failed to make the admission; and
 (c) the court is satisfied that the proposed exploitation would not infringe a claim of the complete specification. 30
- (2) Nothing in this section limits the court’s jurisdiction to grant a declaration apart from this section.
 Compare: 1953 No 64 s 75(1); Patents Act 1990 s 126(1) (Aust)

153 Costs in declaration of non-infringement 35

The costs of the parties in a proceedings for a declaration of non-infringement are at the discretion of the court.
 Compare: 1953 No 64 s 75(2)

154 Validity of patent not at issue in proceedings for, and not affected by, declaration of non-infringement

- (1) The validity of a claim of the specification of a patent must not be questioned in a proceedings for a declaration of non-infringement. 5
- (2) Accordingly, whether or not a declaration is made does not affect the validity of the patent.

Compare: 1953 No 64 s 75(3)

Subpart 3—Other provisions for
proceedings relating to patents Standing of
Attorney-General 10

*Notice and registration requirements for
proceedings on interests in patents*

155 Notice must be given before bringing civil proceedings on unregistered interests in patents 15

- (1) A person (A) must not bring civil proceedings in respect of any interest in a patent that is not registered under this Act unless A has first given at least 1 month's written notice to the proposed defendant (B) of—

- (a) A's intention to bring proceedings; and 20
(b) A's address for service.

- (2) If the interest is capable of being registered under this Act, B may require A to register A's interest in the patent by giving written notice to A within 1 month of receiving A's notice of intention to bring proceedings. 25

- (3) If B gives A written notice of that requirement, A must not bring civil proceedings in respect of that interest against B unless A registers the interest—

- (a) within 6 months of B giving that notice; and
(b) at least 1 month before A commences proceedings. 30

- (4) However, the court may, on application in that behalf, authorise A to bring civil proceedings without complying with either or both of **subsections (1) and (3)**.

- (5) In this section and **section 156**, **interest in a patent** means an interest to which a person may be entitled as owner, mortgagee, licensee, or otherwise in a patent. 35

Compare: 1953 No 64 s 85(1)(a); (1)(c); (2)

156 Interests must be registered at least 1 month before bringing civil proceedings

- (1) A person (A) must not bring civil proceedings in respect of any interest in a patent (as defined in **section 155(5)**) that is registered under this Act unless that interest was registered, — 5
- (a) if **section 155(3)** applies, within the time limits required by that subsection; and
- (b) in any other case, at least 1 month before the person commences the proceedings.
- (2) However, the court may, on application in that behalf, authorise A to bring civil proceedings without complying with **subsection (1)**. 10
- Compare: 1953 No 64 s 85(1)(b)

157 Application of Limitation Act 1950

- (1) Nothing in **section 155** or **156** enables persons to bring proceedings that are barred under the Limitation Act 1950. 15
- (2) Nothing in section 33 of the Limitation Act 1950 excludes the operation of that Act when proceedings are barred by **section 155** or **156**. 20
- Compare: 1953 No 64 s 85(3)

*Standing for Attorney-General***158 Attorney-General may appear in patent proceedings**

- (1) The Attorney-General may do all or any of the following things if he or she considers that the public interest is or may be involved: 25
- (a) bring a proceedings to test the validity of a patent;
- (b) apply for the revocation of a patent;
- (c) appear and be heard in any proceedings before a court or the Commissioner for the grant, amendment, or revocation of a patent, or for a declaration 30 of non-infringement, and take any steps he or she considers desirable as if he or she were a party to the proceedings;
- (d) intervene in, and take over the control and conduct of, any proceedings referred to in **paragraph (c)** with the 35 consent of a party.

- (2) In any ~~of those proceedings~~ proceeding in which the Attorney-General appears, costs may be awarded either to or against the Attorney-General.

Compare: 1953 No 64 s 76(1), (3)

159 Parties must give notice to Solicitor-General if questioning patent validity 5

- (1) A party to a ~~proceedings~~ before a court or the Commissioner who intends to question the validity of a patent must give notice of that intention to the Solicitor-General.

- (2) That notice must be given in writing at least 21 days before the hearing. 10

- (3) The party must also supply the Solicitor-General with any papers filed in the ~~proceedings~~ by that or any other party to the ~~proceedings~~ that the Solicitor-General requests.

Compare: 1953 No 64 s 76(2)

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Subpart 4—Patent dealings, patent licences,
and transmission of interests in patents

*Registration of assignments, licences, and other
interests in patents*

160 Application for registration of assignments, licences, and other interests in patents 20

- (1) A person who acquires a patent or share in a patent or an interest in a patent (~~the acquirer~~A) must apply to the Commissioner for registration of ~~the acquirer's title or of the acquirer's interest~~ A's title or interest. 25

- (2) However, the person who disposes of the patent or share in a patent or who confers the interest may instead apply to register ~~the acquirer's~~ A's title or interest (and in this case **subsection (1)** does not apply).

- (3) In either case, the application must be made, ~~and any prescribed documents must also be provided to the Commissioner,~~ in the prescribed manner. 30

- (4) This section applies to acquisitions and disposals by assignment, transmission, operation of law, mortgage, licence, or

by any other means (other than a compulsory licence granted under **subpart 5**).

Compare: 1953 No 64 s 84(1), (2), (5)

161 Registration of assignments, licences, and other interests in patents 5

If an application is made under **section 160**, the Commissioner, on proof of ~~the acquirer's title or interest~~ satisfactory to the Commissioner of the acquisition by the person (A) of a patent or interest or share in a patent,—

- (a) must register ~~the acquirer's A's~~ title or interest; and 10
- (b) may issue a replacement copy of the patent in the name of the new patentee; and
- (c) must retain the documents provided with the application under **section 160(3)** or a copy of those documents.

Vesting of patents and patent applications without probate or letters of administration 15

162 Commissioner may vest patent or patent application without probate or letters of administration

- (1) If a patentee, applicant for a patent, or nominated person (A) dies, the Commissioner may (without requiring probate or letters of administration) register or substitute a person (B) as the patentee, applicant, or nominated person in place of A if— 20
 - (a) B proves, to the Commissioner's satisfaction, that—
 - (i) B is entitled to obtain probate of A's will or letters of administration of A's estate, or is A's personal representative, in the place where A was living at the time of his or her death; and 25
 - (ii) probate or letters of administration have not been made or resealed in New Zealand; and
 - (iii) the interests of A's creditors, and of all persons 30
 - beneficially interested under A's will or on A's intestacy, will be adequately safeguarded if this action is taken; and
 - (b) B applies in the prescribed manner.
- (2) If B becomes the patentee, applicant, or nominated person 35
 - under this section, B holds the patent subject to all existing interests and equities affecting it.

- (3) This section applies even if A died before the commencement of this section.
- (4) Nothing in section 70 or 73 of the Administration Act 1969 restricts the operation of this section.
- Compare: 1953 No 64 s 86

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Termination of sales, leases, and licences of patented products and processes if patent no longer in force

163 Termination of sales, leases, and licences of patented products and processes if patent no longer in force

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- (1) This section applies to the following contracts:
- (a) a contract for the sale or lease of a patented product:
- (b) a licence to exploit a patented product or process.
- (2) A contract that this section applies to may be terminated by either party, on giving 3 months' written notice to the other party, at any time after the patent, or all the patents, by which the product or process was protected at the time the contract was made, has or have ceased to be in force.
- (3) **Subsection (2)**—
- (a) applies whether the contract was made before or after the commencement of this section; and
- (b) applies despite anything to the contrary in the contract or in any other contract; and
- (c) does not limit any right to terminate a contract exercisable apart from this section.

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Compare: 1953 No 64 s 67

Subpart 5—Compulsory licences

Compulsory licences for supply of patented inventions predominantly in New Zealand

164 Compulsory licences Application for compulsory licence where market is not being supplied, or is not being supplied on reasonable terms, in New Zealand

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- (1) Any interested person may apply to the court for the grant of a licence under a patent on either of the grounds specified in **subsection (2)** at any time after the later of—

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- (a) the expiry of 3 years from the date that the patent is granted; or
- (b) the expiry of 4 years from the patent date.
- ~~(2) The grounds are that a market for the patented invention is not being supplied; or is not being supplied on reasonable terms; in New Zealand.~~ 5
- (2) The grounds are that a market for the patented invention—
- (a) is not being supplied in New Zealand; or
- (b) is not being supplied on reasonable terms in New Zealand. 10

Compare: 1953 No 64 s 46(1), (2)

165 Court may order grant of licence

- (1) The court may make an order for the grant of a licence in accordance with an application under **section 164** on any terms that the court thinks fit if the court is satisfied that either of the grounds referred to in **section 164(2)** is established. 15
- (1A) However,—
- (a) a licence must not be granted under this section for a patent relating to an integrated circuit;
- (b) no order may be made under **subsection (1)** that would be contrary to any treaty, convention, arrangement, or engagement applying to New Zealand and any convention country. 20
- (2) A licence granted under this section—
- (a) is not exclusive; and 25
- (b) must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and
- (c) is limited to the supply of the patented invention predominantly in New Zealand; and 30
- (d) must be recorded in the patents register by the Commissioner as soon as is reasonably practicable after the Commissioner receives a copy of the order made under **subsection (1)**.
- (3) Any licence granted under this section may, on the application of an interested party person, be terminated by the court if the 35

court is satisfied that the grounds on which the licence was granted have ceased to exist.

Compare: 1953 No 64 ss 46(3)–(5), (8), 54(3)

*Compulsory licences for export of
pharmaceutical products*

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**165A Court may order grant of licence for export of
pharmaceutical products to certain countries**

(1) The court may, on an application made by any person, make an order for the grant of a licence under a patent if the court is satisfied that—

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(a) the patented invention is—

(i) a pharmaceutical product; or

(ii) a process for making a pharmaceutical product;
and

(b) the pharmaceutical product is needed to address a serious public health problem in 1 or more overseas countries specified in the application (for example, an epidemic, whether actual or imminent, of HIV/AIDS, tuberculosis, malaria, or other disease); and

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(c) each of those overseas countries is either—

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(i) an eligible importing Member that has made a notification in respect of the product under paragraph 2(a) of the Annex to the TRIPS agreement;
or

(ii) a country that is currently specified in respect of the product in a notice under **section 165B**; and

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(d) all of the pharmaceutical products made under the licence will be exported to those overseas countries.

(2) A licence granted under this section—

(a) is not exclusive; and

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(b) must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and

(c) must be recorded in the patents register by the Commissioner as soon as is reasonably practicable after the Commissioner receives a copy of the order made under **subsection (1)**.

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- (3) Any licence granted under this section may, on the application of an interested person, be terminated by the court if the court is satisfied that the grounds on which the licence was granted have ceased to exist.
- (4) For the purposes of this section and **sections 165B to 165D**,— 5
eligible importing Member has the same meaning as in Article 31bis of the TRIPS agreement
pharmaceutical product includes a medicine or vaccine, an active ingredient of a medicine or vaccine that is necessary 10
for its manufacture, or a diagnostic kit needed for the use of a medicine or vaccine.
- 165B Secretary of Foreign Affairs and Trade may publish notices that specify eligible countries**
- (1) This section applies if— 15
- (a) the government of a country that is not a member of the World Trade Organization has sent to the Government of New Zealand a request for the country to be specified under this section for the purposes of **section 165A(1)(c)(ii)** in respect of a particular pharmaceutical product; and 20
- (b) the request sets out information relating to why the government of that country considers that either—
- (i) the country has no manufacturing capacity in its pharmaceutical sector for the pharmaceutical 25
product; or
- (ii) the country's manufacturing capacity in its pharmaceutical sector for the pharmaceutical product (excluding any capacity owned or controlled by the patentee) is currently insufficient 30
for the purposes of meeting its need for the product; and
- (c) the request specifies the expected quantity of the pharmaceutical product that is needed by the country.
- (2) The Secretary of Foreign Affairs and Trade (the **Secretary**) may, after a request from a country has been received under **subsection (1)**, by notice in the *Gazette*, specify the country for the purposes of **section 165A(1)(c)(ii)** in respect of the 35

- relevant pharmaceutical product if he or she is satisfied that either—
- (a) the country has no manufacturing capacity in its pharmaceutical sector for the product; or
 - (b) the country’s manufacturing capacity in its pharmaceutical sector for the product (excluding any capacity owned or controlled by the patentee) is currently insufficient for the purposes of meeting its need for the product. 5
- (3) The notice under **subsection (2)** must— 10
- (a) specify the country and pharmaceutical product; and
 - (b) specify the expected quantity of the pharmaceutical product that is needed by the country (as notified to the Government of New Zealand under **subsection (1)**); and 15
 - (c) state that the Secretary is satisfied of the matters specified in **subsection (2)** and his or her reasons for being so satisfied.
- (4) The Secretary may, by notice in the *Gazette*,—
- (a) amend or revoke a notice under **subsection (2)**; 20
 - (b) revoke a notice under **subsection (2)** and replace it with another.
- (5) The Secretary must publish a copy of a notice under **subsection (2)** on an Internet site maintained by, or on behalf of, the Ministry of Foreign Affairs and Trade. 25
- (6) To avoid doubt, a notice under **subsection (2)** is not a regulation for the purposes of the Regulations (Disallowance) Act 1989 and the Acts and Regulations Publication Act 1989 or for any other purpose.
- 165C Terms of licence** 30
- (1) An order under **section 165A** must specify terms of the licence relating to the following matters:
- (a) the name and address of the licensee;
 - (b) the name of the patented invention for which the licence has been granted; 35
 - (c) the name of the country or countries to which the pharmaceutical products made under the licence must be exported:

- (d) the maximum quantity of pharmaceutical products that may be exported to each of those countries (which must be no more than the court considers is necessary to meet the needs of the country):
- (e) the duration of the licence: 5
- (f) the address of the licensee's Internet site for the purposes of **subsection (2)(e)**.
- (2) A licence granted under **section 165A** is subject to the following terms:
- (a) all pharmaceutical products made under the licence must be clearly identified, through specific labelling or marking, as having been made under a compulsory licensing scheme for the export of the product: 10
- (b) all pharmaceutical products made under the licence must have particular distinguishing features (for example, special packaging or special colouring or shaping of the products) if including those features is feasible and does not have a significant impact on price: 15
- (c) all pharmaceutical products made under the licence must be exported to the country or countries specified under **subsection (1)(c)**: 20
- (d) the licensee must, before exporting the pharmaceutical products to a country specified under **subsection (1)(c)**, supply to the Council for Trade-Related Aspects of Intellectual Property Rights of the World Trade Organization a statement containing the following information for the purpose of the information being published on the WTO Internet site: 25
- (i) the quantities of the pharmaceutical product to be exported to the country: 30
- (ii) the specific labelling or marking referred to in **paragraph (a)** and any distinguishing features of the pharmaceutical products referred to in **paragraph (b)**:
- (e) the licensee must, before exporting the pharmaceutical products to a country specified under **subsection (1)(c)**, publish the information specified in **paragraph (d)** on the licensee's Internet site. 35

(3) A licence granted under **section 165A** may be subject to any other terms that the court thinks fit.

(4) For the purposes of this section,—

licensee's Internet site means an Internet site maintained by, or on behalf of, the licensee

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WTO Internet site means an Internet site maintained by, or on behalf of, the World Trade Organization that contains pages dedicated to the system established by Article 31bis of the TRIPS agreement.

165D Copy of order must be sent to Commissioner and Secretary of Foreign Affairs and Trade

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(1) The Registrar of the court must, as soon as is reasonably practicable after an order is made under **section 165A**, send a copy of the order to the Commissioner and the Secretary.

(2) The Secretary must, as soon as is reasonably practicable after receiving a copy of the order, publish a copy of the order on an Internet site maintained by, or on behalf of, the Ministry of Foreign Affairs and Trade.

15

General provisions relating to compulsory licences

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166 Remuneration payable to patentee

If a licence is granted under **section 165** this subpart to a person, that person must pay the remuneration to the patentee the remuneration—

(a) that is agreed between that person and the patentee; or

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(b) that is determined by a method agreed between that person and the patentee; or

(c) that is determined by the court on the application of that person or the patentee in default of agreement.

Compare: 1953 No 64 s 46(6)

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167 Licence must not be granted in certain circumstances

(1) A licence must not be granted under **section 165** unless the person applying for the licence, having taken all reasonable steps to do so, has been unable to obtain a licence, or to obtain a licence on reasonable terms, from the patentee.

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- (2) A licence must not be granted under **section 165** for a patent relating to an integrated circuit.
- (3) A licence must not be granted under **section 165** that would be contrary to any treaty, convention, arrangement, or engagement applying to New Zealand and a convention country. 5
Compare: 1953 No 64 ss 46(7), (8), 54(3)
- 167** Person applying for licence must have made efforts to obtain licence from patentee on reasonable commercial terms and conditions 10
A licence must not be granted under this subpart unless the person applying for the licence, having made efforts to obtain a licence from the patentee on reasonable commercial terms and conditions, has been unable to obtain a licence, or to obtain a licence on reasonable commercial terms and conditions, from the patentee within a reasonable period of time. 15
Compare: 1953 No 64 s 46(7)
- 168** Exercise of powers on applications under section 164, 165A, or 166
- (1) The powers of the court on an application under **section 164, 165A, or 166** must be exercised with a view to ensuring that the inventor or other person beneficially entitled to a patent receives reasonable adequate remuneration having regard to the nature of the invention. 20
- (2) For the purposes of **subsection (1)**, the court must, in the case of a licence under **section 165A**, have regard to the economic value of the products made under the licence to the country to which the products will be exported under the licence. 25
Compare: 1953 No 64 s 48
- 169** Order for grant of licence has effect as deed
- (1) Any order under this ~~Act~~ subpart for the grant of a licence has effect as if it were a deed, executed by the patentee and all other necessary parties, granting a licence in accordance with the order. 30
- (2) **Subsection (1)** does not limit any other method of enforcement. 35
Compare: 1953 No 64 s 54(1)

Subpart 6—Crown use of patented inventions

170 Crown use of patented inventions

- (1) Any government department, and any person authorised in writing by a government department, may exploit any patented invention for the services of the Crown at any time after the complete specification relating to an application for a patent for the invention has become open to public inspection. 5
- (2) ~~Anything done under **subsection (1)** does not amount to an infringement of the patent concerned.~~ 10
- (2) The exploitation of an invention under **subsection (1)** is not an infringement,—
- (a) if the application for a patent is pending, of the nominated person's rights in the invention; or
- (b) if a patent has been granted for the invention, of the patent. 15
- (3) **Subsection (1)**—
- (a) is subject to **sections 177 to 179**; but
- (b) applies despite any other provision of this Act.
- (4) For the purposes of this subpart,— 20
- (a) any use of an invention for the supply to the ~~Government~~ government of any country outside New Zealand of products required for the defence of that country must be treated as exploitation of the invention for the services of the Crown if that supply is made in accordance 25 with any agreement or arrangement between the Government of New Zealand and the ~~Government~~ government of that country:
- (b) the power of a government department or a person authorised by a government department under this section to exploit a ~~patented~~ an invention includes the power to sell to any person any products made in the exercise of the powers conferred by this section that are no longer required for the purpose for which they were made: 30
- (c) the power of a government department or a person authorised by a government department under this section to sell a ~~patented~~ an invention does not, in the case of an application for a patent or a patent relating to an inte- 35

grated circuit, extend to the sale of the invention to the public.

Compare: 1953 No 64 s 55(1), (2); Patents Act 1990 s 163 (Aust)

171 Regulations Order in Council may declare use to be Crown use 5

Any use of an invention must, for the purposes of this subpart, be treated as a use for the services of the Crown if the Governor-General, by Order in Council, declares that the use of the patented invention by a person, or by any class of persons, engaged in a particular industry is necessary or desirable to enable full benefit to be derived by the members of the public in New Zealand of any enterprise or undertaking in which the Crown or any government department has a complete or an almost complete monopoly. 10

Compare: 1953 No 64 s 55(3) 15

172 Protection of buyers

The buyer of any products sold in the exercise of powers conferred by **section 170**, and any person claiming through the buyer, has the power to deal with them in the same manner as if the patent were held on behalf of the Crown. 20

Compare: 1953 No 64 s 55(4)

173 Rights of third parties in respect of Crown use

(1) This section applies in relation to any use of a patented invention, or of an invention for which a patent application is pending, made for the services of the Crown— 25

- (a) by a government department or a person authorised by a government department under **section 170**; or
- (b) by the patentee, nominated person, or applicant for the patent to the order of a government department.

(2) The provisions of any licence, assignment, or agreement made between the patentee, nominated person, or applicant for the patent, or any person who derives title from that person or from whom that person derives title, and any person other than a government department is of no effect to the extent that those provisions— 30 35

- (a) restrict or regulate the use of the invention referred to in **subsection (1)**; or
 - (b) restrict or regulate the use of any model, document, or information relating to the invention in relation to the use of the invention referred to in **subsection (1)**; or 5
 - (c) provide for the making of payments for any of those uses or calculated by reference to any of those uses.
- (3) The reproduction or publication of any model or document in connection with a use referred to in **subsection (1)** is not an infringement of any copyright subsisting in the model or document. 10
- (4) **Subsection (2)**—
- (a) applies whether the licence, assignment, or agreement is made before or after the commencement of this section; and 15
 - (b) is subject to **sections 177 and 179**.
- Compare: 1953 No 64 s 56

174 Reference of disputes concerning Crown use

- (1) The following disputes may be referred to the court by either party to the dispute in the manner that is prescribed by rules of the court: 20
- (a) any dispute concerning the exercise by a government department or a person authorised by a government department of the powers conferred by **section 170**;
 - (b) any dispute concerning the terms for the use of an invention for the services of the Crown under that section. 25
- (2) In any proceedings under this section, the government department may,—
- (a) if the patentee is a party to the proceedings, apply for the revocation of the patent on any ground on which a patent may be revoked under **subpart 11 of Part 3**; and 30
 - (b) in any case, put in issue the validity of the patent without applying for its revocation.
- (3) In determining any dispute referred to the court under this section, the court must have regard to— 35
- (a) any benefit or compensation that the nominated person or patentee of the patented invention may have received,

- or may be entitled to receive, directly or indirectly from any government department or person authorised by a government department in respect of the invention; and
- (b) the need to ensure that the nominated person or patentee receives reasonable adequate remuneration having regard to the nature of the patented invention. 5

Compare: 1953 No 64 s 57(1)–(3)

175 Court may refer matter to special or official referee or arbitrator

- (1) In any proceedings under **section 174**, the court may order the whole proceedings or any question or issue of fact arising in the proceedings to be referred to a special or official referee or an arbitrator on any terms that the court thinks fit. 10
- (2) References to the court in **section 174** must be construed as including a reference to the special or official referee or arbitrator. 15

Compare: 1953 No 64 s 57(4)

176 Special provisions as to Crown use during emergency

- (1) The powers exercisable in relation to an invention by a government department or a person authorised by a government department under **section 170** include the power to exploit the patented invention for any purpose that appears to the government department necessary or desirable— 20
- (a) to avoid prejudice to the security or defence of New Zealand; or 25
- (b) to assist in the exercise of powers and the implementation of civil defence emergency management during a state of emergency declared under the Civil Defence Emergency Management Act 2002.
- (2) This section is subject to **sections 177 to 179**. 30

Compare: 1953 No 64 s 58

177 Nature and scope of rights under section 170

- (1) The right to use a patented an invention under **section 170**—
- (a) is not exclusive; and

- (b) must not be assigned otherwise than in connection with the goodwill of the business in which the ~~patented~~ invention is used; and
- (c) is, despite **section 170(4)(a)**, limited to the supply of the ~~patented~~ invention predominantly in New Zealand by a government department or a person authorised by a government department under that section. 5
- (2) The right to use a ~~patented~~ an invention under **section 170** may, on the application of any interested ~~party~~ person, be terminated by the court if the court is satisfied that the circumstances that gave rise to the right to use the ~~patented~~ invention have ceased to exist and are unlikely to recur. 10
- (3) The right to use a ~~patented~~ an invention under **section 170** is, except in a case to which **section 176** applies, subject to the government department or person authorised by a government department under **section 170** having first ~~taken all reasonable steps to obtain the consent of the patentee to the use of the patented invention on reasonable terms and conditions, and having failed to obtain that consent within a reasonable period of time~~ made efforts to obtain the consent of the nominated person or the patentee for the use of the invention on reasonable commercial terms and conditions, and having failed to obtain that consent, or to obtain that consent on reasonable commercial terms and conditions, within a reasonable period of time. 15 20 25

Compare: 1953 No 64 s 58A

178 **Duty to inform nominated person or patentee**

- (1) If any use of a ~~patented~~ an invention is made by or with the authority of a government department under **section 170**, the government department must, as soon as practicable after the use of the ~~patented~~ invention has begun, notify and provide the nominated person or patentee with any information concerning the extent of the use as the nominated person or patentee may from time to time require. 30
- (2) **Subsection (1)** does not require the government department to notify or disclose information to the nominated person or 35

patentee if to do so would, or might reasonably be expected to, prejudice the security or defence of New Zealand.

Compare: 1953 No 64 s 58B

179 Nominated person or patentee entitled to remuneration

The Crown must, if an act is done under **section 170**, pay 5
~~the remuneration to the patentee~~ to the nominated person or patentee the remuneration—

- (a) that is agreed between the nominated person or patentee and the Crown; or
- (b) that is determined by a method agreed between the nom- 10
inated person or patentee and the Crown; or
- (c) that is determined by the court under **section 174** in default of agreement.

Compare: 1953 No 64 s 58C

Subpart 7—Mention of inventor in patent, 15
specification, and patents register

180 Mention of inventor in patent, specification, and patents register

- (1) This section applies if the Commissioner is satisfied, on a request or claim made under **section 181**,— 20
 - (a) that the person in respect of whom, or by whom, the request or claim is made is the inventor of—
 - (i) an invention for which a patent application has been made; or
 - (ii) a substantial part of an invention for which a 25
patent application has been made; and
 - (b) that the patent application is a direct result of that person being the inventor.
- (2) The Commissioner must cause the person to be mentioned as inventor in— 30
 - (a) any patent granted in relation to the patent application; and
 - (b) the complete specification; and
 - (c) the patents register.

- (3) The mention of a person as inventor under this section does not confer or derogate from any rights under the patent.

Compare: 1953 No 64 s 23(1)

181 Request or claim to be mentioned as inventor

- (1) A request or claim made for the purposes of **section 180** must be made in the prescribed manner (if any). 5

- (2) A request or claim under this section must be made—

(a) before the date that is 2 months after the complete specification becomes open to public inspection; or

(b) within a further period (not exceeding 1 month) that the Commissioner may allow. 10

- (3) The Commissioner may only extend the period under **subsection (2)(b)** on a request to that effect made to the Commissioner before the expiry of the 2 month period referred to in **subsection (2)(a)**. 15

Compare: 1953 No 64 s 23(3)–(5)

181A Request or claim may not be considered in certain circumstances

No request or claim under **section 181** may be considered by the Commissioner if the Commissioner considers that the request or claim is based on facts that, if proved in the case of an opposition under **section 87A(1)(b)** by the person in respect of or by whom the request or claim is made, would have entitled the person to relief under **subpart 9 of Part 3**. 20

Compare: 1953 No 64 s 23(6) 25

182 Commissioner must give notice of claim and opportunity to be heard

- (1) If a claim is made under **section 181**, the Commissioner must give notice of the claim to every applicant for the patent (not being the claimant) and to any other person that the Commissioner considers is interested. 30

- (2) The Commissioner must, before deciding on any request or claim made under **section 181**, give a reasonable opportunity to be heard to any of the following persons:

- (a) the person in respect of whom, or by whom, the request or claim is made:
- (b) any person to whom notice of the claim has been given under this section.

Compare: 1953 No 64 s 23(7)

5

183 Certificate concerning ownership mention of inventor

- (1) A person who alleges that another person should not have been mentioned as inventor under **sections 180 to 182** may apply to the Commissioner for a certificate to that effect.
- (2) The Commissioner may issue a certificate that specifies that a person should not have been mentioned as inventor under those sections. 10
- (3) If the Commissioner issues a certificate, the Commissioner must rectify the specification and the patents register accordingly. 15
- (4) The Commissioner must, before deciding to issue a certificate, give a reasonable opportunity to be heard to any person that the Commissioner considers is interested.

Compare: 1953 No 64 s 23(8)

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**Part 6
Administrative and miscellaneous
provisions**

Subpart 1—Patents register and other
information on patents and patent
applications

25

Patents register

241 Patents register

- (1) The Commissioner must keep a register of patents in New Zealand in accordance with this Act and the regulations.
- (2) **Sections 252 and 253** provide for evidence relating to the patents register. 30

242 Purpose of patents register

The purpose of the patents register is to—

- (a) enable members of the public to—
 - (i) know what patents are in force and the key dates for those patents (for example, the date of filing of the patent application); and 5
 - (ii) know who is the patentee and who has other interests in a patent (for example, under a mortgage or licence) and the addresses for service of those persons; and 10
 - (iii) find out about the scope of a claim; and
 - (iv) find out other matters affecting the validity and ownership of the patent and of any licences of the patent; and
- (b) facilitate the functions of the Commissioner under this Act. 15

243 Form of patents register

The patents register may be—

- (a) an electronic register; or
- (b) kept in any other manner that the Commissioner thinks fit. 20

244 Contents of patents register

(1) The patents register must contain the following information for patents in force in New Zealand:

- (a) the names, addresses, nationality or principal place of business (as appropriate), and addresses for service of patentees: 25
- (b) the date of filing of the patent application, the patent date, the priority date or dates, the date of the publication of the accepted complete specification, the date the complete specification became open to public inspection, the date that the patent is granted, and the date the next renewal fee is due: 30
- (c) titles of the complete specifications:
- (d) details of assignments and transmissions: 35
- (e) the names, addresses, and addresses for service of licensees and other persons with interests in patents:

- (f) any other matters required by or under this Act to be entered in the patents register.
- (2) The patents register may also contain any other information that the Commissioner considers necessary or desirable.
- (3) No notice of any trust may be entered in the patents register, and the Commissioner is not affected by any notice of that kind. 5
Compare: 1953 No 64, s 83(1), (4)
- Searches of patents register and obtaining patent information* 10
- 245 Search of patents register**
A person may search the patents register in accordance with this Act or the regulations.
- 246 Requests for patent information**
The Commissioner must give a person the prescribed information concerning a patent or patent application if the person requests it in the prescribed manner. 15
Compare: 1953 No 64 s 90
- 247 Loss or destruction of patent**
If the Commissioner is satisfied that a patent has been lost or destroyed or cannot be produced, he or she may, on request by a person in the prescribed manner, provide a replacement copy of the patent. 20
Compare: 1953 No 64 s 92
- Changes to patents register and other official documents* 25
- 248 Changes to patents register**
The Commissioner may make changes to the patents register in accordance with this Act or the regulations.
- 249 Commissioner may correct own mistakes in patents register, etc** 30
- (1) The Commissioner may correct an error or omission that the Commissioner is satisfied has been made by the Commissioner

(or an employee or other person providing services for the benefit of the Commissioner or IPONZ) in—

- (a) the patents register; or
 - (b) any patent; or
 - (c) any other document issued under this Act. 5
- (2) The Commissioner must, before making the correction,—
- (a) give notice that the Commissioner proposes to make the correction to persons that the Commissioner thinks have an interest in it; and
 - (b) give those persons a reasonable opportunity to be heard. 10
- (3) The Commissioner may require production of the patent or other document to make the correction.

Compare: 1953 No 64 s 88(1), (2)

250 Commissioner may correct other persons' mistakes in patents register, etc 15

- (1) The Commissioner may (on application by any person or on the Commissioner's own initiative) correct an error or omission that the Commissioner is satisfied has been made by any person in—
- (a) the patents register; or 20
 - (b) any patent; or
 - (c) any patent application; or
 - (d) any documents filed in connection with a patent application or filed in proceedings before the Commissioner in connection with a patent or patent application. 25
- (2) Any person (whether or not that person made the error or omission) may apply for a correction under this section in the prescribed manner.
- (3) The Commissioner must, before making the correction, publish in the journal the nature of the proposed correction if the Commissioner thinks that—
- (a) the correction would materially alter the meaning or scope of the document to be corrected; and
 - (b) it ought not be made without notice to persons who have an interest in it. 35

- (4) If a person gives notice within the prescribed time to the Commissioner of opposition to the application for the proposed correction, the Commissioner must, before deciding the matter,—
- (a) give notice of the opposition to the applicant; and
 - (b) give the applicant and opponent a reasonable opportunity to be heard. 5
- (5) This section does not apply to an error or omission by persons referred to in **section 249(1)** or to an error or omission in a complete specification (*see **section 37A** and **subpart 8 of Part 3*** for amendments to complete specifications). 10
- Compare: 1953 No 64 s 88(3), (4)

251 Court may rectify patents register

- (1) The court may, on application of any person aggrieved, order the patents register to be rectified by making an entry, or varying or deleting an entry, in it. 15
 - (2) In a proceedings under this section, the court may determine any question that it is necessary or expedient to decide in connection with the rectification of the patents register.
 - (3) The applicant for rectification must give notice of the application in the prescribed manner to the Commissioner. 20
 - (4) The Commissioner is entitled to appear and be heard on the application, and must appear if so directed by the court.
 - (5) Any order by the court under this section must direct that notice of the order must be served on the Commissioner in the prescribed manner. 25
 - (6) The Commissioner must, on receipt of notice of an order, rectify the patents register accordingly.
- Compare: 1953 No 64 s 87

Evidence

- #### **252 Evidence: patents register and patents** 30
- (1) The patents register is prima facie evidence of any matters required or authorised by or under this Act to be entered in it.
 - (2) A copy of, or extract from, a patent or registered document that purports to be certified as a true copy or extract by the 35

Commissioner is admissible in evidence in legal proceedings to the same extent as the original patent or document.

Compare: 1953 No 64 ss 83(3), 89(2)

253 Evidence: anything done by Commissioner

- (1) A certificate purporting to be signed by the Commissioner in relation to the matters referred to in **subsection (2)** is for all purposes prima facie evidence of those matters specified in the certificate. 5
- (2) The matters are—
- (a) that anything that he or she is authorised to do by or under this Act or the Patents Act 1953 (including entries in the patents register or register of patent attorneys) has or has not been done; or 10
 - (b) that anything that he or she is authorised or required to do by or under this Act or the Patents Act 1953 has been lawfully done; or 15
 - (c) that any person was or was not registered as a patent attorney at any particular time or during any period specified in the certificate; or
 - ~~(d) that any person did or did not hold a registration certificate at any particular time or during any period specified in the certificate; or~~ 20
 - (e) that any entry in the patents register or register of patent attorneys is as stated in the certificate. 25

Compare: 1953 No 64 s 89(1)

Journal and other publications

254 Commissioner must publish journal

- (1) The Commissioner must periodically publish a journal containing—
- (a) prescribed details concerning patents and patent applications (for example, the names and patentees of patents granted and brief descriptions of the inventions); and 30
 - (b) any other matter required by this Act, the regulations, or any other law to be published in it; and
 - (c) other information concerning patents or patent applications that the Commissioner thinks is useful or desirable 35

for patentees, patent applicants, licensees, or the public to know.

- (2) The journal may be published electronically or in any other manner that the Commissioner thinks fit.

Compare: 1953 No 64 s 112(1)

5

255 Commissioner may keep or publish indexes, etc

- (1) The Commissioner may publish indexes, specifications, abridgments of specifications, catalogues, and other works relating to inventions, patents, and patent applications that he or she thinks fit.

10

- (2) The Commissioner may keep a classification by subject matter of—

(a) specifications filed in New Zealand and open to public inspection; and

(b) printed publications relating to patents published in New Zealand that are necessary or useful for the purpose of determining with readiness and accuracy the patentability of inventions.

15

- (3) Those indexes and other documents may be published or kept electronically or in any other manner that the Commissioner thinks fit.

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Compare: 1953 No 64 s 112(2), (3)

Subpart 2—General provisions on proceedings of Commissioner

Hearing before exercise of Commissioner's discretion

25

255A Hearing before exercise of Commissioner's discretion

- (1) The Commissioner must not exercise any of the Commissioner's discretionary powers under this Act or any regulations adversely to any person without giving the person a reasonable opportunity of being heard in the prescribed manner.

30

- (2) **Subsection (1)** does not apply to—

(a) the Commissioner's power to direct an applicant to request an examination under **section 59B**:

(b) a person to whom **section 92A** applies.

35

Compare: 1953 No 64 s 94

*Giving evidence to Commissioner***256 How to give evidence to Commissioner in proceedings**

(1) Evidence must be given by affidavit or statutory declaration (unless the Commissioner directs otherwise under **subsection (2)**) in proceedings before the Commissioner under this Act. 5

(2) However, the Commissioner may—

(a) take oral evidence instead of, or as well as, the affidavit or declaration; and

(b) allow a witness to be cross-examined on the witness's affidavit, declaration, or oral evidence. 10

(3) The statutory declaration may be used before a court in any appeal instead of evidence by affidavit and, if used in this way, has all the same incidents and consequences as evidence by affidavit. 15

(4) Section 111 of the Crimes Act 1961 (which relates to false statements or declarations) applies to every affidavit and statutory declaration made for the purposes of this Act.

Compare: 1953 No 64 s 96(1), (4)

257 Commissioner may receive evidence on oath

20

(1) The Commissioner may also administer oaths to any witness in proceedings before him or her.

(2) Evidence given on oath before the Commissioner is given in judicial proceedings for the purposes of sections 108 and 109 of the Crimes Act 1961 (which relate to perjury). 25

Compare: 1953 No 64 s 96(2), (3)

258 Issuing of summons by Commissioner

(1) The Commissioner may issue a summons to a person requiring that person to attend a hearing before the Commissioner and to do all or any of the following matters: 30

(a) give evidence:

(b) give evidence under oath:

(c) produce documents, things, or information, or any specified documents, things, or information, in the possession or control of that person that are relevant to the hearing. 35

- (2) The Commissioner may require that any documents, things, or information produced under this section be verified by oath, statutory declaration, or otherwise.
- (3) **Sections 283 to 285** contain requirements for the summons and offences for failing to comply with the summons. 5

Power to award costs

259 Commissioner may award costs

- (1) The Commissioner may, in any proceedings before him or her under this Act,—
 - (a) by order, award to a party costs ~~that the Commissioner considers reasonable~~ of an amount that the Commissioner thinks appropriate (which, without limitation, may be on an indemnity basis); and 10
 - (b) direct how and by what parties they are to be paid.
- (2) The order may be entered as a judgment of the court and, ~~with the leave of the court,~~ may be enforced accordingly. 15
 Compare: 1953 No 64 s 95(1)

260 Commissioner ~~or court~~ may require security for costs

- (~~1~~) ~~The Commissioner or the court on appeal, as the case may be, may require a party to proceedings to give security for the costs of the proceedings or appeal if the party does not reside, and does not carry on business, in New Zealand.~~ 20
- (1) The Commissioner may require a party to proceedings to give security for the costs of the proceedings if the Commissioner is satisfied that— 25
 - (a) the party does not reside, and does not carry on business, in New Zealand; or
 - (b) there is reason to believe that the party will be unable to pay the costs of the other party if unsuccessful in the proceedings. 30
- (2) If the party does not give the security required, the Commissioner ~~or court~~ may treat the proceedings as abandoned by the party and determine the matter accordingly.
 Compare: 1953 No 64 s 95(2)

*Appeals of against Commissioner's decisions***261 Appeals of against decisions of Commissioner**

- (1) A person who is aggrieved by a decision of the Commissioner under this Act may appeal to the court.
- (2) An appeal must be brought— 5
- (a) ~~must be brought by way of notice of appeal~~ in accordance with the rules of court; and
- (b) ~~must be lodged~~ within—
- (i) 20 working days after the date of the decision; or
- (ii) any further time the court allows on application 10
made before or after that period expires.
- (3) ~~This section—~~
- (a) ~~does not apply to decisions of the Commissioner under **Part 5** (see **section 222** for appeals of those decisions):~~ 15
- (b) ~~does not allow an appeal to be made to the court from a decision of the Commissioner under **section 27 or 28** (see **section 29** for reviews of those decisions):~~
- (4) This section does not allow an appeal to be made to the court from a decision of the Commissioner under **section 27 or 28** (see **section 29** for reviews of those decisions). 20

262 Decisions to have effect pending determination of appeal

A decision against which an appeal under **section 261** is lodged continues in force pending the determination of the appeal unless the court orders otherwise.

25

263 Procedure on appeal

- (1) An appeal must be heard as soon as is reasonably practicable after it is lodged.
- (2) An appeal is by way of rehearing.
- (3) On hearing the appeal, the court— 30
- (a) may confirm, reverse, or modify the decision appealed against; and
- (b) may make any other decision that the Commissioner could have made.
- (4) The court must not review— 35
- (a) any part of a decision not appealed against; or

~~(b) any decision not appealed against at all.~~

264 Appeals of against decisions of court on appeal

- (1) A decision of the court on an appeal ~~of~~ against a decision of the Commissioner may be ~~further~~ appealed to the Court of Appeal if— 5
- (a) the decision was made under **section 25** (which relates to the Commissioner’s power to give directions to co-owners); or
 - (b) the decision was made under **section 92** or **104** (which relates to the revocation of a patent by the Commissioner) and the effect of the decision is the revocation of a patent; or 10
 - (c) the court or Court of Appeal gives leave.
- (2) All other decisions of the court on an appeal of a decision of the Commissioner are final. 15
- Compare: 1953 No 64 ss 97(4), 98

Costs of Commissioner

265 Costs of Commissioner in proceedings

In ~~all~~ any proceedings before a court under this Act, the costs of the Commissioner are at the discretion of the court. 20

Compare: 1953 No 64 s 99

Subpart 3—Establishment and operation of administrative bodies and officers for patents

Commissioner and Assistant Commissioners

266 Commissioner and Assistant Commissioners 25

- (1) The chief executive of the Ministry must appoint, under the State Sector Act 1988,—
- (a) the Commissioner of Patents; and
 - (b) as many Assistant Commissioners of Patents as may be necessary for the purposes of this Act. 30
- (2) These persons are employees of the Ministry, and those appointments may be held separately or in conjunction with any other office in the Ministry.
- Compare: 1953 No 64 ss 3, 4

267 Functions of Commissioner

The functions of the Commissioner are, in accordance with this Act and the regulations, to—

- (a) examine patent applications and specifications, grant patents, revoke patents, and accept surrenders of patents, and make other decisions relating to patent applications and patent grants: 5
- (b) ~~assess candidates for registration, register patent attorneys, and carry out other functions relating to their registration, in accordance with **Part 5**:~~ 10
- (c) ~~provide administrative support to the Board:~~
- (d) maintain the patents register and carry out other functions relating to the patents register:
- (e) ~~maintain the patent attorneys register and carry out other functions relating to the patent attorneys register:~~ 15
- (f) maintain and supply information on patents and patent applications, including by publishing a journal:
- (fa) register persons as patent attorneys, and carry out other functions relating to their registration and the register of patent attorneys, under the Patents Act 1953: 20
- (g) carry out other functions, duties, and powers conferred on him or her by this Act and the regulations.

268 Powers of Assistant Commissioners of Patents

- (1) An Assistant Commissioner of Patents has the functions, duties, and powers of the Commissioner under this Act (other than the power to delegate under **section 269**), but is subject to the control of the Commissioner. 25
- (2) The fact that an Assistant Commissioner exercises those functions, duties, and powers is conclusive evidence of the authority to do so. 30
Compare: 1953 No 64 s 4(2), (3)

269 Power of Commissioner to delegate

- (1) The Commissioner may delegate to any person, either generally or particularly, any of the Commissioner's functions, duties, and powers (except this power of delegation). 35
- (2) A delegation—
 - (a) must be in writing; and

- (b) may be made subject to any restrictions and conditions that the Commissioner thinks fit; and
 - (c) is revocable at any time, in writing; and
 - (d) does not prevent the performance or exercise of a function, duty, or power by the Commissioner. 5
- (3) A person to whom any functions, duties, or powers are delegated may perform and exercise them in the same manner and with the same effect as if they had been conferred directly by this Act and not by delegation.
- (4) A person who appears to act under a delegation is presumed to be acting in accordance with its terms in the absence of evidence to the contrary. 10
- (5) Any reference in this Act or the regulations to the Commissioner includes a reference to the delegate in respect of anything delegated to that person. 15

270 Annual report of Commissioner

- (1) ~~The Commissioner must, as soon as practicable after 30 June, but no later than 30 September, of each year, give to the Minister a report on the operation of this Act for the year ended on the immediately preceding 30 June.~~ 20
- (2) ~~The report must include an account of fees, salaries, allowances, and other money received and paid under this Act during that year, and any other reports required by other Acts or by the regulations.~~
- (3) ~~The Minister must present a copy of the report to the House of Representatives within 6 sitting days of receiving it.~~ 25
Compare: 1953 No 64 s 116

271 Liability of Commissioner and others

The Commissioner, an Assistant Commissioner, or any other person acting on behalf of the Commissioner is not personally liable for any act or omission done in good faith in the performance or intended performance of the Commissioner's functions, duties, or powers. 30

*Intellectual Property Office of New Zealand***272 Intellectual Property Office of New Zealand**

- (1) The Minister may, by notice in the *Gazette*,—
- (a) appoint a place where there is an office situated for the purpose of communications to and from the public on matters arising under this Act, the Trade Marks Act 2002, the Designs Act 1953, and any other intellectual property statutes that the Minister thinks fit; and 5
 - (b) change that place; and
 - (c) name that office; and 10
 - (d) change the name of that office.
- (2) On the commencement of this section (to avoid the need for a notice, but without preventing future changes by notice),—
- (a) the place used as the Patent Office immediately before the commencement of this section is appointed as the place for that office; and 15
 - (b) the name of that office is the Intellectual Property Office of New Zealand.
- (3) The Governor-General may, by Order in Council, amend this Act and any other enactment by omitting the name of that office and substituting another name to reflect a name change of that office. 20

273 Opening hours of Intellectual Property Office of New Zealand

- (1) The Commissioner may— 25
- (a) fix the opening hours for IPONZ; and
 - (b) declare IPONZ closed on any day.
- (2) The Commissioner must publicly notify those opening hours and (before closing IPONZ) must publicly notify any closure.
- (3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of IPONZ, be done on the next opening day (and is then still in time). 30

274 Closing of Intellectual Property Office of New Zealand at short notice

- (1) The Commissioner may declare IPONZ closed without giving publication of the closure under **section 273** if—
- (a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and 5
- (b) it is not practicable to make that prior publication.
- (2) The Commissioner must then, if practicable, display a public notice that IPONZ is closed in or on the building in which IPONZ is situated. 10
- (3) The Commissioner must also, as soon as practicable after closing IPONZ, publicly notify the closure.

Māori advisory committee

275 Appointment and membership of Māori advisory committee

- (1) The Commissioner must appoint a committee called the Māori advisory committee. 15
- (2) The Commissioner may, at any time,—
- (a) appoint a person to the committee:
- (b) remove a member from the committee and, if the Commissioner thinks fit, appoint another member in that member's place. 20
- (3) A person must not be appointed as a member of the committee unless, in the opinion of the Commissioner, the person is qualified for appointment, having regard to that person's knowledge of mātauranga Māori (Māori traditional knowledge) and tikanga Māori (Māori protocol and culture). 25
- (4) A member of the committee may resign office by notice in writing to the Commissioner.

276 Functions of Māori advisory committee

The function of the Māori advisory committee is to advise the Commissioner (on request) on whether—

- (a) an invention claimed in a patent application is derived from Māori traditional knowledge or from indigenous plants or animals; and 35

- (b) if so, whether the commercial exploitation of that invention is likely to be contrary to Māori values.

277 Effect of advice from Māori advisory committee

The Commissioner must consider, but is not bound by, the advice given by the Māori advisory committee.

5

278 Māori advisory committee may regulate own procedure

The Māori advisory committee may regulate its own procedure, subject to any direction given by the Commissioner.

Subpart 4—Other miscellaneous provisions

Power to extend time limits

10

279 Commissioner may extend time limits for delays by Commissioner

- (1) The Commissioner may extend the time within which anything must be done under this Act or the regulations if that thing is or will not be done in time because of a delay by the Commissioner.

15

- (2) The Commissioner may grant the extension even if the time has expired for doing the thing.

Compare: 1953 No 64 s 93(1), (5)

280 Commissioner may extend time limits for certain filing requirements or for delivery failures

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- (1) The Commissioner may, on application by any person under **section 281** or at the Commissioner's own discretion, extend—

(a) the time limit under **section 35(2)(a) or (b)** (which relates to the time limit for the filing of a complete specification) or **section 50** (which relates to the filing of a convention application); or

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(b) the time within which anything must be done under this Act or the regulations if that thing is not or will not be done in time because of a failure or delay of the postal, fax, or electronic delivery.

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- (2) The Commissioner may grant the extension even if the time has expired for doing the thing.

- (3) However, the Commissioner must refuse to grant ~~an~~ the extension if in his or her opinion—
- (a) the applicant or the applicant’s agent has not allowed a reasonable margin of time for the delivery to IPONZ, by post or otherwise, of any documents or information relating to the matter for which the application for the extension is made; or
 - (b) the applicant or the applicant’s agent has in any other way failed to act with due diligence and prudence on the matter; or
 - (c) there has been undue delay in applying for the extension of time or in prosecuting the application.
- (4) The Commissioner may grant the extension on any terms or conditions he or she thinks fit.
Compare: 1953 No 64 s 93A(1), (2), (3)

281 Requirements for applying and granting extensions of time limits under section 280

- (1) A person must apply for an extension of a time limit under **section 280** in the prescribed manner.
- (2) ~~If an extension is applied for by a person’s agent, the Commissioner may require—~~
- (a) ~~written confirmation that the application is authorised by that person; and~~
 - (b) ~~the confirmation to be signed by that person and lodged with the Commissioner within the time specified by the Commissioner.~~
- (3) The Commissioner must publish every extension granted in the journal.
Compare: 1953 No 64 s 93A(4), (5)

Serving notices 30

282 Service of notices

- (1) Any notice or any other document required to be served on, or given to, any person under this Act or the regulations is sufficiently served or given if the notice or document is—

- (a) delivered personally or posted to the person at the person's address for service or last known place of residence or business; or
- (b) sent by fax or ~~email~~ electronic communication to the person's last known fax number or ~~email~~ electronic address. 5
- (2) A notice or document that is sent to a person at a fax number or an ~~email~~ electronic address must be treated as received by that person not later than 2 days after the date on which it is sent. 10
- (3) A notice or document that is posted to a person must be treated as received by that person not later than 7 days after the date on which it is posted.
- (4) However, a notice or document must not be treated as received if the person to whom it is posted or sent proves that it was not received, otherwise than through fault on the person's part. 15
- (5) This section does not apply to—
- (a) notices or other documents served or given in any proceedings in a court;
- (b) notices or other documents served or given in accordance with another procedure specified in this Act or the regulations. 20

Requirements for summons

283 Requirements for summons

- (1) A summons issued ~~by the Board under section 214~~ or by the Commissioner under **section 258** must be in writing, be signed by the ~~Board~~ or Commissioner, and state— 25
- (a) the date and time when, and the place where, the person must attend; and
- (b) the documents, things, or information that the person is required to bring and produce to the ~~Board~~ or Commissioner; and 30
- (c) the entitlement to be paid or tendered a sum in respect of witnesses' fees, allowances, and expenses; and
- (d) the penalty for failing to attend. 35
- (2) A summons may be served by—
- (a) delivering it personally to the person summoned; or

- (b) posting it to the person summoned at that person’s usual place of residence or address for service.
- (3) A summons must,—
 - (a) if it is to be served by personal delivery, be served at least 48 hours before the attendance of the witness is required: 5
 - (b) if it is to be served by post, be served at least 10 days before the attendance of the witness is required.
- (4) A summons that is posted is treated as having been served when it would have been delivered in the ordinary course of post. 10

284 Witnesses’ fees, allowances, and expenses

- (1) A witness appearing before the ~~Board~~ or Commissioner under a summons is entitled to be paid witnesses’ fees, allowances, and expenses in accordance with the scales prescribed by regulations under the Summary Proceedings Act 1957. 15
- (2) The person requiring attendance of the witness must pay or tender to the witness the fees, allowances, and expenses at the time the requirement to attend is served or at some other reasonable time before the hearing. 20

285 Offence of failing to comply with summons

- (1) A person summoned to attend before the ~~Board~~ or Commissioner commits an offence if the person, without sufficient cause,—
 - (a) fails to attend in accordance with the summons; or 25
 - (b) does not give evidence when required to do so; or
 - (c) does not give evidence under oath when required to do so; or
 - (d) does not answer any question that is lawfully asked by the ~~Board~~ or Commissioner; or 30
 - (e) does not provide any documents, things, or information that the summons requires the person to provide.
- (2) A person who commits an offence against this section is liable on summary conviction to a fine not exceeding \$2,000.
- (3) A person must not be convicted of an offence against this section if witnesses’ fees, allowances, and expenses to which the 35

person is entitled under **section 284** have not been paid or tendered to him or her.

Fees and other money paid under Act

286 Fees and penalties payable under Act or regulations

- (1) Fees and penalties must be paid for any matter arising under this Act if required by this Act or by the regulations. 5
- (2) The Commissioner may (in addition to any other action permitted under this Act) decline to do any act, or to permit any act to be done, or to receive any document, for which a fee or penalty is payable until that fee or penalty is paid. 10
- (3) Fees for international applications may, in accordance with New Zealand's obligations under the Patent Cooperation Treaty, be collected by the Commissioner on behalf of—
- (a) the International Bureau; or
- (b) any international ~~search~~ searching authority that has been approved, for the purposes of this subsection, by the Minister as an appropriate authority on whose behalf the Commissioner may collect those fees. 15

Compare: 1953 No 64 s 115(1), (3)

287 Payment and application of fees and other money paid under this Act 20

- (1) All fees and other money required to be paid by this Act or the regulations must be paid to the Commissioner (unless this Act or the regulations require otherwise).
- (2) The Commissioner must pay all the fees or other money paid to him or her under this Act into a Departmental Bank Account. 25
- ~~(3) Any fee or penalty paid in connection with registration or renewal of a registration certificate for a patent attorney must be applied for the purposes of **sections 238 and 267(b), (c), and (e)**.~~ 30
- (4) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by the regulations, may be refunded by the Commissioner, and all money so refunded may be paid out of public money without further appropriation than this Act. 35

- (5) Any amount of a fee or other money required to be paid by this Act or the regulations that is not paid is recoverable in a court of competent jurisdiction as a debt due to the Crown or, if the Act or regulations require it to be paid to a person other than the Commissioner, as a debt due to that person. 5
- (6) This section applies to fines, disciplinary penalties, and costs orders imposed under this Act other than fines for offences. 5
Compare: 1953 No 64, s 115(1), (2)

Miscellaneous

- 288 Protection of Royal arms, etc** 10
The grant of a patent does not in itself authorise the patentee to use or place on a patented product any representation specified in sections 12 to 15 of the Flags, Emblems, and Names Protection Act 1981 (which relate to the use of Royal, vice-regal, State, and heraldic emblems and names). 15
Compare: 1953 No 64, s 107
- 289 Saving for Royal prerogative and certain Crown rights**
(1) ~~Nothing in this Act takes away, limits, or prejudicially affects the prerogative of the Crown in relation to the granting of letters patent or to the withholding of a grant of letters patent.~~ 20
(2) Nothing in this Act affects the right of the Crown or any person deriving title directly or indirectly from the Crown to sell or use articles forfeited under laws relating to customs or excise.
Compare: 1953 No 64 s 117
- 290 Act does not apply to Tokelau** 25
This Act does not apply to Tokelau.
- 291 Application of Personal Property Securities Act 1999**
Nothing in **sections 16(3), 22, 155 to 157 141A, 160, 161, and 241 to 252** affects the operation of the Personal Property Securities Act 1999. 30
Compare: 1953 No 64 s 85A

Subpart 5—Regulations

292 Regulations

(1) The Governor-General may, by Order in Council, make regulations for all or any of the following purposes:

- Patent applications and the granting of patents* 5
- (a) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of patent applications and the granting of patents under this Act, including—
- (i) requiring patent applications, specifications, and any other documents relating to patent applications or specifications to be filed, made, or otherwise provided to the Commissioner in a prescribed manner: 10
- (ii) requiring those patent applications, specifications, and documents to be dealt or proceeded with in a prescribed manner: 15
- (iii) providing for further information or documents to be filed or otherwise provided to the Commissioner in the prescribed manner, in relation to any of those patent applications, specifications, or documents: 20
- (iv) providing for the procedure to be followed in connection with the division of a patent application, specification, or other document into 2 or more applications, specifications, or documents: 25
- (v) providing for the procedure to be followed in connection with the merging of separate patent applications, specifications, or documents:
- (vi) providing for the Commissioner to direct that patent applications, specifications, or documents filed under this Act be treated as having been filed on a different date from the date on which those patent applications, specifications, or other documents were actually filed: 30 35
- Applications, requests, notices, and proceedings*
- (b) requiring any applications, requests, or notices under this Act to be made or given in a prescribed manner:

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- (c) providing for the procedure to be followed in connection with any application, request, or notice under this Act, or in connection with any proceeding before the Commissioner, and for authorising the rectification of irregularities of procedure: 5
- (d) regulating the making of applications, requests, or notices under this Act by agents, and prescribing classes of persons whom the Commissioner may refuse to recognise as agents:
- Declarations as to inventor* 10
- (e) requiring a declaration concerning the inventor of an invention to be provided in prescribed cases with the complete specification or within the prescribed period after the filing of the complete specification:
- Matters under Commissioner's direction or control* 15
- (f) providing for all matters placed under the direction or control of the Commissioner by this Act or the regulations, including—
- (i) providing for the Commissioner to extend time limits under the regulations or waive requirements of the regulations: 20
- (ii) regulating applications for, oppositions to, and the granting of extensions of time limits by the Commissioner under this Act, including providing for the protection of persons who have in good faith begun to exploit an invention for which an application for an extension is made: 25
- (ia) providing for the manner in which a reasonable opportunity to be heard must be given to persons:
- (iii) providing for how statutory declarations for proceedings before the Commissioner must be made and given: 30
- (iv) providing for the Commissioner to destroy documents and information provided to him or her in connection with any application, request, or notice that is abandoned, void, or otherwise inactive for the prescribed period: 35

- Micro-organisms*
- (g) providing for the procedure to be followed in connection with the deposit for the purposes of this Act of micro-organisms with prescribed depository institutions, the furnishing of samples of micro-organisms by those institutions, and requests for those samples: 5
- (h) prescribing matters for the purposes of **sections 39 to 41**: 10
- Patent Cooperation Treaty*
- (i) carrying out, or giving effect to, New Zealand's obligations under the Patent Cooperation Treaty: 10
- (j) setting out the English text of the Patent Cooperation Treaty or the Treaty regulations as in force for New Zealand: 15
- Budapest Treaty*
- (k) carrying out, or giving effect to, New Zealand's obligations under the Budapest Treaty: 10
- (l) setting out the English text of the Budapest Treaty as in force for New Zealand: 20
- Patent attorney registration and registration certificates*
- (m) ~~prescribing procedures, requirements, and other matters, not inconsistent with this Act, relating to patent attorney registrations and registration certificates, including—~~ 25
- (i) ~~the manner in which persons must apply for registration and registration certificates:~~
- (ii) ~~the procedures to be followed in evaluating and deciding on those applications and for implementation of those decisions:~~ 30
- (iii) ~~the period for which registration certificates are in force:~~
- (iv) ~~the subjects or subject groups in which candidates must have passed examinations to have the qualifications required for registration:~~ 35
- (v) ~~the criteria for the type of experience required for candidates for registration:~~

(vi)	the procedures and requirements that apply to the Board’s assessment and certification of qualifications and experience of candidates for registration against the requirements in Part 5 or the regulations:	5
(vii)	the procedures and requirements that apply to a removal or suspension of registration:	
(viii)	any minimum and maximum periods for a voluntary suspension of registration:	
	<i>Examinations and courses of study</i>	10
(n)	prescribing procedures, requirements, and other matters, not inconsistent with this Act, relating to examinations conducted by the Board and courses of study and examinations conducted by persons accredited by the Board, including—	15
(i)	the manner in which persons must apply to sit those examinations or carry out the course:	
(ii)	the fees payable to examiners or instructors:	
	<i>Complaints and disciplinary matters on patent attorneys</i>	20
(o)	prescribing procedures, requirements, and other matters, not inconsistent with this Act, relating to complaints on patent attorneys and disciplining of patent attorneys, including—	
(i)	the manner in which persons must make complaints:	25
(ii)	the investigation of and decisions on those complaints, and the implementation of those decisions:	
(iii)	the exercise by the Commissioner and the Board of their functions relating to complaints and disciplinary matters:	30
(iv)	constituting a complaints assessment committee and disciplinary committee and delegating Board functions and powers to those committees for the purposes of the disciplinary regime:	35

- Board functions*
- (p) ~~regulating the manner in which the Board exercises any of its other functions under this Act:~~
- Registers*
Patents register
- (q) prescribing procedures, requirements, and other matters, not inconsistent with this Act, for ~~any register that the Commissioner is required to keep under this Act~~ the patents register, including matters relating to—
- (i) the operation of the register:
- (ii) access to and search of the register: 10
- (iii) the location of, and hours of access to, the register:
- Journal*
- (r) prescribing the manner in which something must be published in the journal: 15
- Fees and penalties*
- (s) prescribing fees and penalties to be paid, or the means by which those fees and penalties may be calculated or ascertained, for any matter under this Act or the regulations or any provisions of the Patents Act 1953 or Patents Regulations 1954 that are preserved by **section 295A**: 20
- (t) prescribing the period for the payment of a renewal fee or maintenance fee:
- (u) exempting, or providing for the Commissioner to exempt from, waive, or refund, fees or penalties: 25
- General*
- (v) providing for transitional or savings provisions:
- (w) providing for any other matters contemplated by this Act, necessary for its administration, or necessary for giving it full effect. 30
- (2) The structure of the fee system under this Act prescribed by regulations under **subsection (1)** may be such that the renewal and maintenance fees—
- (a) recover a share of the costs incurred by the Commissioner in performing his or her functions under this Act or the Patents Act 1953; and 35

- (b) recover those costs at a level that provides an appropriate incentive (having regard to the purpose of this Act set out in **section 3(aa)**) for applicants to let patent applications become void or abandoned and patentees to let patents lapse if they do not receive, or will not receive, sufficient benefit from having the patent. 5

Compare: 1953 No 64, ss 93A(7), 96(5), 114

293 Supplementary empowering provision

- (1) For the purposes of this Act, the power for regulations made to prescribe the manner in which a thing is done includes the power to— 10
- (a) prescribe when, where, and how the thing must be done:
 - (b) prescribe the form that must be used in connection with doing the thing:
 - (c) prescribe what information must be provided or other evidence or documents must be provided in connection with the thing: 15
 - (d) prescribe requirements with which information, evidence, or documents that are provided in connection with the thing must comply: 20
 - (e) provide for the Commissioner to determine any of the matters in **paragraphs (a) to (d)**:
 - (f) prescribe that fees must be paid in connection with doing the thing.
- (2) Any regulations made under **section 292** or this section may prescribe, or provide for the Commissioner to determine, different or additional procedures, requirements, or matters in relation to different classes of applications, requests, notices, or other matters. 25

294 Orders in Council as to convention countries

For the purpose of giving effect to any international agreement or arrangement to which New Zealand is a party or that applies to New Zealand, the Governor-General may, by Order in Council, declare that any entity specified in the order that is a party to the agreement or arrangement or to which the agreement or arrangement applies (whether a State, part of a State, a territory for whose international relations a State is respon- 35

sible, a political union, an international organisation, or any other entity) is, for the purposes of all or any of the provisions of this Act, a convention country.

Subpart 6—Repeals, amendments,
validation, and saving and transitional
provisions 5

295 Repeal of Patents Act 1953 and consequential revocations

- (1) The Patents Act 1953 (except for the sections set out in **section 295A**) (1953 No 64) is repealed.
- (2) The Patents Regulations 1954 (except for the provisions set out in **section 295A**) (SR 1954/211) are consequentially revoked. 10
- (3) The Patents (Patent Cooperation Treaty) Regulations 1992 (SR 1992/316) are consequentially revoked.

295A Preservation of patent attorney provisions 15

- (1) The following sections of the Patents Act 1953 are not repealed by **section 295**:
 - (a) section 2 (interpretation):
 - (b) sections 88(1), (2), and (5), 89, 93, and 93A(2) to (7) (powers connected to register and registration process): 20
 - (c) sections 100 to 104 (patent attorneys):
 - (d) sections 105 and 108 (offences):
 - (e) section 110 (service of notices, etc, by post):
 - (f) section 114(1) and (2) (except paragraphs (a) to (c), (i), (j), and (l)) (regulations). 25
- (2) The following provisions of the Patents Regulations 1954 are not repealed by **section 295**:
 - (a) regulation 2 (interpretation):
 - (b) Part 2 (fees), to the extent it relates to the fees prescribed by items 10 to 13 and 15 to 17 in Schedule 1: 30
 - (c) regulation 129 (except paragraphs (a) to (c) and (e)) (public inspection of register):
 - (d) Part 30 (patent attorneys):
 - (e) regulations 166, 167, 168, and 169(1) and (3) (powers connected to register and registration process): 35
 - (f) Schedule 1, items 10 to 13 and 15 to 17 (fees).

- (3) Any reference in a provision preserved by this section to the Commissioner, the Journal, or the Patent Office must be read as a reference to the Commissioner or journal under this Act or to IPONZ (as the case may be).

296 Consequential amendments to other enactments 5
The enactments set out in **Schedule 2** are amended in accordance with that schedule.

297 Preservation of various regulations and orders

- (1) The following regulations continue in force, despite the repeal of the Patents Act 1953, as if made under this Act: 10
- (a) Patents, Designs, and Trade Marks Convention Order 2000 (SR 2000/236) (except that clause 4 is revoked):
 - (b) Patents (United States of America) Regulations 1956 (SR 1956/159):
- (2) An order or regulation that continues in force under this section may be amended or revoked as if it had been made under this Act: 15

297 Preservation of various regulations and orders

- (1) The Patents, Designs, and Trade Marks Convention Order 2000 (SR 2000/236)— 20
- (a) continues in force, despite **section 295**, as if made under this Act (except that clause 4 is revoked):
 - (b) may be amended or revoked as if made under this Act.
- (2) The Patents (United States of America) Regulations 1956 (SR 1956/159)— 25
- (a) continue in force, despite **section 295**, as if made under this Act:
 - (b) apply despite any inconsistency with the provisions of this Act:
 - (c) may be amended or revoked as if section 81 of the Patents Act 1953 were still in force. 30

298 Validation of fees

- (1) All fees prescribed under the Patents Act 1953 that relate to the registration of patent attorneys or prescribed examinations

under that Act must be taken to be and always to have been lawfully imposed.

- (2) All money received by the Commissioner from the fees referred to in **subsection (1)** must be taken to be and always to have been lawfully collected.

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298A Validation of priority date for Treaty applications

- (1) This section applies to a Treaty application made under the Patents Act 1953 that claims the priority, under Article 8 of the Patent Cooperation Treaty, of an earlier application made in New Zealand.

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- (2) The claim to priority by the application is validated and must be taken to be, and always to have been, lawful to the extent that it would have been valid under the Patents Act 1953 if New Zealand had been a convention country for the purposes of that Act.

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Transitional provisions for patents and patent applications

299 Outline of transitional provisions for patents

- (1) The general scheme and effect of the transitional provisions for patents on and from the commencement of **Part 3** of this Act (**commencement**) is as follows:

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- (a) this Act applies to patents granted under the Patents Act 1953 ~~on~~ before commencement (but patents retain their existing key dates, term, and grounds for revocation):

- (b) patent applications made under the Patents Act 1953 generally continue to be dealt with under that Act on and from commencement, but—

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- (i) if a complete specification is later filed, this Act then applies to the patent application:

- (ii) if a patent application is post-dated to a date on or after commencement, this Act applies to the patent application:

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- (c) Treaty applications made under the Patents Act 1953—

- (i) continue to be dealt with under that Act if the applicant has fulfilled the applicant's obligations

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- under Article 22(1) or 39(1)(a) of the Patent Co-operation Treaty before commencement; and
- (ii) must be dealt with under this Act if the applicant did not fulfil those obligations before that time:
- (d) if a fresh patent application is made, even after commencement, in respect of a patent application that is under the Patents Act 1953, and if the fresh patent application is given a date before commencement, the fresh patent application must still be dealt with under that Act. 5
- (2) This section is a guide only to the general scheme and effect of the transitional provisions for patents. 10

300 Transitional provision for patents granted under Patents Act 1953

- (1) This Act applies to a patent granted under the Patents Act 1953 as if it were granted under this Act. 15
- (2) However,—
- (a) the patent retains its original date of filing of the patent application, patent date (that is the date of filing of the complete specification), priority date or dates, date of the publication of the accepted complete specification, date that the patent was granted, and date that the next renewal fee was due under the Patents Act 1953; and 20
- (b) the patent retains its existing term; and
- (c) the next renewal fee (after this ~~Act~~ section comes into force) must be paid when due in accordance with the Patents Act 1953 but, after that due date, renewal fees become due in accordance with this Act; and 25
- (d) on ~~re-examining the~~ a re-examination of the patent application and the complete specification under **section 89**, the grounds that a person may specify in a request for re-examination, and that the Commissioner ~~must~~ may consider and report on the ~~matters~~, are the grounds in section 41(1)(e) and (f) of the Patents Act 1953 (rather than the ~~matters grounds~~ in **section 90 106** of this Act); and 30 35
- (e) the Commissioner or the court may revoke the patent under ~~section 104~~ this Act only on the grounds set out in section 41(1) or (3) of the Patents Act 1953, and

- only those grounds are available as grounds of defence in a proceeding for the infringement of the patent (rather than the grounds in **section 106** of this Act); and
 (f) **section 138A** of this Act does not apply.

301 Patent applications made under Patents Act 1953 continue under that Act 5

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply (as if **section 295** were not in force) to a patent application made under that Act ~~and not deemed to be void, refused, granted, withdrawn, or abandoned~~ before the commencement of **Part 3** of this Act. 10
- (1A) Any reference in any other enactment to a repealed provision of the Patents Act 1953 continues to have effect for the purposes of **subsection (1)** as if the reference had not been repealed or amended by this Act. 15
- (2) **Section 300** applies to any patent granted in respect of that application.

302 Patents Act 1953 ceases to apply to patent application if complete specification later filed 20

- (1) The Patents Act 1953 ceases to apply to a patent application made under that Act if a complete specification is filed on or after the commencement of **Part 3** of this Act for the following reasons, or any other reason: 25
- (a) only a provisional specification was filed before the commencement of **Part 3**; or
- (b) the original complete specification was directed (whether before or after the commencement of **Part 3**) to be treated as a provisional specification under section 9(4) of the Patents Act 1953. 30
- (2) In this case, the complete specification must comply with this Act, and this Act applies to the patent application, as if the patent application had been made under this Act.
- (3) If a complete specification is provided for 2 or more patent applications that are cognate or of which one is a modification of 35

another, this section applies to those 2 or more patent applications.

303 This Act applies if patent application under Patents Act 1953 is post-dated

If a patent application made under the Patents Act 1953 is post-dated, on the request of the applicant, to a date that is on or after the commencement of **Part 3** of this Act, this Act applies to the patent application as if the patent application had been made under this Act. 5

304 Patents Act 1953 applies to divisional applications dated before commencement 10

If a fresh patent application is made on or after the commencement of **Part 3** of this Act for any part of the subject-matter of a patent application to which the Patents Act 1953 applies, and the fresh patent application is given a date before that commencement, the fresh patent application must also be treated as a patent application made under the Patents Act 1953 (and **sections 301 and 302** apply). 15

305 Which Act applies to Treaty applications

(1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply (as if **section 295** were not in force) to a Treaty application made under that Act if the applicant fulfilled the applicant's obligations under Article 22(1) or Article 39(1)(a) of the Patent Cooperation Treaty; ~~and the application was not deemed to be void, refused, granted, withdrawn, or abandoned,~~ before the commencement of **Part 3** of this Act. 20 25

(1A) Any reference in any other enactment to a repealed provision of the Patents Act 1953 continues to have effect for the purposes of **subsection (1)** as if the reference had not been repealed or amended by this Act. 30

(2) **Section 300** applies to any patent granted in respect of that application.

- (3) However, this Act applies to a Treaty application made under the Patents Act 1953 if the applicant did not fulfil those obligations before the commencement of **Part 3**.

*Transitional provisions for other applications,
notices, and requests*

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306 Transitional provision for other applications, notices, or requests

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply (as if **section 295** were not in force) to any application (other than a patent application or an application for registration as a patent attorney), notice, or request that was received by the Commissioner or the court (as the case may be) before the commencement of **Part 3** of this Act. 10
- (2) However, if an application, notice, or request of that kind relates to a patent application— 15
- (a) to which the Patents Act 1953 applies, that Act (and the regulations, orders, directions, and other matters made under it) ~~apply~~ applies to the other application, notice, or request also (as if **section 295** were not in force); or 20
- (b) to which this Act applies, this Act applies to the other application, notice, or request also.
- (3) If the Patents Act 1953 continues to apply to an application, notice, or request under this section, any reference in any other enactment to a repealed provision of the Patents Act 1953 continues to have effect for that purpose as if the reference had not been repealed or amended by this Act. 25

*Transitional provision for matters in force on
commencement*

307 Transitional provision for orders, directions, and other matters in effect on commencement

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- (1) An order, direction, or any other matter made under a repealed provision of the Patents Act 1953 or a revoked provision of the Patents Regulations 1954, and that is in effect immediately before the commencement of this section, continues to have 35

effect as if it had been made under the provision of this Act or the regulations—

- (a) that, with or without modification, replaces, or that corresponds to, the provision of the Patents Act 1953 under which it was made; and 5
 - (b) under which it could be made.
- (2) The order, direction, or other matter may be amended or revoked as if it had been made under the provision of this Act or the regulations that replaces, or that corresponds to, the provision of the Patents Act 1953 or the Patents Regulations 1954 under which it was made. 10

Transitional provision for patents register and register of patent attorneys

- 308 Transitional provision for patents register and register of patent attorneys** 15
- (1) The register of patents kept under section 83 of the Patents Act 1953 continues to have effect as the patents register kept under **section 241** of this Act.
 - (2) The register of patent attorneys kept under section 100 of the Patents Act 1953 continues to have effect as the register of patent attorneys kept under **section 230** of this Act. 20

Transitional provisions for existing offences and infringements

- 309 Transitional provision for existing offences and infringements** 25
- The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply (as if **section 295** were not in force) for the purpose of—
- (a) investigating any offence or infringement committed before the commencement of this section: 30
 - (b) commencing or completing any proceedings for any offence or infringement committed before the commencement of this section:
 - (c) imposing a penalty or granting any relief or other remedy for any offence or infringement committed before the commencement of this section. 35

*Transitional provisions for patent attorneys***310 Outline of transitional provisions for patent attorneys**

(1) The general scheme and effect of the commencement and transitional provisions for patent attorneys is as follows:

- (a) on Royal assent, — 5
 - (i) the regulation-making powers in the Act and the provisions for making and approving the code of conduct for patent attorneys come into force; and
 - (ii) the provisions governing the establishment, operation, powers, and functions of the Board come into force; and 10
- (b) between Royal assent and the commencement of **Part 5**, the Institute may develop the code of conduct for patent attorneys; and
- (c) on the commencement of **Part 5**, — 15
 - (i) the approved code of conduct may also come into force; and
 - (ii) persons registered as patent attorneys under the Patents Act 1953 are treated as being registered under this Act; and 20
 - (iii) persons may apply for registration as patent attorneys under this Act, but applications for registration made before the commencement date must continue to be dealt with under the Patents Act 1953. 25

(2) This section is a guide only to the general scheme and effect of the commencement and transitional provisions for patent attorneys:

311 Transitional provision for patent attorneys registered under Patents Act 1953 30

(1) A person who was registered as a patent attorney under the Patents Act 1953 immediately before commencement of **Part 5** of this Act is treated as a patent attorney registered under this Act on the commencement of **Part 5**:

(2) A patent attorney who had paid his or her renewal fee for registration for the calendar year in which **Part 5** commences is treated as having a current registration certificate on the commencement of **Part 5**: 35

- (3) The registration certificate is treated as expiring on the date on which the person's next renewal fees were due under the Patents Act 1953.

312 Transitional provision for applicants for registration

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continue to apply to an application for registration as a patent attorney made under that Act and not refused, accepted, or withdrawn before the commencement of **Part 5** of this Act. 5
- (2) If a person qualifies for registration as a patent attorney under **subsection (1)**, the person may be registered as a patent attorney and issued with a registration certificate under **Part 5**. 10

313 Transitional provision for lawyers

Nothing in **section 487 or 488** prohibits barristers or solicitors of the High Court of New Zealand from giving professional advice or taking part in proceedings as permitted by section 103(5) of the Patents Act 1953 in relation to instructions received before the commencement of **Part 5** of this Act. 15

Transitional provisions for Commissioner and Assistant Commissioners

20

314 Transitional appointment of Commissioner and Assistant Commissioners

- (1) The persons holding office as the Commissioner and Assistant Commissioners under the Patents Act 1953 are treated as having been appointed as the Commissioner and Assistant Commissioners under this Act on the commencement of this section (and may hold both offices concurrently). 25
- (2) The persons holding office as the Commissioner and Assistant Commissioners under the Designs Act 1953 continue to hold those offices despite the repeal and substitution of sections 3 and 4 of that Act. 30

315 Transitional power for Commissioner

- (1) The Commissioner may, for the purpose of facilitating the transition from the Patents Act 1953 to this Act, do any of the

following in connection with a patent application, other application, notice, or request originally made under the Patents Act 1953 and to which this Act now applies:

- (a) exempt a person (on the terms and conditions (if any) that the Commissioner thinks fit) from any statutory requirement that applied or now applies to the application, notice, or request: 5
 - (b) give a person additional time to comply with a statutory requirement in respect of the application, notice, or request that previously did not apply. 10
- (2) In this section, **statutory requirement** means a requirement under the Patents Act 1953 or this Act, or under any regulations, orders, directions or other matters made under either Act.
- (3) This section expires on close of the day that is 3 years after the commencement of this section. 15
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Schedule 2

Consequential amendments

s 296

Part 1

Amendments to other Acts

Administration Act 1969 (1969 No 52)

Section 67(1): omit “section 86 of the Patents Act 1953” and substitute “**section 162** of the Patents Act **2008**”. 5

Commerce Act 1986 (1986 No 5)

Section 45(2)(a): repeal and substitute:

“(a) the Patents Act **2008**; or”.

Section 45(3)(a): omit “Patents Act 1953” and substitute “Patents Act **2008**”. 10

Copyright Act 1994 (1994 No 143)

Section 74(1): repeal and substitute:

“(1) The making of any object in 3 dimensions (including, subject to subsection (2), a copy in 2 dimensions reasonably required for the making of the object) does not infringe copyright in a literary or artistic work, if the work or a copy of it forms part of— 15

“(a) a patent specification that—

“(i) is open to public inspection in the Intellectual Property Office of New Zealand in respect of a New Zealand patent that, for any reason, has ceased to have effect; and 20

“(ii) is used for the purpose of making the object; or

“(b) a representation or specimen of a design that— 25

“(i) is open to public inspection in the Intellectual Property Office of New Zealand in respect of a design for which registered protection in New Zealand has ceased; and

“(ii) is used for the purpose of making the object.” 30

Part 1—*continued***Copyright Act 1994 (1994 No 143)**—*continued*

Section 74(3): repeal and substitute:

“(3) If a patent that has ceased to have effect is restored by an order made under **subpart 12 of Part 3** of the Patents Act **2008**, nothing done under **subsection (1)** in the period beginning with the day on which the patent ceased to have effect and ending with the close of the day on which the order is made constitutes an infringement of copyright in any literary or artistic work or copy of the work forming part of the patent specification.” 5

Crown Proceedings Act 1950 (1950 No 54) 10

Section 7(1): omit “Patents Act 1953” and substitute “Patents Act **2008**”.

Section 7(2): repeal and substitute:

“(2) Nothing in subsection (1) or in any other provision of this Act affects the rights of any Government Department under **subpart 6 of Part 4** of the Patents Act **2008** or sections 16 to 18 of the Designs Act 1953.” 15

Dairy Industry Restructuring Act 2001 (2001 No 51)

Section 108(5): omit “Patents Act 1953” and substitute “Patents Act **2008**”. 20

Designs Act 1953 (1953 No 65)

Definition of **Journal** in section 2(1): repeal and substitute:

“**Journal** means the journal published under **section 254** of the Patents Act **2008**”.

Section 2(1): insert in its appropriate alphabetical order: 25

“**Ministry** means the department of State that, with the authority of the Prime Minister, is for the time being responsible for the administration of this Act”.

Part 1—*continued***Designs Act 1953 (1953 No 65)**—*continued*

Sections 3 and 4: repeal and substitute:

“3 Commissioner and Assistant Commissioners of Designs

“(1) The chief executive of the Ministry must appoint, under the State Sector Act 1988,—

“(a) the Commissioner of Designs; and 5

“(b) as many Assistant Commissioners of Designs as may be necessary for the purposes of this Act.

“(2) These persons are employees of the Ministry, and those appointments may be held separately or in conjunction with any other office in the Ministry. 10

“4 Powers of Assistant Commissioners of Designs

“(1) An Assistant Commissioner of Designs has the functions, duties, and powers of the Commissioner under this Act (other than the power to delegate under **section 4A**), but is subject to the control of the Commissioner. 15

“(2) The fact that an Assistant Commissioner exercises those functions, duties, and powers is conclusive evidence of the authority to do so.

“4A Power of Commissioner to delegate

“(1) The Commissioner may delegate to any person, either generally or particularly, any of the Commissioner’s functions, duties, and powers (except this power of delegation). 20

“(2) A delegation—

“(a) must be in writing; and

“(b) may be made subject to any restrictions and conditions that the Commissioner thinks fit; and 25

“(c) is revocable at any time, in writing; and

“(d) does not prevent the performance or exercise of a function, duty, or power by the Commissioner.

“(3) A person to whom any functions, duties, or powers are delegated may perform and exercise them in the same manner and with the same effect as if they had been conferred directly by this Act and not by delegation. 30

Part 1—*continued***Designs Act 1953 (1953 No 65)**—*continued*

“(4) A person who appears to act under a delegation is presumed to be acting in accordance with its terms in the absence of evidence to the contrary.

“(5) Any reference in this Act or the regulations made under this Act to the Commissioner includes a reference to the delegate in respect of anything delegated to that person. 5

“4B Liability of Commissioner and others

The Commissioner, an Assistant Commissioner, or any other person acting on behalf of the Commissioner is not personally liable for any act or omission done in good faith in the performance or intended performance of the Commissioner’s functions, duties, or powers.” 10

Section 7(1): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Section 9(2): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”. 15

Section 25(1): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Section 25(2): omit “sealed with the seal of the Patent Office”.

Section 29(1): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”. 20

Section 30(1), (2), and (4): omit “Patent Office” and substitute in each case “Intellectual Property Office of New Zealand”.

Section 32(2): repeal and substitute:

“(2) A copy of any entry in the register of designs or of any representation, specimen, or document kept in the Intellectual Property Office of New Zealand or an extract from the register or any such document, purporting to be certified by the Commissioner, must be admitted in evidence without further proof and without production of the original.” 25
30

Section 37(1): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Section 37A(2)(a): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Part 1—*continued*

Designs Act 1953 (1953 No 65)—*continued*

Section 39(2): omit “Patents Act 1953” and substitute “Patents Act **2008**”.

Section 45: omit “Patent Office” in each place where it appears and substitute in each case “Intellectual Property Office of New Zealand”.

Section 45A: omit “Patent Office” in each place where it appears and substitute in each case “Intellectual Property Office of New Zealand”.

Sections 45 and 45A: repeal and substitute:

“45 Opening hours of Intellectual Property Office of New Zealand

“(1) The Commissioner may— 10

“(a) fix the opening hours for the Intellectual Property Office of New Zealand; and

“(b) declare the Intellectual Property Office of New Zealand closed on any day.

“(2) The Commissioner must publicly notify those opening hours, and (before closing the Intellectual Property Office of New Zealand) any closure, in accordance with **section 5(3)** of the Patents Act **2008**. 15

“(3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of the Intellectual Property Office of New Zealand, be done on the next opening day (and is then still in time). 20

“45A Closing of Intellectual Property Office of New Zealand at short notice 25

“(1) The Commissioner may declare the Intellectual Property Office of New Zealand closed without giving publication of the closure under **section 45** if—

“(a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and 30

“(b) it is not practicable to make that prior publication.

“(2) The Commissioner must then, if practicable, display a public notice that the Intellectual Property Office of New Zealand is closed in or on the building in which the Intellectual Property Office of New Zealand is situated. 35

Part 1—*continued***Designs Act 1953 (1953 No 65)**—*continued*

“(3) The Commissioner must also, as soon as practicable after closing the Intellectual Property Office of New Zealand, publicly notify the closure in accordance with **section 5(3)** of the Patents Act **2008**.”

Section 46(2)(a), (c), and (f): omit “Patent Office” and substitute in each case “Intellectual Property Office of New Zealand”.

Section 46(2)(h): omit “*Patent Office Journal*” and substitute “*Journal*”.

Section 46: add as subsection (3):

“(3) The structure of the fee system under this Act prescribed by regulations under this section may be such that any fees for an extension of the period of copyright in a registered design under section 12(2)—

“(a) recover a share of the costs incurred by the Commissioner in performing his or her functions under this Act; and

“(b) recover those costs at a level that provides an appropriate incentive for persons to not extend that period of copyright if they do not receive sufficient benefit from having the copyright in the registered design.”

Section 49: omit “~~Patents Act 1953~~” and substitute “~~Patents Act **2008**~~” repeal.

Disputes Tribunals Act 1988 (1988 No 110)

Definition of **intellectual property** in section 2: omit “~~Patents Act 1953~~” and substitute “~~Patents Act **2008**~~”.

Employment Relations Act 2000 (2000 No 24)

Section 161(1): insert after paragraph (q):

“(qa) disputes about an invention made by an employee (either alone or jointly with any other person) or any patent granted, or to be granted, in respect of that invention:

“(qb) reviews under **section 29** of the Patents Act **2008**.”

Part 1—*continued*

Flags, Emblems, and Names Protection Act 1981 (1981 No 47)

Paragraph (f) of the definition of **registering authority** in section 2: omit “Patents Act 1953” and substitute “Patents Act **2008**”.

~~Lawyers and Conveyancers Act 2006 (2006 No 1)~~

Definition of **patent attorney** in section 6: repeal and substitute: 5

“**patent attorney** means a person who is registered, and holds a current registration certificate, as a patent attorney under the Patents Act **2008**

“**patent attorney company** has the meaning set out in **section 185** of the Patents Act **2008**”. 10

Section 36(3): insert “or patent attorney company” after “patent attorney”.

Section 47(j): repeal.

Privacy Act 1993 (1993 No 28)

Part 1 of Schedule 2: insert the following item in its appropriate alphabetical order omit the item relating to the Patents Act and substitute: 15

Patents Act 1953

section 100

Patents Act **2008**

section 230 241

Public Works Act 1981 (1981 No 35)

Definition of **intellectual property** in section 2: omit “Patents Act 1953” and substitute “Patents Act **2008**”. 20

Securities Act 1978 (1978 No 103)

Clause 13 of Schedule 2: omit “Patents Act 1953” and substitute “Patents Act **2008**”.

Summary Proceedings Act 1957 (1957 No 87)

The item relating to the Patents Act 1953 in Part 2 of Schedule 1: omit and substitute the following item: 25

The Patents Act **2008** **131** Breach of secrecy as to certain inventions

Part 1—*continued***Trade Marks Act 2002 (2002 No 49)**

Section 56: repeal and substitute:

“56 Approved regulations must be deposited at Intellectual Property Office of New Zealand

After the Commissioner has approved the draft regulations, 5
the approved regulations that govern the use of the registered
certification trade mark must be deposited at the Intellectual
Property Office of New Zealand for inspection.

“Compare: 1953 No 66 s 48”.

Section 159(2)(a)(iii): omit “Patent Office” and substitute “Intellectual 10
Property Office of New Zealand”.

New section 175D: insert before section 176:

“175D Liability of Commissioner and others

The Commissioner, an Assistant Commissioner, or any other 15
person acting on behalf of the Commissioner is not personally
liable for any act or omission done in good faith in the
performance or intended performance of the Commissioner’s
functions, duties, or powers.”

Section 184(2): omit “, sealed with the seal of the Patent Office,”.

Sections 188 and 189 and the heading above section 188: repeal and 20
substitute:

“Intellectual Property Office of New Zealand

**“188 Opening and closing of Intellectual Property Office of
New Zealand**

~~“(1) The Commissioner may, by notice in the prescribed manner,= 25~~

~~“(a) fix the hours during which the Intellectual Property Of-
fice of New Zealand is open for the transaction of public
business under this Act; and~~

~~“(b) declare the Intellectual Property Office of New Zealand
closed for the transaction of public business on any day: 30~~

~~“(2) An act or proceeding is in time if=~~

~~“(a) the time prescribed for doing the act or taking the pro-
ceeding expires on a day when the Intellectual Property
Office of New Zealand is closed; and~~

Part 1—*continued***Trade Marks Act 2002 (2002 No 49)**—*continued*

“(b) the act or proceeding cannot be done or taken on that day because the Intellectual Property Office of New Zealand is closed; and

“(c) the act or proceeding is done or taken on the next day when the Intellectual Property Office of New Zealand is open. 5

“Compare: 1953 No 66 s 76

“189 Closing of Intellectual Property Office of New Zealand at short notice

“(1) Despite **section 188**, the Commissioner may, without giving notice of the closure of the Intellectual Property Office of New Zealand in the prescribed manner, declare the Intellectual Property Office of New Zealand closed for the transaction of business if,— 10

“(a) because of an emergency or other temporary circumstances, the Commissioner is satisfied that it is or will be necessary or desirable to close the Intellectual Property Office of New Zealand on any day; and 15

“(b) it is not practicable to give notice of the closure in the prescribed manner. 20

“(2) If the Commissioner proposes to declare or has declared the Intellectual Property Office of New Zealand closed under **subsection (1)**, the Commissioner must, if practicable, display a public notice of that fact in or on the building in which the Intellectual Property Office of New Zealand is situated. 25

“(3) As soon as practicable, the Commissioner must also cause a copy of the public notice, or (if no such notice was displayed) a notice of the exercise of his or her powers under this section, to be published in the prescribed manner. 30

“Compare: 1953 No 66 s 76A

“188 Opening hours of Intellectual Property Office of New Zealand

“(1) The Commissioner may—

Part 1—*continued***Trade Marks Act 2002 (2002 No 49)**—*continued*

- “(a) fix the opening hours for the Intellectual Property Office of New Zealand; and
- “(b) declare the Intellectual Property Office of New Zealand closed on any day.
- “(2) The Commissioner must publicly notify those opening hours, and (before closing the Intellectual Property Office of New Zealand) any closure, in accordance with **section 5(3)** of the Patents Act **2008**. 5
- “(3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of the Intellectual Property Office of New Zealand, be done on the next opening day (and is then still in time). 10
- “**189 Closing of Intellectual Property Office of New Zealand at short notice** 15
- “(1) The Commissioner may declare the Intellectual Property Office of New Zealand closed without giving publication of the closure under **section 188** if—
- “(a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and 20
- “(b) it is not practicable to make that prior publication.
- “(2) The Commissioner must then, if practicable, display a public notice that the Intellectual Property Office of New Zealand is closed in or on the building in which the Intellectual Property Office of New Zealand is situated. 25
- “(3) The Commissioner must also, as soon as practicable after closing the Intellectual Property Office of New Zealand, publicly notify the closure in accordance with **section 5(3)** of the Patents Act **2008**.”
- Section 198: ~~omit “Patents Act 1953” and substitute “Patents Act **2008**”~~ repeal. 30
- The heading above section 199(1): repeal and substitute: “*Intellectual Property Office of New Zealand*”.
- Section 199(1): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”. 35

Part 1—*continued***Trade Marks Act 2002 (2002 No 49)**—*continued*

Section 199: add as subsection (2):

“(2) The structure of the fee system under this Act prescribed by regulations under subsection (1) may be such that any renewal fees—

“(a) recover a share of the costs incurred by the Commissioner in performing his or her functions under this Act; and

“(b) recover those costs at a level that provides an appropriate incentive for persons to let registrations of trade marks lapse if they do not receive sufficient benefit from having the registration.”

Trans-Tasman Mutual Recognition Act 1997 (1997 No 60)

Schedule 1: omit “Patents Act 1953” and substitute “Patents Act 2008”.

Part 2

15

Regulations amended

Defence Regulations 1990 (SR 1990/78)

Regulation 24(1): omit “New Zealand Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Regulation 24(1): omit “the Patent Office” and substitute “the Intellectual Property Office of New Zealand”. 20

Regulation 26: omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Schedule 2: omit “Patent Office” in each place where it appears and substitute in each case “Intellectual Property Office of New Zealand”. 25

Designs Regulations 1954 (SR 1954/224)

The definition of **lodged** in regulation 2: omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Regulation 4: omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”. 30

Part 2—*continued***Designs Regulations 1954 (SR 1954/224)**—*continued*

Regulation 5: omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Regulation 6: omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Regulation 16: omit “Patent Office” in each place where it appears and substitute in each case “Intellectual Property Office of New Zealand”. 5

Schedule 2: omit “Patent Office” in each place where it appears and substitute in each case “Intellectual Property Office of New Zealand”.

Patents, Designs, and Trade Marks Convention Order 2000 (SR 2000/236) 10

Clause 3: omit “Patents Act 1953” and substitute “Patents Act **2008**”.

Patents (United States of America) Regulations 1956 (SR 1956/159) 15

Regulation 3: omit “Patents Act 1953 or the Patents Regulations 1954” and substitute “Patents Act **2008** or regulations made under that Act”.

Regulation 4: omit “section 11 of the Patents Act 1953” and substitute “**section 5** of the Patents Act **2008**”. 20

Regulation 4: omit “Patents Act 1953 or the Patents Regulations 1954” and substitute “Patents Act **2008** or regulations made under that Act”.

Trade Marks Regulations 2003 (SR 2003/187)

Definition of **filing date** in regulation 3: omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”. 25

Regulation 8(a): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Regulation 23(a) and (b): revoke and substitute:

“(a) who is suspended from practice before the Intellectual Property Office of New Zealand; or 30

Patents Bill

Part 2—*continued*

Trade Marks Regulations 2003 (SR 2003/187)—*continued*

“(b) whose name has been removed from the register of patent attorneys under **section 198** of the Patents Act **2008**, and has not been restored to the register; or”.

Legislative history

9 July 2008
5 May 2009

Introduction (Bill 235-1)
First reading and referral to Commerce Committee
